

27
No. 95-26-CFX
Status: GRANTED

Title: Herbert Markman and Positek, Inc., Petitioners
v.
Westview Instruments, Inc. and Althon Enterprises,
Inc.

Docketed:
July 3, 1995

Court: United States Court of Appeals for
the Federal Circuit

See also:
94-2081
95-45

Counsel for petitioner: Mallin, William B.

Counsel for respondent: Griffin III, Frank H.

Entry	Date	Note	Proceedings and Orders
1	Jul 3 1995	G	Petition for writ of certiorari filed.
2	Aug 2 1995		DISTRIBUTED. September 26, 1995 (Page 76)
3	Aug 2 1995		Brief amicus curiae of Association of Trial Lawyers of America filed.
4	Aug 3 1995	G	Motion of American Board of Trial Advocates for leave to file a brief as amicus curiae filed.
5	Aug 7 1995		Brief amicus curiae of Litton Systems, Inc. filed.
6	Aug 7 1995	X	Brief of respondents Westview Instruments, et al. in opposition filed.
7	Aug 23 1995	X	Reply brief of petitioners filed.
8	Sep 27 1995		Motion of American Board of Trial Advocates for leave to file a brief as amicus curiae GRANTED.
9	Sep 27 1995		Petition GRANTED. The brief of petitioners is to be filed with the Clerk and served upon opposing counsel on or before 3 p.m., Thursday, November 9, 1995. The brief of respondents is to be filed with the Clerk and served upon opposing counsel on or before 3 p.m., Friday, December 8, 1995. A reply brief, if any, is to be filed with the Clerk and served upon opposing counsel on or before 3 p.m., Thursday, December 28, 1995. Rule 29.2 does not apply. *****
10	Nov 1 1995		SET FOR ARGUMENT MONDAY, JANUARY 8, 1996. (2ND CASE).
11	Nov 9 1995		Joint appendix filed.
12	Nov 9 1995		*Joint appendix in two volumes
13	Nov 9 1995		Brief of petitioners Herbert Markman, et al. filed.
14	Nov 9 1995		Brief amicus curiae of Association of Trial Lawyers of America filed.
15	Nov 9 1995		Brief amicus curiae of Litton Systems, Inc. filed.
16	Nov 9 1995		Brief amici curiae of Exxon Corporation, et al. filed.
17	Nov 9 1995		CIRCULATED.
18	Nov 17 1995		Record filed.
		*	Partial record proceedings United States Court of Appeals for the Federal Circuit (BOX).
19	Nov 24 1995	G	Motion of American Board of Trial Advocates for leave to file a brief as amicus curiae filed.
20	Dec 4 1995		Motion of American Board of Trial Advocates for leave to file a brief as amicus curiae GRANTED.
21	Dec 7 1995	X	Brief amicus curiae of John T. Roberts filed.
22	Dec 8 1995	X	Brief of respondents Westview Instruments, et al. filed.
23	Dec 8 1995	X	Brief amicus curiae of Dallas-Fort Worth Intellectual

2 PM

Entry	Date	Note	Proceedings and Orders
			Property Law Association filed.
24	Dec 8 1995	X	Brief amicus curiae of Douglas W. Wyatt filed.
25	Dec 8 1995	X	Brief amicus curiae of United States Surgical Corporation filed.
26	Dec 8 1995	X	Brief amicus curiae of Intellectual Property Owners filed.
27	Dec 8 1995	X	Brief amicus curiae of Honeywell, Inc. filed.
28	Dec 8 1995	X	Brief amicus curiae of American Automobile Manufacturers Association filed.
29	Dec 8 1995	X	Brief amicus curiae of American Intellectual Property Law Association filed.
30	Dec 8 1995	X	Brief amicus curiae of Federal Circuit Bar Association filed.
31	Dec 8 1995	X	Brief amicus curiae of Airtouch Communications, Inc. filed.
32	Dec 8 1995	X	Brief amici curiae of Matsushita Electric Corporation of America, et al. filed.
33	Dec 8 1995		LODGING consisting of 12 sets of two spiral bound volumes submitted by counsel for Matsushita Electric Corp., et al.
34	Dec 28 1995	X	Reply brief of petitioners Herbert Markman, et al. filed.
36	Jan 4 1996		Record filed.
		*	Original record proceedings United States District Court for the Eastern District of Pennsylvania (BOX).
35	Jan 8 1996		ARGUED.

No. 95-

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,

Respondents.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

Of Counsel:

LEWIS F. GOULD, JR.
STEPHAN P. GRIBOK
ECKERT SEAMANS CHERIN
& MELLOTT
1700 Market Square
Suite 3232
Philadelphia, PA 19103

WILLIAM B. MALLIN
Counsel of Record
TIMOTHY P. RYAN
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
(412) 566-6000

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

(i)

QUESTION PRESENTED

In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning of a patent?

(ii)

**LIST OF PARTIES TO THE PROCEEDING
PURSUANT TO RULES 14(1)(b) AND 29.1**

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of *Certiorari*.

LIST OF PARTIES PURSUANT TO RULE 29.1

Petitioner Positek, Inc. does not have any parent companies or subsidiaries.

(iii)

TABLE OF CONTENTS

PAGE

QUESTION PRESENTED	i
LIST OF PARTIES TO THE PROCEEDING PURSUANT TO RULES 14(1)(b) AND 29.1	ii
LIST OF PARTIES PURSUANT TO RULE 29.1	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	vi
OPINIONS BELOW	1
JURISDICTION	1
CONSTITUTIONAL PROVISION	2
STATEMENT OF THE CASE	2
1. The Patent	2
2. The Accused System	3
3. District Court Litigation	3
4. Post-Verdict Decision of District Judge	5
5. Federal Circuit Opinions	5

(iv)

TABLE OF CONTENTS --Continued

REASONS FOR GRANTING THE WRIT	9
A. The Seventh Amendment Requires Juries To Determine the Meaning of Disputed Patent Terms in Jury Patent Infringement Actions For Damages.	10
1. The Holding Below Is Contrary To The Relevant Historical Record.	13
2. The Holding Below Is Inconsistent With Precedent From This Court.	17
3. The Policy Arguments Advanced Below Are Constitutionally Irrelevant And Unsound	20
B. The Seventh Amendment Question Is Both Recurring and Important.	25
CONCLUSION	30
APPENDIX	
A. Opinions of United States Court of Appeals for the Federal Circuit (April 5, 1995)	1a-159a

(v)

TABLE OF CONTENTS--Continued

B. Judgment, United States Court of Appeals for the Federal Circuit (April 5, 1995)	160a-161a
C. Order, Ordering, <i>sua sponte</i> , That the Appeal be Heard <i>en banc</i> (Nov. 5, 1993)	162a-163a
D. Order Providing for Additional Briefing and Other Matters for Rehearing <i>en banc</i> (Jan. 7, 1994)	164a-167a
E. Judgment of United States District Court for the Eastern District of Pennsylvania in Favor of Defendants and Against Plaintiffs (Oct. 1, 1991)	168a
F. Order of United States District Court for the Eastern District of Pennsylvania Granting Motion for Directed Verdict (Oct. 1, 1991)	169a
G. Memorandum of United States District Court for the Eastern District of Pennsylvania Granting Motion for Directed Verdict (Sept. 30, 1991)	170a-177a

TABLE OF AUTHORITIES

Cases:

Page

<i>American Airlines v. Lockwood</i> , 50 F.3d 966 (Fed. Cir.), cert. granted, (U.S. June 5, 1995) (No. 94-1660)	29, 30
<i>Beacon Theatres, Inc. v. Westover</i> , 359 U.S. 500 (1959)	26
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	17, 18
<i>Blonder-Tongue Labs., Inc. v. University of Ill. Found.</i> , 402 U.S. 313 (1971)	21, 22
<i>Bramah v. Hardcastle</i> , 1 Carpmael Patent Cas. 168 (K.B. 1789)	11
<i>Cardinal Chem. Co. v. Morton</i> , 113 S.Ct. 1967 (1993)	26, 29
<i>Collins v. Sawrey</i> , 4 Bro. P.C. 692 (H.L. 1772)	15
<i>Control Components, Inc. v. Valtek, Inc.</i> , 609 F.2d 763 (5th Cir.), cert. denied, 449 U.S. 1022 (1980)	7
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	20
<i>Curtis v. Loether</i> , 415 U.S. 189 (1974)	11, 13

Page

<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	10, 21, 26
<i>Fidelity & Deposit Co. v. United States</i> , 187 U.S. 315 (1902)	20
<i>Galloway v. United States</i> , 319 U.S. 372 (1943)	20
<i>Goddard v. Foster</i> , 84 U.S. (17 Wall.) 123 (1872)	23
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	23
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	10, 16
<i>Hall Lab., Inc. v. Economics Lab., Inc.</i> , 169 F.2d 65 (8th Cir. 1948)	7
<i>Heald v. Rice</i> , 104 U.S. 737 (1882)	8, 18, 19
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	19
<i>Hurin v. Electric Vacuum Cleaner Co.</i> , 298 F. 76 (6th Cir. 1924)	7
<i>In re U.S. Fin. Sec. Litig.</i> , 609 F.2d 411 (9th Cir. 1979), cert. denied, 446 U.S. 929 (1980)	22
<i>Intervet Am., Inc. v. Kee-Vet Lab., Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	18

	Page
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877),	19, 27
<i>Liardet v. Johnson</i> , K.B. (1778)	13, 14
<i>Lucas Aero., Ltd. v. Unison Indus., L.P.</i> , 1995 U.S. Dist. LEXIS 8414 (D. Del. June 2, 1995)	24, 28
<i>Lytle v. Household Mfg., Inc.</i> , 494 U.S. 545 (1990)	13
<i>Market Street Cable Ry. Co. v. Rowley</i> , 155 U.S. 615 (1895)	19
<i>Markman v. Westview Instruments, Inc.</i> , 772 F. Supp. 1535 (E.D. Pa. 1991), aff'd, 52 F.3d 967 (Fed. Cir. 1995)	passim
<i>Mayor of Kingston Upon Hull v. Horner</i> , 1 Cowp. 102 (K.B. 1774)	15
<i>McAllister v. United States</i> , 348 U.S. 19 (1954)	21
<i>McGill Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984)	7
<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986)	11, 22, 23

	Page
<i>Morris v. Bramson</i> , 1 Carpmael Patent Cas. 30, (K.B. 1776)	11
<i>Motion Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	23
<i>Neilson v. Harford</i> , Webster P.C. 295 (1841)	15
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	7
<i>Parsons v. Bedford</i> , 28 U.S. (3 Pet.) 433 (1830)	10, 26
<i>Perini Am., Inc. v. Paper Converting Mach. Co.</i> , 832 F.2d 581 (Fed. Cir. 1987)	12
<i>Pierce v. Underwood</i> , 487 U.S. 552 (1988)	25
<i>Pirkle v. Ogontz Controls Co.</i> , No. 94-1454 (Fed. Cir. April 6, 1995)	27
<i>Reed v. Proprietors of Locks & Canals</i> , 49 U.S. (8 How.) 274 (1850)	23
<i>Rex v. Arkwright</i> , p. 172-73, Carpmael Patent Cas. 79, Webster Patent Cas. 66, Davies Patent Cas. 106	16
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970)	13
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	19, 20

(x)

	Page
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	19, 27
<i>Slocum v. New York Life Ins. Co.</i> , 228 U.S. 364 (1913)	22
<i>Smithkline Diagnostics, Inc. v. Helena Lab. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988)	11, 18, 23
<i>Teamsters v. Terry</i> , 494 U.S. 558 (1990)	10, 11
<i>Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed. Cir. 1991)	7
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	18
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	11, 21
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	14
<i>United States v. Gaudin</i> , No. 94-514, slip. op. U.S. (June 19, 1995)	13
<i>United States v. Torniero</i> , 735 F.2d 725 (2d Cir. 1984), <i>cert. denied</i> , 469 U.S. 1110 (1985)	22
<i>United States Surgical Corp. v. Ethicon, Inc.</i> , No. 94-1386 (Fed. Cir. Feb. 14, 1995), <i>petition for cert. filed</i> , June 20, 1995	27

(xi)

	Page
<i>United States v. Wonson</i> , 28 F. Cas. 745 (C.C.D. Mass. 1812)	10
<i>Walker v. Southern Pacific R.R.</i> , 165 U.S. 593 (1897)	12, 17
<i>Washburn v. Gould</i> , 29 Fed. Cas. 312 (C.C.D. Mass. 1844)	15
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854)	20
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1859)	19
Constitution:	
U.S. Const. amend. VII	<i>passim</i>
Statutes:	
28 U.S.C. § 1254(1)	1
28 U.S.C. § 1295(a)(1)	26
35 U.S.C. § 112	17
35 U.S.C. § 281	3, 10
35 U.S.C. § 284	3, 11
Statute of Monopolies, 21 Jac. I, ch. 3 § 2 (1623)	10, 15

	Page
Other Sources:	
<i>Restatement (Second) of Contracts</i> § 200, cmt. c (1981)	6
2 W. BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 579 (E. Christian 13th ed. 1796)	11
F. BULLER, AN INTRODUCTION TO THE LAW RELATIVE TO TRIALS AT NISI PRIUS ch. VII (6th ed. 1791)	11, 14
W. HANDS, THE LAW AND PRACTICE OF PATENTS FOR INVENTIONS (1808)	29
XII W. HOLDSWORTH, A HISTORY OF ENGLISH LAW, 354 (1938)	14
E. W. Hulme, <i>On the History of the Patent Law</i> <i>in the 17th and 18th Century</i> , 18 LAW QUARTERLY REVIEW 280 (1902)	14
A. MILLER & M. DAVIS, INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT 124 (2d ed. 1990)	19-20
I J. OLDHAM, "THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY (1992)	14, 16
J. STORY, COMMENTARIES ON EQUITY JURISPRUDENCE §§ 930-934 (13th ed. 1886) . .	11

**IN THE
SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
PETITIONER,
v.
WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
RESPONDENTS.

PETITION FOR WRIT OF CERTIORARI

Herbert Markman and Positek, Inc. respectfully petition for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinions of the Court of Appeals are reported at 52 F.3d 967 (Fed. Cir. 1995), and are reproduced beginning at Appendix page 1a. The opinion of the district court is reported at 772 F. Supp. 1535 (E.D. Pa. 1991) and is reproduced beginning at Appendix page 170a.

JURISDICTION

The judgment of the Court of Appeals was entered on April 5, 1995. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISION

The Seventh Amendment of the United States Constitution provides:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

STATEMENT OF THE CASE

This case presents the question whether the Seventh Amendment permits courts, in jury patent infringement actions for damages, to resolve as a matter of law genuinely disputed questions about the meaning of a patent. Sitting *en banc*, the United States Court of Appeals for the Federal Circuit held that the Seventh Amendment permits all such disputes to be classified as legal ones, subject to judicial determination at trial and *de novo* review on appeal. Because both infringement and validity decisions routinely turn on interpretation of patents, and because the Federal Circuit has exclusive appellate jurisdiction in all such cases, the decision below will profoundly affect the trial of virtually every patent infringement action throughout the Nation.

1. The Patent. Petitioner Herbert Markman is the owner of, and petitioner Positek, Inc. is a licensee under, United States Reissue Patent No. 33,054, titled "Inventory Control and Reporting System for Drycleaning Stores." 6a. Claim 1 of the patent covers the invention of a computerized "inventory control and reporting system." 9a. The inventory is controlled by bar coded record or records generated by the computer for each transaction. 8a. The bar coded

records can relate to an individual article or a batch of articles *Id.*¹ Claim 1 requires "means to maintain an inventory total." 10a. The patent does not contain a definition of the term "inventory."

2. The Accused System. Respondent Westview Instruments, Inc. manufactures, and respondent Althon Enterprises, Inc. uses, a computerized system that records information for drycleaning businesses, including the names of each customer and cash totals of each transaction. 11a-12a. There is a bar coded record for each customer's batch of articles. *Id.* The system records, but does not retain in computer memory, a listing of individual items of clothing. *Id.* Thus, the accused system has means to maintain a cash inventory total for each customer's order, but not a listing of individual garments for each order. 17a.

3. District Court Litigation. Petitioners sued respondents for patent infringement under 35 U.S.C. § 281 and sought money damages under 35 U.S.C. § 284. At trial, respondents argued that the accused system does not infringe petitioners' patent because the term "inventory," as used in the patent, refers only to "articles of clothing," and not to "transaction totals or dollars." 13a.

Petitioners introduced considerable testimonial and documentary evidence directed at how the disputed patent term would be understood by those of ordinary skill in the art. Both Markman himself (the inventor and one skilled in the art) and a practicing patent attorney with expertise in the field testified in support of petitioners' interpretation.

¹ Some of the patent claims are not limited to the drycleaning industry so that articles can refer to articles other than clothing.

Documentary evidence was also introduced reflecting the use of the term "inventory" in the industry, including the accused systems' operating manual and brochures. 12a. An expert on computer and bar code technology testified concerning the capacity and function of the accused system which was demonstrated to the jury. *Id.* The evidence demonstrated *inter alia*, that a skilled artisan would understand that because the patent permits inventory to be controlled by batches of articles (as does the accused system), an inventory total could be in dollars associated with the batches without keeping a listing of the individual articles of clothing. The evidence, which is not fully summarized here, was more than enough to support the jury's implied interpretation and verdict of infringement.²

At trial, the district judge recognized the presence of evidentiary disputes when he made evidentiary rulings and also when he instructed the jury to "determine the meaning" of the disputed claim language, taking into account not only the text of the patent itself, but also all "other considerations" that bear on how the text "would normally be

² Petitioners also cross examined Westview's president -- the designer of the accused-system and also one skilled in the art. He conceded that Westview's brochures (which he had approved) described the accused system as an inventory control system, Fed. Cir. Appendix, A923-24, 926, -- thereby recognizing that in the industry the usage of the term inventory included cash totals as well as physical totals. He further testified that one type of inventory a drycleaner is concerned about is the cash inventory and that the accused system was designed to account for that type of "inventory." *Id.* at A924-25. He described the list of invoices generated by the accused system as the "dollar inventory." *Id.* at A928. In his deposition testimony read to the jury at trial, Westview's president had also described the accused system as an "inventory control system." *Id.* at A923-25.

understood by those of ordinary skill in the art." 13a. The district judge further instructed the jury to make the infringement determination by comparing the relevant claims of the patent, as so interpreted, with respondents' system. *Id.* The jury found that respondents had infringed the patent. *Id.*

4. Post-Verdict Decision of District Judge. After verdict, the district court reversed itself. 170a. It held, on a deferred ruling on a motion for directed verdict, that "claim construction was a matter of law for the court." *Id.* Thus, the district judge reinterpreted the patent *de novo*, affording no deference to the interpretation found by the jury. The district judge found that the term "inventory" referred to physical articles of clothing and that, under that interpretation, respondents had not infringed. *Id.* In doing so, the district judge weighed the evidence, evaluated credibility and purported to explain away admissions by Westview. 173a-176a. In short, he found facts. The district judge did not purport to determine that the evidence was insufficient to support the jury verdict. Instead, he expressly decided that the meaning of the terms of the patent was an issue of law exclusively for him which he proceeded to decide by evaluating the evidence. 13a-14a.

5. Federal Circuit Opinions. Sitting *en banc*, the Federal Circuit affirmed. The court held squarely that the terms of a patent are always subject to judicial determination at trial without any role for or deference to the jury, 30a ("[t]he court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim"), and to *de novo* review on appeal, 44a n.13 ("[W]e review court

determinations on questions of claim construction under a *de novo* standard of review, like other legal questions").³

The court made clear that its holding applied even if "[e]xtrinsic evidence" -- including live "expert and inventor testimony" -- is necessary to determine the meaning of the patent. 33a.⁴ This means that, whatever formula is used to describe the consideration of this evidence, the district judge actually will decide the weight of evidence and credibility and demeanor of witnesses in resolving this supposed issue of law. The holding also expressly means that the district judge's decision, depending at least in part on weighing evidence and credibility, is to be reviewed *de novo* by the Federal Circuit as a matter of law, without any deference to the findings of the jury or judge.⁵ This result flows from a

³ While the court often spoke of "claim construction," it repudiated the traditional distinction between "construction," which involves determining the legal effect of a written document, and "interpretation," which involves determining its meaning. 21a n.6. See, e.g., *Restatement (Second) of Contracts* § 200, cmt. c (1981). Thus, the court asserted that "the terms mean one and the same thing in patent law," *id.*, and its holding explicitly encompasses both concepts. 21a. ("[W]e conclude that the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." (emphasis added)). 5a.

⁴ The court reaffirmed the traditional rule that "extrinsic evidence," including live testimony, is appropriate to determine the "true meaning of the language employed" in the patent. (citation omitted) 34a.

⁵ After holding that the jury had no role in finding the meaning of the patent, the majority then interpreted the patent *de novo* by weighing evidence and deciding credibility, 43a, labelling that fact finding process as deciding a legal issue. The majority did not hold that the evidence was insufficient to support the jury verdict, or even analyze that issue. There was ample evidence to support the jury verdict.

change of labels divorced from substance: the factual dispute merely is relabelled a question of law.

The majority acknowledged that the Seventh Amendment applies to infringement actions for damages, but found no authority supporting "the proposition that claim construction was a question of fact or involved triable issues of fact to a jury in or prior to 1791." 45a. In reaching its decision, the court also acknowledged "inconsistencies" between the decision below and its prior decisions, 25a, at least seven of which it explicitly disapproved. 23a-24a.⁶

⁶ See, e.g., *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991) ("When the meaning of a term in a patent claim is unclear, subject to varying interpretations, or ambiguous, the jury may interpret the term en route to deciding the issue of infringement."); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985) ("[W]hen the meaning of a term in the claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction."); *McGill Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.) ("If ... the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, construction of the claims should be left to a jury."), *cert. denied*, 469 U.S. 1037 (1984). The court's decision also conflicts with pre-Federal Circuit decisions of the regional courts of appeals. See, e.g., *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.) ("proper meaning" of disputed patent term is "a factual issue to be determined by the jury"), *cert. denied*, 449 U.S. 1022 (1980); *Hall Lab., Inc. v. Economics Lab., Inc.*, 169 F.2d 65, 66-67 (8th Cir. 1948) ("[T]he construction of patent claims where extrinsic evidence is required to determine the meaning of technical terms also involves questions of fact."); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("In case of a controversy as to the construction of a patent claim, it may usually be true ... that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved.").

Finally, the court advanced several policy and theoretical arguments. The court asserted that judges must interpret patents to ensure both predictability and accuracy. 28a. It held that jury determinations were inappropriate because "extrinsic evidence" could not enlarge, diminish or vary the text of the patent. 35a. And, it contended that patents are more analogous to statutes than to contracts. 51a-52a.

Judge Mayer concurred in the judgment but strongly criticized the majority's reasoning and characterized the majority's holding as a "sea change" in the law. 57a. He argued that if "extrinsic evidence" results in a "genuine dispute" over the meaning of a patent term, it "falls to the finder of fact to settle it." 64a. He was blunt that removing these disputes from the jury was "unconstitutional." 58a. Moreover, he emphasized that because infringement often turns on how the patent is interpreted, the classification of all interpretive questions as legal ones "eviscerates" both the role of the jury and the Seventh Amendment. 57a-58a.⁷

Judge Newman dissented. 83a. She concluded that disputes about the meaning of patents are factual ones, informed as they are by live testimony about the scope and content of prior art, events that occurred during the prosecution history, and the usages and customs of the relevant scientific community. 83a-92a. On the Seventh Amendment question, she set forth extensive historical evidence that infringement cases in general, and patent interpretation issues in particular, were tried to juries in England beginning at least as early as 1623. 118a-129a. She characterized the

⁷ Judge Rader concurred in the judgment, but did not address the Seventh Amendment issues debated in the other opinions. 81a-82a.

majority's treatment of the Seventh Amendment as nothing short of "egregious." 115a.

REASONS FOR GRANTING THE WRIT

This Court should grant *certiorari* to decide whether, in patent infringement actions for damages where a jury is demanded, the Seventh Amendment permits judges to resolve as a matter of law all genuine disputes about the meaning of a patent. In holding that it does, the Federal Circuit ignored all historical evidence relevant to the constitutional question, misread a series of this Court's decisions, overruled or limited a legion of prior cases, and imposed a regime -- *de novo* appellate review of conflicting live testimony -- virtually unknown in our jurisprudence. The holding below seeks to escape the Seventh Amendment by mischaracterizing this factual dispute as an issue of law.

This is an enormously important case of constitutional dimension which will have a major day-by-day impact on the administration of the patent system which itself flows directly from the Constitution. Under the holding below, it will be commonplace to deny litigants their constitutional right to jury trial on the meaning of patent terms, a critical issue in validity as well as infringement determinations. If this recurring issue is not now settled by this Court, there is a real danger of continuing confusion, if not chaos, in patent litigation and a waste of judicial and other resources.

The constitutional right to jury trial is of first importance. This attack on that fundamental right requires careful scrutiny and deserves this Court's attention. If, contrary to petitioners' position, there is to be this major curtailment of the constitutional right to jury trial in infringement cases, that critical change should come only from this Court.

A. The Seventh Amendment Requires Juries To Determine the Meaning of Disputed Patent Terms in Jury Patent Infringement Actions For Damages.

As this Court has long recognized, the Seventh Amendment guarantees a jury trial in all cases where legal rights, as opposed to equitable rights, are at issue. See, e.g., *Teamsters v. Terry*, 494 U.S. 558, 564-65 (1990); *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830). That distinction, of course, incorporates English practice as of 1791. See, e.g., *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935) ("[R]esort must be had to the appropriate rules of the common law established at the time of the adoption of that constitutional provision in 1791."); *United States v. Wonson*, 28 F. Cas. 745, 750 (C.C.D. Mass. 1812) (Story, J.) ("Beyond all question, the common law here alluded to ... is the common law of England, the grand reservoir of all our jurisprudence."). The Seventh Amendment also applies to statutory claims that are "analogous" to "common-law causes of action ordinarily decided in English law courts in the late 18th century," *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989), and therefore deemed to "resolve legal rights," *Terry*, 494 U.S. at 565. Under these settled principles, the Seventh Amendment unquestionably applies to infringement claims for damages; that much the Federal Circuit conceded. 44a.⁸

⁸ This conclusion is inescapable. Infringement actions under 35 U.S.C. § 281 are obviously analogous to infringement actions at common law. In England in 1791, cases involving "letters patent," like those involving other "grants, licenses [or] charters" from the Crown, had been tried to juries for at least 168 years, under the Statute of Monopolies, 21 Jac. I, ch. 3, § 2 (1623), "[A]ll monopolies, and all such commissions, grants,

(continued...)

Recognizing that the Seventh Amendment applies to infringement trials, it is important to focus on the nature of the dispute when the meaning of a term of a patent is at issue in infringement litigation. Patents are directed to those skilled in the art. They contain technological disclosures and are written by and for the technologically informed. Frequently, the terminology used in the patent and the art is technical and difficult. The task is to determine what the term means to one "of skill in the art". See, e.g., *Smithkline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878 (Fed. Cir. 1988); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

This issue -- what does the term mean to one skilled in the art -- is on its face a factual inquiry so that when disputed, it raises a factual dispute. The inquiry is not what the term means to a judge, but what the term means to those of ordinary skill in the art. That is why it is settled, as the court below conceded, that evidence, such as testimony from those skilled in the art, expert testimony and other evidence, may be introduced in order to find the meaning of the patent

⁸(...continued)

licenses, charters, [and] letters patent ... shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise." See, e.g., *Bramah v. Hardcastle*, 1 Carpmael Patent Cas. 168 (K.B. 1789); *Morris v. Bramson*, 1 Carpmael Patent Cas. 30 (K.B. 1776); F. BULLER, AN INTRODUCTION TO THE LAW RELATIVE TO TRIALS AT NISI PRIUS ch. VII (6th ed. 1791), cited in 2 W. BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 579 (E. Christian 13th ed. 1796); J. STORY, COMMENTARIES ON EQUITY JURISPRUDENCE §§ 930-934, at 236-39 (13th ed. 1886). Moreover, the money damages provided under 35 U.S.C. § 284 are a quintessential legal remedy. See, e.g., *Terry*, 494 U.S. at 570; *Curtis v. Loether*, 415 U.S. 189, 196 (1974).

term. Of course, when a tribunal -- judge or jury -- resolves issues by considering testimony and evidence, it must weigh conflicting evidence, make credibility determinations and judge the demeanor of witnesses. In the final analysis, it must find the facts to resolve that dispute. Thus, this is a classic issue -- a factual dispute -- to be submitted to the jury as required by the Seventh Amendment. *See, e.g., Walker v. Southern Pacific R.R.*, 165 U.S. 593, 596 (1897) ("questions of fact in common law actions shall be settled by a jury").⁹

Nonetheless, the court below asserted that the Seventh Amendment is not implicated because any interpretive dispute "is strictly a legal question for the Court." 44a. The court's analysis is wrong for at least three independent reasons. First, the court ignored clear historical evidence that juries, not judges, interpreted patents in England in 1791. Second, the court simply misread a series of related decisions in which this Court addressed whether patent interpretation questions should be classified as legal or factual. Third, the court rested primarily on a series of policy-based and theoretical arguments that have no place in this Court's Seventh Amendment jurisprudence, and are unconvincing even on their own terms. Relabelling a factual dispute as a legal question in 1995 cannot escape the Seventh Amendment.

⁹ *See also Perini Am., Inc. v. Paper Converting Mach. Co.*, 832 F.2d 581 (Fed. Cir. 1987). (Former Chief Judge Markey, the first Chief Judge of the Federal Circuit, explained that while "resolution of the question on the meaning of a term or terms dictates the interpretation of the claim," that "does not change the nature of the meaning-of-terms inquiry from one of fact to one of law." *Id.* at 584.)

1. The Holding Below Is Contrary To The Relevant Historical Record.

The Federal Circuit's assertion that interpretive disputes present legal questions cannot foreclose constitutional analysis, for the Seventh Amendment would be meaningless if courts could evade it simply by re-classifying factual questions as legal ones. The appropriate analysis turns on substance and history, not labels. Thus, the Seventh Amendment applies not only to claims tried by juries at common law, but also to issue decided by juries at common law. *See, e.g., Ross v. Bernhard*, 396 U.S. 531, 538 (1970) ("The Seventh Amendment question depends on the nature of the issue to be tried rather than the character of the overall action."). For example, when legal and equitable claims are tried together, the Seventh Amendment attaches not only to the legal claim as a whole, but also to "all issues common to both claims." *Lyle v. Household Mfg., Inc.*, 494 U.S. 545, 550 (1990) (quoting *Curtis v. Loether*, 415 U.S. at 196 n.11) (emphasis added)).¹⁰

The majority below conducted no historical analysis to determine whether the relevant issue -- interpretation of the patent -- was triable to a jury at common law. 45a. In fact, it clearly was. In infringement cases decided before 1791, English juries were instructed to decide questions that required them to interpret terms of art in patents. For example, in *Liardet v. Johnson*, a leading King's Bench decision rendered in 1778, a defendant asserted that a patent

¹⁰ *See also, United States v. Gaudin*, No. 94-514, slip op. at 6 (U.S. June 19, 1995) (Sixth Amendment requires jury determinations of all "mixed" questions of law and fact that have "typically been resolved by juries").

was invalid because its specification had not adequately described how to make the invention. Lord Mansfield instructed the jury to determine not only whether the device could be made, but also "all objections made to exactness, certainty and propriety of the specification." See I J. OLDHAM, *THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY* 756 (1992) (printing previously unpublished jury instructions from manuscript sources).¹¹

Similarly, in *Turner v. Winter*, 1 T.R. 602, 605 (K.B. 1787), the Court of King's Bench, (the principal common law court of the time), set aside an infringement judgment because the jury had not "fully and fairly examined" whether the patent was vague or misleading. Rather than make those determinations itself, the court remanded the case for a new trial. An influential 1791 authority confirmed that juries, in determining the validity of a patent, also must determine "[t]he meaning of the specification." F. BULLER, *supra*, note 8 at 76.¹²

¹¹ Because of the incomplete and unofficial nature of court reporting in England in the late 18th century, it was common for manuscripts of noteworthy cases to be circulated among the judges and lawyers. I THE MANSFIELD MANUSCRIPTS at 104. Other sources confirm the particular significance of the *Liardet* case. See E. W. Hulme, "On the History of the Patent Law in the 17th and 18th Century," 18 LAW QUARTERLY REVIEW 280, 317-18 (1902).

¹² Francis Buller was a Justice on the King's Bench between 1778 and 1794. His work on trial practice, *Nisi Prius*, was widely used and respected. See, e.g., XII W. HOLDSWORTH, A HISTORY OF ENGLISH LAW 354 (1938) ("a good deal more than a book of practice").

Cases involving other grants under the Statute of Monopolies, *see supra*, note 8, held explicitly, before 1791, that juries must resolve relevant interpretive disputes. For example, in *Collins v. Sawrey*, 4 Bro. P.C. 692, 699 (H.L. 1772), the House of Lords rejected an argument that the "construction" of a charter, because it depended on "written evidence," should not have been "tried ... by a jury" (emphasis in original). Similarly, in *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102, 108 (K.B. 1774), the Court held that a dispute about the interpretation of a charter "is a question of fact" and "therefore most proper to be left to the decision of the jury."

Subsequent English cases reiterated that this settled practice applies to patents. In *Neilson v. Harford*, Webster Patent Cas. 295, 370 (1841), the Court of Exchequer (also a common law court) explained that while a judge must "construe all written instruments," the "true meaning of the words in which they are couched, and the surrounding circumstances, if any," must be "ascertained by the jury." The *Neilson* Court agreed that it was "peculiarly the province of a jury" to construe "as matters of fact" patent terms that might constitute "words of art, words of commerce [and] words which are used in some sense different from their ordinary sense." *Id.* at 367.

In *Washburn v. Gould*, 29 Fed. Cas. 312 (C.C.D. Mass. 1844), Justice Story summarized the English practice. Citing *Neilson*, he explained that while courts would construe the legal effect of patents, juries would determine their meaning:

[T]he jury are to judge the meaning of words of art, and technical phrases, in commerce and manufactures, and of

the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification.

Id. at 325. The historical record, which to our knowledge is uncontroverted, confirms Justice Story's conclusion.

Citing no contrary historical precedent, the majority below argued that all of these cases are irrelevant simply because of "manifest differences in patent law in eighteenth century England and patent law as it exists today in Title 35 of the United States Code." 45a. That reasoning is flawed on several grounds. To begin with, "manifest differences" cannot be dispositive for purposes of Seventh Amendment analysis, which requires identifying not an identical English claim or issue that was tried to a jury, but only an "analogous" one. *See Nordberg*, 492 U.S. at 42. Moreover, the court's analysis does not address how any such "manifest differences" would affect the specific question at issue here - whether judges or juries should construe patents. Finally, the only difference cited by the Court -- that use of the word "claim" originated in American law 45a -- is a distinction of pure semantics, and of no substance.¹³

¹³ Under eighteenth-century English law, a patent was required to contain a "specification" that would particularly describe the nature of the invention and would enable "'mechanics'" to "'make the machine by following the directions of the specification,'" J. OLDHAM, *supra*, at 732 (quoting jury instructions by Justice Buller in *Rex v. Arkwright*, as given at pp. 172-73 of the printed proceedings in the case, and as reprinted at *Carpmael Patent Cas.* 79, *Webster Patent Cas.* 66 and *Davies Patent Cas.* 106.) Under modern American law, a patent must contain (1) a "claim" "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention"; and (2) a "specification" that describes the invention "in such full, clear, concise, and exact terms as

(continued...)

The historical record appears uncontroverted that in England in 1791, juries interpreted patent terms in infringement cases. The Federal Circuit erred in holding that the Seventh Amendment does not guarantee the same jury determinations today.

2. The Holding Below Is Inconsistent With Precedent From This Court.

Citing but not analyzing ten of this Court's decisions, the Federal Circuit asserted that "construction of a patent claim is a matter of law exclusively for the court." 25a-26a. Actually, those cases establish a nearly opposite proposition - that construction or interpretation of a patent is a factual question for the jury, at least if the parties introduce live testimony or other extrinsic evidence. While none of these cases addressed the Seventh Amendment explicitly, they further undercut the constitutional holding below, since the Amendment unquestionably attaches to all infringement issues properly identified as "factual." *See, e.g., Walker v. Southern Pacific R.R.*, 165 U.S. at 596.

In *Bischoff v. Wethered*, 76 U.S. (9 Wall) 812 (1870), a validity determination turned on whether two patents were identical. This Court held that the jury must decide that question and in so doing, of course, must interpret both

¹³(...continued)

to enable any person skilled in the art ... to make and use the same." 35 U.S.C. § 112. These requirements are substantively identical, regardless of whether the relevant descriptions appear in text entirely denominated as a "specification" (as in older English law) or in text denominated in part as a "claim" and in part as a "specification" (as in modern American law). A semantic distinction unrelated to the substance of the interpretive issue in dispute cannot rewrite history or abrogate the constitutional right to jury trial.

patents. The Court endorsed the "common practice" for making such determinations: to submit to the jury expert testimony regarding "the nature of the various mechanisms or manufactures described in the different patents produced." *Id.* at 814. Moreover, while noting that courts might set aside clearly incorrect verdicts "as against the weight of evidence," this Court stressed that "in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the Court." *Id.*¹⁴

In *Heald v. Rice*, 104 U.S. 737 (1882), a validity defense turned on whether a reissued patent and an original one were identical. This Court interpreted the two patents because their language was "clear" with respect to identity. *See id.* at 749. Moreover, the Court distinguished *Bischoff* on precisely that ground: "if it appears from the face of the instruments that extrinsic evidence is not needed to explain

¹⁴ The Federal Circuit attempted to distinguish *Bischoff* as a case involving "a question of invalidity in a breach of contract action." 54a. But the Court failed to explain why, if juries interpret patents in that context, they should not also interpret patents in the context of infringement determinations. Moreover, the purported distinction between contract claims and patent claims cannot explain *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), in which this Court applied *Bischoff* in the context of a patent claim. *Id.* at 456 ("the resemblance [of the two patents] was close enough to require submission of the question of identity to the jury, and the admission of the testimony of experts on that subject"). Finally, the purported distinction between validity and infringement determinations is especially bizarre, since the Federal Circuit has consistently held that patents must be interpreted identically for both purposes. *See, e.g., Intervet America, Inc. v. Kee-Vet Lab., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989) ("claims must be given the same construction when considering infringement as when considering validity." (emphasis in original)); *Smithkline Diagnostics* 859 F.2d at 882. (same).

terms of art," the Court said, construction or interpretation "consequently is [a] matter of law for the Court." *Id.* (emphasis added). *See also Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (patent construction presents a "matter of law for the court" where "[n]o extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject matter") (citing *Heald*); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (construing patent as a matter of law because "it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter") (citing *Heald* and *Market Street Cable*).

Virtually every other case cited by the majority below is a close variant of *Heald* and its progeny. For example, in *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), this Court construed as a matter of law a patent whose "language" presented "no difficulty" with respect to the interpretive question at issue. In *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1859), this Court imposed as a matter of law the "only construction" of which the patent was "capable." And in *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877), this Court construed as a matter of law a patent whose "[w]ords" could "not show more plainly" which interpretation was proper.¹⁵

¹⁵ The majority below cited three cases that simply do not address the question presented here. 25a. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1853), this Court merely stated the hornbook rule that a combination patent cannot be infringed unless the defendant duplicates every necessary element of the combination, *see, e.g., A. MILLER & M. DAVIS, INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND* (continued...)

None of these cases undercuts the Seventh Amendment protection for patent interpretation issues that a proper historical analysis would establish. As the Federal Circuit explained, extrinsic evidence cannot "enlarge, diminish or vary" the terms of a patent, but can only aid in their interpretation. 33a. Where the terms themselves are clear without resorting to extrinsic evidence, there is simply no genuine interpretive dispute for a jury to determine. In that situation, the Seventh Amendment has never prevented courts from making the relevant determination as a matter of law. *See, e.g., Galloway v. United States*, 319 U.S. 372, 388-93 (1943) (Seventh Amendment does not prevent directed verdict); *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 319-21 (1902) (Seventh Amendment does not prevent summary judgment).

3. The Policy Arguments Advanced Below Are Constitutionally Irrelevant And Unsound.

Ultimately the holding below rested on a series of policy-based and theoretical arguments purportedly showing that judges should interpret patents as a matter of law. These arguments cannot succeed, because all relevant Seventh

¹⁵(...continued)

COPYRIGHT 124 (2d ed. 1990), and then remanded for a factual determination of what elements were necessary to the patent at issue. *Silsby*, 55 U.S. at 225-26. *Winans v. Denmead*, 56 U.S. (15 How.) 330, 339 (1854), involved a patent for railroad cars shaped as "a frustrum of a cone." The meaning of that term was undisputed, and this Court addressed only the question of how close to a perfect cone (which exists only as an abstract mathematical concept) a car must be in order to infringe. *Id.* at 343-44. *Coupe v. Royer*, 155 U.S. 565 (1895), held that a district court had erred in failing to instruct the jury that the patent at issue encompassed only a "vertical" rotary shaft -- a critical but unambiguous element of the invention at issue. *Id.* at 574-75, 579-80.

Amendment considerations are historical. *See, e.g., Tull v. United States*, 481 U.S. 412, 417-18 (1987); *Dimick*, 293 U.S. at 476. The Seventh Amendment does not permit abridging the right to jury trial because of some perceived advantage of a decision by the judge rather than the jury. These considerations reflect a lack of confidence in juries not shared by the framers of the Constitution. Even on their own terms, however, they are without merit.

First, the majority asserted that judges must interpret patents in order to ensure predictability. 28a. But the court failed to explain how judicial determinations would advance that interest to any significant degree. To begin with, the principal source of unpredictability in this context -- use of live testimony or other extrinsic evidence to augment the fixed text and prosecution history -- is a settled practice that the majority opinion below embraced, 33a, and that will continue regardless of whether interpretive authority is vested in courts or juries. Moreover, there is nothing unusual or anomalous about elaborating upon legal duties through case-by-case jury determinations -- as routinely occurs, for example, in the context of negligence. *See, e.g., McAllister v. United States*, 348 U.S. 19, 20-22 (1954).¹⁶

¹⁶ That process also can occur in the specific context of infringement determinations that turn on questions of patent interpretation: if a plaintiff prevails under an expansive interpretation, then prospective defendants learn about a grave risk of liability unless they conform their conduct accordingly; and if a plaintiff loses under a narrow interpretation, then prospective defendants may bar the plaintiff, under ordinary principles of issue preclusion, from asserting the broad interpretation in subsequent litigation. *See, e.g., Blonder-Tongue Lab., Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971).

Second, the majority below asserted that judicial interpretation will ensure accuracy. 28a-29a. To the extent the court rested on the proposition that judges "trained in the law" are expert at analyzing often scientifically complex items such as the text of a patent and its "associated public record," its analysis ignores that a factual issue exists only if these materials require explanation to determine their meaning to one with ordinary skill in the art, at which point live and extrinsic testimony becomes appropriate, and even essential. *See, e.g., Moeller*, 794 F.2d at 657 (trial court's refusal to permit expert testimony regarding interpretation of claim terms as understood by one skilled in the art was abuse of discretion.) Alternatively, to the extent the court rested on the proposition that judges are simply better at assessing complicated trial testimony, its reasoning is inconsistent with an additional bedrock Seventh Amendment principle -- that the amendment contains no exception for complexity. *See, e.g., Slocum v. New York Life Ins. Co.*, 228 U.S. 364, 388 (1913) (applicability of the Seventh Amendment is "not a question of whether the facts are difficult or easy of ascertainment").¹⁷

Third, the majority asserted that jury determinations are inappropriate because extrinsic evidence cannot "enlarge, diminish or vary" the text of a patent, but can only "assist in its construction." 33a; 36a. That is a simple *non sequitur*.

¹⁷ In recent years, litigants have attempted to create a complexity exception to the Seventh Amendment, but the courts of appeals have refused. *See, e.g., United States v. Torniero*, 735 F.2d 725, 734 (2d Cir. 1984), *cert. denied*, 469 U.S. 1110 (1985); *In re U.S. Fin. Sec. Litig.*, 609 F.2d 411, 432 (9th Cir. 1979), *cert. denied*, 446 U.S. 929 (1980). *Cf. Blonder-Tongue Lab.*, 402 U.S. at 331-32 (no complexity exception to issue preclusion in patent context).

In many areas of law, juries assess extrinsic evidence that cannot modify a legally operative document, but can nonetheless help clarify its terms. *See, e.g., Goddard v. Foster*, 84 U.S. (17 Wall.) 123, 142 (1872) (contract); *Reed v. Proprietors of Locks & Canals*, 49 U.S. (8 How.) 274, 289 (1850) (deed).

Fourth, the majority asserted that patents are more analogous to statutes, whose meanings are resolved by courts as a matter of law, than to contracts, whose disputed terms are determined by juries as a matter of fact. 51a-52a. This Court, however, has analogized patents to contracts or deeds. *See, e.g., Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (contract); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (deed). Moreover, the analogy between statutory construction and patent interpretation, comparing statutory text to patent claims, and legislative history to prosecution history, is very limited. 51a-52a. The analogy breaks down when those sources are unclear, for while no court would permit legislators (or experts) to present testimony about the meaning of a statute, courts routinely permit experts and inventors to testify about the meaning of a patent, as the Federal Circuit acknowledged. 12a.¹⁸ In that critical respect, patents are indeed more like contracts than like statutes.

¹⁸ Such live testimony is necessary because patents bear the meaning ascribed to them not by generalist judges, but by persons skilled in the relevant art. *Smithkline Diagnostics*, 859 F.2d at 882 (expert testimony is relevant to claim construction because "claims should be construed as one skilled in the art would construe them"); *Moeller*, 794 F.2d at 657 (expert testimony as to the meaning of claim terms required because "the test of claim interpretation is directed to one skilled in the art").

Statutes are not interpreted by a trial process where evidence is weighed and credibility and demeanor evaluated; that is an important reason why statutes can be interpreted by an appellate court as well as a district court judge. The process of weighing evidence and evaluating credibility is the method for resolving disputes of facts. It turns jurisprudence on its head to characterize that process as the way to decide a question of law. This settled method for finding facts cannot be magically transformed into an issue of law by simply saying so.¹⁹ A change of label cannot change the substance. In jury trials, finding of facts on the merits is for the jury as mandated by the Seventh Amendment.

Finally, to the extent that policy arguments are relevant, the court below ignored compelling ones against its result. In characterizing patent interpretation questions as legal, the Federal Circuit was forced to vest ultimate interpretive authority not with the various district courts, but with itself. 44a n.13 ("[W]e review court determinations on questions of claim construction under a *de novo* standard of review, like other legal questions"). It is perhaps debatable, at least as a policy matter, whether district judges or juries are better

¹⁹ Characterizing the interpretation of a term in a patent as a legal issue cannot avoid the reality that considering testimony requires weighing evidence and deciding credibility. After the holding below, a district judge, in struggling with the near impossible task of complying with it, emphasized "When two experts testify differently as to the meaning of a technical term, and the court embraces the view of one, the other, or neither while construing a patent claim as a matter of law, the court has engaged in weighing evidence and making credibility determinations." *Lucas Aero., Ltd. v. Unison Indus., L.P.*, 1995 U.S. Dist. LEXIS 8414 at *8 n.7 (D. Del. June 2, 1995). When evidence is weighed and credibility is evaluated, the judge is resolving a factual dispute, not deciding an issue of law. The substance of the inquiry must control.

situated to make determinations requiring an evaluation of conflicting live testimony. It is little short of absurd, however, to imagine that the United States Court of Appeals for the Federal Circuit is better situated than are the triers of fact (whether judge or jury) to make such determinations. Thus, the court erred badly even assuming that this case involves nothing more than a subconstitutional question about appropriate standards of review. See, e.g., *Pierce v. Underwood*, 487 U.S. 552, 560 (1988) (standard of review turns on who is "better positioned ... to decide the issue in question" (citation omitted)).

B. The Seventh Amendment Question Is Both Recurring and Important.

This Court also should grant *certiorari* because the Seventh Amendment question addressed below is both recurring and important.²⁰

²⁰ The importance of this issue was confirmed by the extraordinary proceedings below. This appeal was argued before a panel on May 8, 1992 which issued no opinion or decision. Rather, on November 5, 1993, the Federal Circuit, *sua sponte*, ordered that this appeal be heard by the court *en banc*. 162a. On January 7, 1994, the Federal Circuit entered an order acknowledging that the appeal raised "significant issues relating to interpretation of a claim in a patent". That order set forth four questions for additional briefing which related to the respective roles of the judge and jury on issues of patent claim construction and invited amicus briefs, seven of which were submitted. 164a-167a. Oral argument was heard before the Federal Circuit *en banc* on May 4, 1994. On April 5, 1995 (three years after the argument before the panel), the Federal Circuit issued the lengthy opinions contained in the Appendix. These special efforts reflect the important, far reaching and highly contentious issue up for consideration, which became even more important when the majority curtailed the right to jury trial.

To begin with, the constitutional right to jury trial "has always been an object of deep interest and solicitude, and every encroachment upon it has been watched with great jealousy". *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 446 (1830). Any effort to restrict that right is a matter of first importance deserving careful scrutiny and providing sufficient ground to warrant review by this Court. See *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 501 (1959) ("[w]e granted *certiorari* because '[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care,'" quoting *Dimick v. Schiedt*, 293 U.S. at 486). This is all the more so when a curtailment of that right is a pervasive one imposed by a court of appeals with exclusive appellate jurisdiction of all patent infringement cases nationwide. 28 U.S.C. § 1295(a)(1). Thus, the dubiously narrow reach afforded the Seventh Amendment by the majority below -- at the very least a "seeming curtailment of the right to a jury trial" -- warrants immediate review by this Court.²¹

Moreover, the Seventh Amendment question is a recurring one. Questions of interpretation arise in every infringement case, since a jury cannot determine whether a patent

²¹ Even in cases involving relatively mundane matters such as *vacatur*, this Court has acknowledged the special significance of the Federal Circuit's patent decisions for purposes of *certiorari*. See *Cardinal Chemical Co. v. Morton*, 113 S. Ct. 1967, 1971 (1993) ("Because the Federal Circuit has exclusive jurisdiction over appeals from all United States District Courts in patent litigation, the rule that it applied ... is a matter of special importance to the entire Nation. We therefore granted *certiorari*.").

was infringed or is invalid unless it first knows what the patent means. Unsurprisingly, the question of meaning is often dispositive, see, e.g., *Singer Mfg. Co.*, 192 U.S. at 286; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1878), as it was in this case and as Judge Mayer noted below. 61a. ("[T]o decide what the claims mean is nearly always to decide the case."). Thus, the decision below threatens, in the words of Judge Mayer, to "eject [t]uries from infringement cases." 57a. It is hard to overestimate the mischief of the holding below.²²

Prompt review is also important because the decision below has already created and will create significant confusion, practical difficulties and waste of judicial and other resources.²³ For example, in pending cases where juries have already interpreted patents, district judges nationwide must determine whether to undertake complex and expensive re-trials or to attempt, belatedly, to weigh evidence and make credibility determinations without giving deference to

²² In the fiscal years 1992-1994, 163 of 274 patent trials were tried to a jury. In the fiscal year 1994, 70% of patent trials were tried to juries. Statistics taken from Annual Reports of the Director of Administrative Office of the United States Courts. Of course, many more patent jury cases were settled.

²³ The extraordinary nature of the issue and the confusion created by the majority below is also confirmed by decisions of panels of the Federal Circuit which contemporaneously continued to recognize interpretation of patent terms as factual inquiries. See *Petition for Certiorari, United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081, at 3-8 (discussing *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-1386 (Fed. Cir. Feb. 14, 1995)). See also *Pirkle v. Ogontz Controls Co.*, No. 94-1454 (Fed. Cir. April 6, 1995)). Petitioners are advised that a petition for writ of *certiorari* will be filed in *Pirkle*. The continuing confusion and controversy can only be eliminated by this Court.

existing jury findings. Moreover, in cases yet to be tried, district judges must determine exactly how, if at all, they are to make such interpretative determinations. On the one hand, credibility assessments are the "necessary precursors to the acceptance or rejection of testimonial evidence from competing experts." *Lucas Aero.*, 1995 U.S. Dist. LEXIS 8414 at *3 n.3. But on the other hand, the decision below might stand for the bizarre proposition that:

because claim construction presents a purely legal question, trial judges must ignore all non-transcribable courtroom occurrences such as a witness's body language, inability to maintain eye contact when confronted with a telling question, hesitance or delay in giving an answer, an affirmative answer in a voice revealing the truthful answer is "no," or the changing demeanor of a witness when shifting from sure to treacherous footing.²⁴

Id. The decision below creates yet another "practical problem" that at least one court "confessedly does not know

²⁴ See *supra.*, note 19. This experienced trial judge, obviously frustrated at being forced by the majority below to treat a factual inquiry involving credibility as a question of law, pointedly said: "But when the Federal Circuit Court of Appeals states that the trial court does not do something [weighing evidence and making credibility determinations] that the trial court does and must do to perform the judicial function, that court knowingly enters a land of sophistry and fiction." *Lucas Aero., Ltd. v. Unison Indus., L.P.*, 1995 U.S. Dist. LEXIS 8414 at *8 n.7. He went on to make clear that "bound by slavish adherence to the fiction that a judge does not make credibility determinations when confronted with testimonial extrinsic evidence en route to pronouncing the 'true' meaning of a patent claim," his opinion was crafted so to omit reference to necessary and inevitable "credibility assessments" which he had made. *Id.* When experienced district judges believe that they are being thrust into a world of make believe, it is time for this Court's intervention.

how to solve": how to "construe claims as a matter of law at the close of evidence without disrupting the jury." *Id.* at 11 n.3. Deferring review on the underlying Seventh Amendment question would simply allow these collateral questions to multiply needlessly in the likely event that petitioners' position has merit.²⁵

Finally, this case implicates questions related to *American Airlines v. Lockwood*, No. 94-1660 (petition for *certiorari* granted June 5, 1995).²⁶ *Lockwood* presents the question whether the Seventh Amendment requires a jury trial in a declaratory judgment action to have a patent declared invalid.²⁷ But that question has little practical significance if this case remains unreviewed, for while the Seventh Amendment might apply to the relatively small class of declaratory judgment counterclaims asserting patent invalidity at issue in *Lockwood*, the decision below would nonetheless eliminate the jury from the much larger category of cases where infringement or validity determinations turn on

²⁵ While delay is sometimes justified to permit further "percolation" in the courts of appeals, that consideration is inapplicable where, as here, the Federal Circuit's nationwide and exclusive jurisdiction is at issue. See *Cardinal Chemical Corp.*, 113 S. Ct. at 1971.

²⁶ *Lockwood* has since waived his right to a jury trial and seeks dismissal suggesting mootness.

²⁷ Unlike the majority below, the Federal Circuit panel which decided *Lockwood* engaged in thorough and correct historical analysis of the relevant English precedent. *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995), *petition for cert. granted, sub. nom., American Airlines v. Lockwood*, (U.S. No. 94-1660, June 5, 1995). See also W. HANDS, *THE LAW AND PRACTICE OF PATENTS FOR INVENTIONS*, 16-17 (1808) (describing English practice).

the meaning of genuinely disputed patent terms. As Judge Nies noted in dissenting from denial of rehearing below in *Lockwood*, "[n]o more important nor contentious an issue arises in patent law jurisprudence than the appropriate role of juries in patent litigation." *In re Lockwood*, 50 F.3d 966, 980-81 (Fed. Cir. 1995), *petition for cert. granted, sub. nom., American Airlines v. Lockwood*, (U.S. No. 94-1660, June 5, 1995). The question presented here, which affects not only declaratory judgment counterclaims filed by alleged infringers but also every infringement case in which a jury is demanded, is vastly more significant than the one presented in *Lockwood*.

CONCLUSION

The Petition for a Writ of *Certiorari* should be granted.

Dated: July 3, 1995

Respectfully submitted,

Of Counsel

Lewis F. Gould, Jr.
Stephan P. Gribok
Eckert Seamans Cherin
& Mellott
1700 Market Street
Suite 3232
Philadelphia, PA 19103

William B. Mallin
Counsel of Record
Timothy P. Ryan
Timothy S. Coon
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

APPENDIX

Appendix A

United States Court of Appeals for the Federal Circuit

92-1049

**HERBERT MARKMAN and
POSITEK, INC.,**

Plaintiffs-Appellants,

v.

**WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,**

Defendants-Appellees.

William B. Mallin, Eckert, Seamans, Cherin & Mellott, of Pittsburgh, Pennsylvania, argued for plaintiffs-appellants. With him on the brief were Lewis F. Gould, Jr., Timothy P. Ryan and Brian M. Martin.

Frank H. Griffin, III, Gollatz, Griffin, Ewing & McCarthy, of Philadelphia, Pennsylvania, argued for defendants-appellees. With him on the brief were Peter A. Vogt and Polly M. Shaffer.

Morton Amster, Anthony F. LoCicero, Joel E. Lutzker and David H. Kagan, Amster, Rothstein & Ebenstein, of New York, New York, Attorneys for Amici

Curiae, Matsushita Electric Corporation of America and Matsushita Electric Industrial Co., Ltd.

Gregory A. Long and Kent R. Raygor, Sheppard, Mullin, Richter & Hampton, of Los Angeles, California, Charles Fried and Arthur R. Miller, of Cambridge, Massachusetts, Donald Chisum, Morrison & Foerster, of Seattle, Washington and William Alsup, Morrison & Foerster, of San Francisco, California, Attorneys for Amicus Curiae, Acuson Corporation and Honeywell, Inc.

R. Carl Moy, Assistant Professor, William Mitchell College of Law, of Saint Paul, Minnesota, Attorney for Amicus Curiae R. Carl Moy.

Sidney David, Charles P. Kennedy, William L. Mentlik and Roy H. Wepner, Lerner, David, Littenberg, Krumholz & Mentlik, Attorneys for Amici Curiae, Ohmeda, Inc.

S. Leslie Misrock, Rory J. Radding, Steven I. Wallach, Pennie & Edmonds, of New York, New York, Attorneys for Amicus Curiae, Ad Hoc Committee to Promote Uniformity in the Patent System.

Gary L. Newton, President, American Intellectual Property Law Association, of Arlington, Virginia, Roger W. Parkhurst, Parkhurst, Wendel & Rossi, of Alexandria, Virginia, Harold C. Wegner, Wegner, Cantor, Mueller & Player, of Washington, D.C., and Nancy J. Linck, Cushman, Darby & Cushman, of Washington, D.C.

Roy E. Hofer, President, The Federal Circuit Bar Association, of Washington, D.C., Anne E. Brookes, Honigman Miller Schwartz & Cohn, of Houston, Texas and Robert J. Carlson, Christensen, O'Connor, Johnson & Kindness, of Seattle, Washington, Attorneys for Amicus Curiae, Federal Circuit Bar Association.

Appealed from: U.S. District Court for the
Eastern District of Pennsylvania

Judge Katz

United States Court of Appeals for the Federal Circuit

92-1049

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

DECIDED: April 5, 1995

Before ARCHER, Chief Judge,* and RICH, NIES,
NEWMAN, MAYER, MICHEL, PLAGER, LOURIE,
CLEVINGER, RADER, and SCHALL, Circuit Judges.**

*Chief Judge Archer assumed the position of Chief Judge on March 18, 1994.

**Circuit Judge Bryson joined the Federal Circuit on October 7, 1994 and has not participated in the disposition of this appeal.

Opinion for the Court filed by Chief Judge ARCHER, in which Circuit Judges RICH, NIES, MICHEL, PLAGER, LOURIE, CLEVINGER, and SCHALL join. Concurring opinions filed by Circuit Judges MAYER, and RADER. Dissenting opinion filed by Circuit Judge NEWMAN.

ARCHER, Chief Judge.

Herbert Markman and Positek, Inc. (collectively referred to as Markman) appeal from the judgment of the United States District Court for the Eastern District of Pennsylvania, Civil Action No. 91-0940 (entered Oct. 1, 1991), that Westview Instruments, Inc. and Althon Enterprises, Inc. (collectively referred to as Westview) did not infringe claims 1 or 10 of United States Reissue Patent No. 33,054, notwithstanding the jury's verdict to the contrary. We have ordered that this case be reheard in banc.¹ We affirm the judgment of noninfringement. In doing so, we conclude that the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court. Thus, in this case the district court properly discharged its obligation to delineate the scope of the claim on motion for judgment as a matter of law when the jury had rendered a verdict that was incompatible with a proper claim construction.

¹A panel of this court heard oral argument in the appeal. On November 5, 1993, this court ordered sua sponte that the appeal be reheard in banc. The court also requested additional briefing and has been helped by the supplemental briefs of the parties and by the several briefs amicus curiae.

I.

A. In the dry-cleaning industry, articles of clothing typically are taken in from customers, recorded in some form, and then sorted according to criteria such as type of clothing and type of cleaning required. During the sorting process, articles of clothing belonging to one customer may be combined together, and also may be combined with similar clothing belonging to other customers, in order to make the cleaning process more efficient and less costly. After the articles of clothing are sorted, they may be cleaned in the same establishment or transported to another establishment for cleaning. During the cleaning process, the articles of clothing move through different locations in the establishment. After cleaning, of course, the articles of clothing must be unsorted and returned to the respective customers.

Markman is the inventor named in and the owner of United States Reissue Patent No. 33,054 (the '054 patent), titled "Inventory Control and Reporting System for Drycleaning Stores." Markman's original patent No. 4,550,246 was reissued and the reissue is the patent in suit. Positek is a licensee under the patent in the dry-cleaning business.

The '054 patent is directed to an inventory-control system that assertedly solves inventory-related problems prevalent in the dry-cleaning business. As the '054 patent specification discusses, articles of clothing can be lost in the sorting and cleaning process, and it has been found in the dry-cleaning business that even a small percentage-loss of

articles of clothing will generate great consumer dissatisfaction. Also, attendant personnel might send clothing through the cleaning process but pocket the proceeds of the transactions and destroy or fail to do the appropriate paperwork, thereby servicing the customers adequately but stealing from the business. In such circumstances it is difficult for the business owner to locate the loss of profits and to deter such activities.

The invention of the '054 patent is described in detail in the specification which states that the inventory control system is "capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment," and that by using the invention of the '054 patent, "the progress of articles through the laundry and drycleaning system can be completely monitored." In this way, the business owner can "reconcile[] [the inventory] at any point in the sequence" of sorting, cleaning, and unsorting clothing, and can "detect and localize spurious additions to inventory as well as spurious deletions therefrom."

According to the specification's description of the invention, as customers bring in their articles of clothing for cleaning, the articles are accumulated by an attendant. The attendant enters information on a keyboard identifying at least the particular customer, the type of articles being deposited, and the particular cleaning operations to be performed. Other information may be entered depending upon the complexity of the system.

A data processor stores and processes the data entered by the attendant, associating sequential customers and transactions with a unique indicium such as a number. The processor is connected to a printer that generates a written record of the stored information associated with the particular customers and transactions. No transaction can proceed without generating a written record, thereby ensuring that each transaction is accounted for.

The patent specification specifies that the written record is to have different portions. For example, the written record includes a customer ticket or receipt, a management ticket copy, and a plurality of article tags. The article tags are to be attached to individual articles or groups of articles in inventory. The management ticket and the article tags contain a bar code and a unique indicium such as a number associated with a customer, transaction, and other information. The bar code records are custom printed sequentially, as sequential customer transactions occur. The tags thus not only associate a bar code with transactions, but also with an article or group of articles, persons, physical items in inventory, and other information again depending upon the system's complexity.

Optical detector devices are then used to read the bar code indicia, and they may be located at various points in the cleaning process, including at least at the customer service station. The articles are logged through a particular station by scanning the tags containing the bar codes with the detector. The bar codes are used to call up information associated with the customer or transaction, and used to generate reports containing information such as the location

of articles within the system, the number of articles located at a particular point in the system, etc. Obviously, the more optical detectors, the tighter the inventory control. After the articles have been processed, optical detection of the bar codes can be used to reorganize the articles into customer packages. The overall result is that additions to and deletions from inventory can be located -- wherever an optical detector appears -- and can be associated with particular customers and articles of clothing. In this way the inventory can be fully reconciled.

In claim 1, the only independent claim involved in this appeal, Markman claims his invention to be (emphasis added):

1. The inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions;

a data processor including memory operable to record said information and

means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

In dependent claim 10, Markman specifies that in the invention of claim 1, the input device is an alpha-numeric keyboard wherein single keys may be used to enter attributes of items being entered.

B. Markman sued Westview and Althon for infringement of claims 1, 10, and 14 of the '054 patent. Westview makes and sells specialty electronic devices, including the system accused of being an infringement of the '054 patent. Althon owns and operates two dry-cleaning sites and uses Westview's device in one of its shops.

The accused Westview device consists of two separate pieces of equipment, which Westview calls the DATAMARK and the DATASCAN. The DATAMARK is a stationary unit comprising a keyboard, electronic display, processor, and printer. When a customer brings articles of clothing in for cleaning, an attendant enters on a keypad information about the customer, articles to be cleaned, and charges for the cleaning. The DATAMARK then prints a bar-coded ticket or invoice listing the information about the customer, the clothes to be cleaned, and the charges for the cleaning. The DATAMARK retains permanently in memory only the invoice number, date, and cash total. The DATAMARK is thus used to print bar-coded tickets for the articles and to retain an invoice list.

The DATASCAN is a portable unit comprising a microprocessor and an optical detector for reading bar-coded tickets or invoices at any location in the dry-cleaning establishment. To use the DATASCAN, first the invoice list is transferred from the DATAMARK to the DATASCAN. Then, the DATASCAN is carried about to read the bar-codes on tickets or invoices in the establishment. As it does this, it can report any discrepancy between the particular invoice read (or not read) and the invoice list. In this way the DATASCAN identifies extra or missing invoices.

C. At a jury trial on the issue of infringement, Markman presented the testimony of four witnesses: (1) an expert on bar-code technology who testified about the manner in which Westview's device operates, (2) Markman, the inventor, who testified about his patent and its claims, (3) a "patent expert" -- that is, a practicing patent lawyer -- who testified in his capacity as a patent lawyer about the meaning of the claim language and how the claims allegedly read on the accused system, (4) an accountant who testified as to the number of allegedly infringing systems sold. Also included in evidence were the actual Westview device and its operating manuals, brochures, and computer program. At the conclusion of Markman's case in chief, Westview moved for a directed verdict.² The district court deferred ruling on the motion. Westview then presented the testimony of a single witness, its president, who demonstrated the operation of the Westview device and testified about its capabilities.

²"Directed verdict" has since been renamed "judgment as a matter of law" and is hereinafter referred to as such. See Fed. R. Civ. P. 50.

The district court charged the jury on infringement, instructing it to "determine the meaning of the claims . . . using the relevant patent documents including the specifications, the drawings and the file histories." The court continued that "[a]lso relevant are other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art." The court then instructed the jury to compare the claims with the Westview device to determine if it infringes. The jury returned answers to general interrogatories finding that Westview infringed independent claim 1 and dependent claim 10 but did not infringe independent claim 14.³

The district court then heard argument on and granted Westview's deferred motion for judgment as a matter of law (JMOL). Stating that claim construction was a matter of law for the court, the district court provided its construction of the claims. The court held that "inventory" as used in the claims meant "articles of clothing" and not simply transaction totals or dollars. Under the district court's construction, the claims require that the system be able to track articles of clothing through the dry-cleaning process, detect and localize missing and additional articles of clothing, and generate reports about the status and location of the articles of clothing. It is undisputed that Westview's system is incapable of doing this because it does not retain information regarding the particular articles of clothing, but rather only a listing of the invoices and the cash total of the inventory. Among other things, the court concluded that

³The finding of noninfringement of independent claim 14 is not at issue in this appeal.

Westview's device does not have the "means to maintain an inventory total" required by claim 1, and cannot "detect and localize spurious additions to inventory as well as spurious deletions therefrom," and directed a verdict of noninfringement of claims 1 and 10.

II.

A. Markman appealed from the district court's grant of JMOL of noninfringement of claims 1 and 10. In this court, Markman's principal argument is that the district court erred in granting the JMOL, stating:

Requiring the jury to interpret certain terms of the patent was quite proper, and indeed required, as the meaning of certain terms of Claim 1 was contested at trial. See Polumbo v. Don-Joy Co. [sic.], 762 F.2d 969, 974, 226 USPQ 5, 8 (Fed. Cir. 1985) (when the meaning of a claim term is disputed a "factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction.")

.....

Despite entrusting the jury with interpreting the

claim, the trial court thwarted [Markman's] right to a jury determination of this factual issue simply because it disagreed with the jury's interpretation. At the root of the district court's astonishing opinion was its mistaken belief that it had a license to re-find the facts and reinterpret the claims as if there were no jury and no jury verdict because, in different appropriate cases, claims of a patent may be interpreted as a matter of law. . . .

. . . . Indeed the deference due to a jury's claim construction was stated positively by this court in Tol-O-Matic L. Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H., 945 F.2d 1546, 1550-52, 20 USPQ2d 1332, 1336-38 (Fed. Cir. 1991).] . . .

.....

. . . . While in appropriate circumstances, claims may be interpreted as a matter of law by the court, in this case the jury was asked to

and did interpret the patent as part of reaching its finding of infringement. Once the jury was assigned this task and rendered its verdict, the trial court was not permitted to discredit the verdict and substitute its evaluation of the evidence for the jury's.

In particular, Markman argues that the district court erroneously substituted its construction of the disputed claim term "inventory" for the jury's implied construction.

As the above quotation shows, Markman contends that the jury was properly given the question of claim construction and that the jury's claim construction and verdict thereon is supported by substantial evidence. The evidence Markman points to in support of the jury verdict is not the language of the patent specification or prosecution history, but rather Markman's own testimony as inventor and the testimony of his patent expert. He also relies on use of the word "inventory" in Westview's product literature and on the testimony of its president. Markman's position essentially is that all the evidence of the meaning of the word "inventory," from the patent, prosecution history, experts, and documents, was properly lumped together and submitted to the jury for it to resolve what in fact is the meaning of "inventory," and that the result of this process is entitled to highly deferential review both by the trial court on motion for JMOL and by this court on appeal from the grant or denial of JMOL.

Setting aside the issue of who properly determines the ultimate scope of the claims, Markman further argues that the district court misconstrued the term "inventory" to mean "articles of clothing" in addition to "cash" or "invoice totals" in order to find that claim 1 defines a system that "tracks" articles of clothing through the dry-cleaning process. Markman says that based on all the evidence presented at trial the term "inventory" as used in claim 1 means "articles of clothing" or "dollars" or "cash" or "invoices," and is not necessarily limited to a construction that always includes "articles of clothing."

Westview on the other hand focuses almost exclusively on the patent and prosecution history to inform the meaning of "inventory." It argues that the patent and prosecution history are in conflict with the testimony and other evidence relied on by Markman and therefore Markman's evidence should be disregarded by the court in favor of the meaning revealed by the patent. This task of assigning the meaning to "inventory," and the meaning assigned are, in the view of Westview, all legal matters for the court and subject to de novo review.

It is undisputed that when the claim term "inventory" is construed to mean "the physical articles of clothing" or to require "articles of clothing" as part of its meaning, the Westview system lacks "means to maintain an inventory total" and does not and cannot "detect and localize spurious additions to inventory as well as spurious deletions

therefrom," as claim 1 would thus require.⁴ Markman's appeal therefore turns on (1) whether the district court acted properly by construing the term "inventory" as a matter of law notwithstanding a contrary construction given the term by some of Markman's witnesses and by the jury, and (2) regardless of whether the court or the jury determines the scope of the claims, whether the term "inventory" requires as part of its meaning "articles of clothing."

B. Where a party moves for JMOL in a case that has been tried to a jury, the district court

must determine whether there exists evidence of record upon which a jury might properly have returned a verdict in [the non-movant's] favor when the correct legal standard is applied. If there is not, [the movant] was entitled to have the question removed from the jury and decided as a matter of law.

Jamesbury Corp. v. Litton Indus. Prods., Inc., 756 F.2d 1556, 1560, 225 USPQ 253, 257 (Fed. Cir. 1985) (emphasis added). On appeal, we review de novo the correctness of the district court's grant of JMOL by reapplying the JMOL

⁴Markman makes much of the distinction between tracking "individual" articles of clothing and tracking "batches" of clothing and says the district court erroneously restricted the invention to the former. For purposes of this appeal, this distinction is irrelevant because Westview's system tracks neither individual articles of clothing nor batches of clothing.

standard. Id.; see Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 762, 9 USPQ2d 1417, 1421 (Fed. Cir. 1988).

Embedded within the above description of JMOL are two aspects. Factual findings made by the jury in arriving at its verdict are to be upheld unless the party moving for JMOL shows that (when the correct legal standard is applied) there is not substantial evidence to support a finding in favor of the nonmovant. See Read Corp. v. Portec, Inc., 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992).

While the jury's factual findings receive substantial deference on motion for JMOL, the legal standards that the jury applies, expressly or implicitly, in reaching its verdict are considered by the district court and by the appellate court de novo to determine whether those standards are correct as a matter of law. Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 660 (1935) ("[A] federal court may take a verdict subject to the opinion of the court on a question of law . . ."); Read Corp., 970 F.2d at 821, 23 USPQ2d at 1431; see Elder v. Holloway, 114 S. Ct. 1019, 1023 (1994) ("[Q]uestion[s] of law . . . must be resolved de novo on appeal."); Bradley v. Secretary of Health and Human Servs., 991 F.2d 1570, 1574 n.3 (Fed. Cir. 1993) ("Legal conclusions are, of course, always reviewed de novo."); Heisig v. United States, 719 F.2d 1153, 1158 (Fed. Cir. 1983); see also Bose Corp. v. Consumers Union of United States, Inc., 466 U.S. 485, 501 (1984) ("[A]n appellate court[] [has] power to correct errors of law, including those that may infect a so-called mixed finding of law and fact, or a finding of fact that is predicated on a

misunderstanding of the governing rule of law."). Notwithstanding the jury's verdict, on review of a motion for JMOL the court retains the power and duty to say what the correct law is, and then to examine the factual issues submitted to the jury and determine whether findings thereon are supported by substantial evidence and support the verdict under the law. Read Corp., 970 F.2d at 821, 23 USPQ2d at 1431; Senmed, Inc. v. Richard-Allan Medical Indus., Inc., 888 F.2d 815, 818, 12 USPQ2d 1508, 1511 (Fed. Cir. 1989); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1550, 220 USPQ 193, 200 (Fed. Cir. 1983).⁵

Since matters of law must be reviewed *de novo* and matters of fact must be accorded substantial deference, the review of a grant of JMOL requires careful distinction between fact and law. In this case which involves claim construction and a grant of JMOL of noninfringement based on claim construction, in order to determine whether that grant was correct, we must distinguish law from fact.

C. An infringement analysis entails two steps. The first step is determining the meaning and scope of the

⁵The general rule is that in reviewing the law on a properly laid and renewed motion for JMOL, the appellate court is not bound by the instructions given the jury, even if they were not objected to. Boyle v. United Technologies, Corp., 487 U.S. 500, 513-14 (1988) (unobjected to jury instructions are not law of the case for purposes of JMOL); City of St. Louis v. Praprotnik, 485 U.S. 112, 120 (1988); 9 Charles A. Wright & Arthur R. Miller, Federal Practice and Procedure § 2537, at 599-600 (1971). We therefore reject Markman's argument that we must defer to the jury's claim construction simply because the district court instructed the jury to interpret the claims and Westview did not object to this instruction. See Wright & Miller, *supra*, § 2521.

patent claims asserted to be infringed. Read Corp., 970 F.2d at 821, 23 USPQ2d at 1431. The second step is comparing the properly construed claims to the device accused of infringing. *Id.* It is the first step, commonly known as claim construction or interpretation,⁶ that is at issue in this appeal.

III.

A. The opinions of this court have contained some inconsistent statements as to whether and to what extent claim construction is a legal or factual issue, or a mixed issue. Markman cites some of our cases which have statements that claim construction may be a factual or mixed issue, including Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H., 945 F.2d 1546, 1550-52, 20 USPQ2d 1332, 1336-38 (Fed. Cir. 1991), and Palumbo v. Don-Joy Co., 762 F.2d 969, 974, 226 USPQ 5, 8 (Fed. Cir. 1985).

At its inception, the Federal Circuit held that claim construction was a matter of law. Our first opinion deciding a question of claim construction, SSIH Equip. S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 376, 218

⁶The dissenting opinion draws a distinction between claim interpretation and claim construction based on the distinction made in contract law. We do not make the same distinction for, in our view, the terms mean one and the same thing in patent law. See Senmed, Inc. v. Richard-Allan Medical Indus., Inc., 888 F.2d 815, 818, 12 USPQ2d 1508, 1511 (Fed. Cir. 1989); Intervet Am., Inc. v. Kee-Vet Labs., Inc., 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). For consistency we use the term construction when referring to the first step in an infringement analysis.

USPQ 678, 688 (Fed. Cir. 1983) (originally reported at 713 F.2d 746-60), said so explicitly, resting on the authority of Winans v. Denmead, 56 U.S. (15 How.) 330 (1854). Cases following SSIH include Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 770-71, 218 USPQ 781, 788 (Fed. Cir. 1983); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1569-71, 219 USPQ 1137, 1140-42 (Fed. Cir. 1983), and SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1118-22, 1138-40, 227 USPQ 577, 583-86, 596-97 (Fed. Cir. 1985) (in banc).

The first Federal Circuit case to deviate from this precedent and state that claim construction may have underlying factual inquiries that must be submitted to a jury was McGill Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir. 1984). In McGill, the court stated that

[i]f . . . the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, construction of the claims could be left to a jury. Envirotech Corp. v. Al George, Inc., 730 F.2d 753 (Fed. Cir. 1984); cf. Hong Kong Export Credit Insurance Corp. v. Dun & Bradstreet, 414 F. Supp. 153, 157 (S.D.N.Y. 1975). In the latter instance, the jury cannot be directed to the disputed meaning for the term of art. Cf. Butler v. Local Union 823,

International Brotherhood of Teamsters, 514 F.2d 442, 452 (8th Cir.), cert. denied, 423 U.S. 924, 96 S.Ct. 265, 46 L.Ed.2d 249 (1975).

Id. at 672, 221 USPQ at 948. A review of the authority relied on for this statement of law, however, is revealing. In contradistinction to the proposition for which it is cited, Envirotech in fact states "[t]he patented invention as indicated by the language of the claims must first be defined (a question of law), and then the trier must judge whether the claims cover the accused device (a question of fact)." Id. at 758, 221 USPQ at 477 (emphasis added). Thus Envirotech is entirely consistent with the earlier precedent.⁷ The other two cases relied upon, the district court opinion in Hong Kong Export Credit and the Eighth Circuit opinion in Butler, are contract cases. Thus this court's earliest pronouncement of jury triable fact issues in claim construction cites no authoritative support.

Cases following the McGill view of claim construction provide no firmer basis for the view. Nevertheless, a significant line of cases has developed in our precedent stating (although rarely holding) that there may be jury triable fact issues in claim construction, relying on McGill (and its erroneous interpretation of Envirotech) and

⁷The views of the "special concurrence" in Envirotech, contending that the claims on appeal had been properly submitted to the jury and were not reviewed de novo on appeal, were not adopted by the majority opinion. 730 F.2d at 763, 221 USPQ at 481 (Baldwin, J., specially concurring.) Accordingly, the concurrence's "spin" on the case is not the position of the court.

its progeny. See Bio-Rad Labs, Inc. v. Nicolet Instrument Corp., 739 F.2d 604, 614, 222 USPQ 654, 661 (Fed. Cir. 1984) (relying on Envirotech); Palumbo v. Don-Joy Co., 762 F.2d 969, 974, 226 USPQ 5, 8 (Fed. Cir. 1985) (no authority cited);⁸ Moeller v. Ionetics, Inc., 794 F.2d 653, 657, 229 USPQ 992, 995 (Fed. Cir. 1986) (citing Palumbo); H.H. Robertson, Co. v. United Steel Deck, Inc., 820 F.2d 384, 389, 2 USPQ2d 1926, 1929 (Fed. Cir. 1987) (citing Moeller and Palumbo); Perini America, Inc. v. Paper Converting Machine Co., 832 F.2d 581, 584, 4 USPQ2d 1621, 1624 (Fed. Cir. 1987) (citing Palumbo and McGill). The language from these opinions, to the effect that disputes over the meaning of claim language may raise factual questions reviewed for substantial evidence or clear error, as the case may be, continued to propagate through our precedent. This line of cases culminated in Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H., 945 F.2d 1546, 20 USPQ2d 1332 (Fed. Cir. 1991), in which this court affirmed a denial of a motion for judgment n.o.v., reasoning that

[i]nterpretation of the claim words [at issue] required that the jury give consideration and weight to several underlying factual questions, including in this case the description of the

⁸Palumbo also presented the issue of construction of means-plus-function claim limitations under 35 U.S.C. § 112, para. 6. As that issue is not before us today, we express no opinion on the issue of whether a determination of equivalents under § 112, para. 6 is a question of law or fact.

claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses.

Id. at 1550, 20 USPQ2d at 1336.

On the other hand, a second line of Federal Circuit opinions has continued to follow the earlier pronouncements that claim construction is strictly a question of law for the court. See Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988); Senmed, 888 F.2d at 818-20, 12 USPQ2d at 1511-13; Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561-63, 19 USPQ2d 1500, 1503-04 (Fed. Cir. 1991); Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386-87 (Fed. Cir. 1992); Read Corp. v. Portec, Inc., 970 F.2d 816, 822-23, 23 USPQ2d 1426, 1432-33 (Fed. Cir. 1992).

B. Notwithstanding the apparent inconsistencies in our opinions, the Supreme Court has repeatedly held that the construction of a patent claim is a matter of law exclusively for the court. Hogg v. Emerson, 47 U.S. (6 How.) 437, 484 (1848); Silsby v. Foote, 55 U.S. (14 How.) 218, 225 (1853); Winans v. Denmead, 56 U.S. (15 How.) at 338; Winans v. New York & Erie R.R. Co., 62 U.S. (21 How.) 88, 100 (1859); Bischoff v. Wethered, 76 U.S. (9

Wall.) 812, 816 (1870); Heald v. Rice, 104 U.S. 737, 749 (1882); Coupe v. Rover, 155 U.S. 565, 579-80 (1895); Market St. Cable Rv. Co. v. Rowley, 155 U.S. 621, 625 (1895); Singer Mfg. Co. v. Cramer, 192 U.S. 265, 275 (1904); see also 2 William C. Robinson, The Law of Patents for Useful Inventions § 731, at 481 (1890) (hereinafter Robinson on Patents); George T. Curtis, A Treatise on the Law of Patents for Useful Inventions § 222, at 251 (4th ed. 1873) (hereinafter Curtis on Patents).⁹ Time and again the Supreme Court has itself resolved disputes over the construction of claims as a matter of law. See, e.g., Coupe v. Rover, 155 U.S. at 574-75, 579 (stating that court defines the scope of the claims and reversing the trial judge's erroneous claim construction); Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274, 275 (1877) (resolving claim construction contentions on the basis of an exhaustive review of the patent and its discussion of the relevant art).

The reason that the courts construe patent claims as a matter of law and should not give such task to the jury as a factual matter is straightforward: It has long been and continues to be a fundamental principle of American law that "the construction of a written evidence is exclusively with the court." Levy v. Gadsby, 7 U.S. (3 Cranch) 180, 186 (1805) (Marshall, C.J.); Eddy v. Prudence Bonds Corp., 165 F.2d 157, 163 (2d Cir. 1947) (Learned Hand, J.)

⁹The Supreme Court has also in equity cases considered the scope of a patent to be a matter of law, not subject to deferential review. See Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 546 (1871); Bates v. Coe, 98 U.S. 31, 38-39 (1879); Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 224 (1880); Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 134, 52 USPQ 275, 279 (1942).

("[A]ppellate courts have untrammelled power to interpret written documents."); 4 Samuel Williston, Williston on Contracts § 601, at 303 (3d ed. 1961) (hereinafter Williston on Contracts) ("Upon countless occasions, the courts have declared it to be the responsibility of the judge to interpret and construe written instruments, whatever their nature.") (footnotes omitted).

The patent is a fully integrated written instrument. By statute, the patent must provide a written description of the invention that will enable one of ordinary skill in the art to make and use it. 35 U.S.C. § 112, para. 1. Section 112, para. 2, also requires the applicant for a patent to conclude the specification with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." It follows, therefore, from the general rule applicable to written instruments that a patent is uniquely suited for having its meaning and scope determined entirely by a court as a matter of law. Bates v. Coe, 98 U.S. at 38 ("[T]he claims of the patent, like other provisions in writing, must be reasonably construed . . ."); Merrill v. Yeomans, 94 U.S. 568, 571 (1877) (construing the patent in part by applying "well-settled rules of construing all instruments"); accord Doble Eng'g Co. v. Leeds & Northrup Co., 134 F.2d 78, 83, 56 USPQ 426, 432 (1st Cir. 1943) ("It appears to be firmly established that . . . a patent is subject to the same general rules of construction as any other written instrument."); 2 Robinson on Patents, *supra*, § 732, at 481-82; 1 Anthony W. Deller, Patent Claims § 21 (2d ed. 1971).

There is much wisdom to the rule that the construction of a patent should be a legal matter for a court. A patent is a government grant of rights to the patentee. 35 U.S.C. § 154. By this grant, the patentee owns the rights for a limited time to exclude others from making, using, or selling the invention as claimed. *Id.*; see Bloomer v. McQuewan, 55 U.S. (14 How.) 539, 548 (1852). Infringement of the patentee's right to exclude carries with it the potential for serious consequences: The infringer may be enjoined and required to pay increased damages, costs and attorney fees. See 35 U.S.C. §§ 283-285. When a court construes the claims of the patent, it "is as if the construction fixed by the court had been incorporated in the specification," Curtis on Patents, *supra*, § 452, at 609, and in this way the court is defining the federal legal rights created by the patent document.

Further, it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude. Merrill v. Yeomans, 94 U.S. at 573-74 ("It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."); Hogg v. Emerson, 47 U.S. (6 How.) at 484. They may understand what is the scope of the patent owner's rights by obtaining the patent and prosecution history -- "the undisputed public record," Senmed, 888 F.2d at 819 n.8, 12 USPQ2d at 1512 n.8 -- and applying established rules of construction to the language of the patent claim in the context of the patent. Moreover, competitors should be able to rest assured, if infringement litigation occurs, that a

judge, trained in the law, will similarly analyze the text of the patent and its associated public record and apply the established rules of construction, and in that way arrive at the true and consistent scope of the patent owner's rights to be given legal effect.

Arriving at a true and consistent scope of the claims also works to the benefit of the patentee, as Professor Robinson eloquently observed:

To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his

privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.

2 Robinson on Patents, *supra*, § 733, at 483-84.

We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim. As such, "[a] patent covers the invention or inventions which the court, in construing its provisions, decides that it describes and claims." 3 Robinson on Patents, *supra*, § 1019, at 247. Because claim construction is a matter of law, the construction given the claims is reviewed *de novo* on appeal. Accordingly, Markman's principal argument that the district court erred in taking the issue of claim construction away from the jury is itself legally erroneous.

IV.

A. Markman argues that the jury's implied construction of the claims is correct and that the district court's construction of the claims is wrong, thereby necessitating that this court reinstate the jury's verdict. Markman contends that the jury properly considered all the evidence of record on the disputed claim term "inventory" in reaching its implicit conclusion that the term does not require articles of clothing. We find that these arguments are not convincing and we reach a conclusion that is in accord with the district court's construction of the claims.

"To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed. Cir. 1991); accord Autogiro Co. of Am. v. United States, 384 F.2d 391, 396-98, 155 USPQ 697, 701-03 (Ct. Cl. 1967). "Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used." Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 631 (Fed. Cir. 1987). In construing the claims in this case, all these sources, as well as extrinsic evidence in the form of Westview's sales literature, were included in the record of the trial court proceedings.

Claims must be read in view of the specification, of which they are a part. Autogiro, 384 F.2d at 397, 155 USPQ at 702; see Winans v. Denmead, 56 U.S. (15 How.) at 338; Bates v. Coe, 98 U.S. at 38-39. The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. See In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 621 (CCPA 1970) ("Occasionally the disclosure will serve as a dictionary for terms appearing in the claims, and in such instances the disclosure may be used in interpreting the coverage of the claim."). As we have often stated, a patentee is free to be his own lexicographer. Autogiro, 384 F.2d at 397, 155 USPQ at 702. The caveat is that any special definition given to a word must be clearly defined in the specification. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). The written

description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims.

To construe claim language, the court should also consider the patent's prosecution history, if it is in evidence. Graham v. John Deere Co., 383 U.S. 1, 33, 148 USPQ 459, 473 (1966). This "undisputed public record" of proceedings in the Patent and Trademark Office is of primary significance in understanding the claims. See Autogiro, 384 F.2d at 397, 155 USPQ at 702 (the "file wrapper" is "part[] of the patent"). The court has broad power to look as a matter of law to the prosecution history of the patent in order to ascertain the true meaning of language used in the patent claims:

Th[e] construction of the patent is confirmed by the avowed understanding of the patentee, expressed by him, or on his half [sic], when his application for the original patent was pending [W]hen a patent bears on its face a particular construction, inasmuch as the specification and claim are in the words of the patentee, . . . such a construction may be confirmed by what the patentee said when he was making his application.

Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 227 (1880); see Singer Mfg. Co., 192 U.S. at 278-85 (construing the claims in light of the prosecution history as a matter of

law).¹⁰ Although the prosecution history can and should be used to understand the language used in the claims, it too cannot "enlarge, diminish, or vary" the limitations in the claims. Goodyear Dental Vulcanite Co., 102 U.S. at 227; Intervet Am., Inc. v. Kee-Vet Labs, Inc., 887 F.2d 1050, 1054, 12 USPQ2d 1474, 1477 (Fed. Cir. 1989).

Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. This evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history. Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful "to show what was then old, to distinguish what was new, and to aid the court in the

¹⁰Accord SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1120, 227 USPQ 577, 585 (Fed. Cir. 1985) (in banc) ("the district court's construction of the claims in light of the prosecution history [is] a question of law"); Lemelson v. United States, 752 F.2d 1538, 1550, 1552, 224 USPQ 526, 533 (Fed. Cir. 1985) ("The prosecution histories being admitted into evidence, the court should have considered them in its construction of the claims."); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1270, 229 USPQ 805, 811 (Fed. Cir. 1986) ("[T]he prosecution history can and should, where relevant, be assessed (along with, e.g., claim language and specification) in properly interpreting claim language."); Mannesmann Demag Corp. v. Engineered Metal Prods. Co., 793 F.2d 1279, 1283, 230 USPQ 45, 47 (Fed. Cir. 1986) ("in view of the prosecution history the district court correctly interpreted the literal meaning of" the claim language at issue); 6 Ernest B. Lipscomb III, Walker on Patents § 21:1, at 261 (3d ed. 1987) ("The words of a patent or patent application, like the words of specific claims therein, always raise a question of law for the court").

construction of the patent." Brown v. Piper, 91 U.S. 37, 41 (1875).

The court may, in its discretion, receive extrinsic evidence in order "to aid the court in coming to a correct conclusion" as to the "true meaning of the language employed" in the patent. Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 546 (1871) (reviewing a decree in equity); see United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 233, 55 USPQ 381, 384 (1942) (the court construed the claim by relying in part on the testimony of one of the patentees as the "clearest exposition of the significance which the terms employed in the claims had for those skilled in the art"); U.S. Indus. Chems, Inc. v. Carbide & Carbon Chems. Corp., 315 U.S. 668, 678, 53 USPQ 6, 10 (1942) ("[I]t is permissible, and often necessary, to receive expert evidence to ascertain the meaning of a technical or scientific term or term of art so that the court may be aided in understanding . . . what [the instruments] actually say."); Winans v. New York & Erie R.R. Co., 62 U.S. (21 How.) at 101 ("[P]rofessors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence."); Marsh v. Quick-Meal Stove Co., 51 F. 203 (C.C.D. Mo. 1892) ("It is the province of the court to construe the claims of the patent that has been offered in evidence. That construction, of course, is to be made in the light of such expert testimony as has been offered."); 3 Robinson on Patents, *supra*, §§ 1012-15, 1019-20; accord Seattle Box Co.

v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573 (Fed. Cir. 1984) ("A trial judge has sole discretion to decide whether or not he needs, or even just desires, an expert's assistance to understand a patent. We will not disturb that discretionary decision except in the clearest case."); Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc., 887 F.2d 1070, 1076, 12 USPQ2d 1539, 1544 (Fed. Cir. 1989) (Newman, J., dissenting) ("The purpose of expert testimony is to provide assistance to the court in understanding, when the claims are technologically complex or linguistically obscure, how a technician in the field, reading the patent, would understand the claims.") (emphasis added).

Extrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims. U.S. Indus. Chems., Inc., 315 U.S. at 678, 53 USPQ at 10; Catalin Corp. of Am. v. Catalazuli Mfg. Co., 79 F.2d 593, 594, 27 USPQ 371, 373 (2d Cir. 1935) (Learned Hand, J.) ("If the doctrine of the 'integration' of a written instrument has any basis at all, surely it should apply to such a document . . . [as the patent]."); 3 Robinson on Patents, *supra*, § 1019, 15 247-48. When, after considering the extrinsic evidence, the court finally arrives at an understanding of the language as used in the patent and prosecution history, the court must then pronounce as a matter of law the meaning of that language. See Loom Co. v. Higgins, 105 U.S. at 586. This ordinarily can be accomplished by the court in framing its charge to the jury, but may also be done in the context of dispositive motions such as those seeking judgment as a matter of law.

Through this process of construing claims by, among other things, using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language as a matter of law based on the patent documents themselves, the court is not crediting certain evidence over other evidence or making factual evidentiary findings. Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.¹¹ The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history. It is therefore still construction, and is a matter of law subject to de novo review.

B. Applying this analysis of claim construction, we conclude that (1) the trial court did not abuse its discretion when it admitted the extrinsic evidence offered by Markman -- Markman's testimony and the testimony of Markman's "patent expert" -- on the issue of claim construction, and that (2) the trial court properly rejected this extrinsic evidence to the extent it contradicted the court's construction of the claims based on the specification and prosecution history. Although in this case the trial court might have granted Westview's motion for directed verdict and should have instructed the jury as to the meaning of the claims (including the disputed term "inventory"), its failure

¹¹For an example of very thorough appellate review of claim construction based on the patent in view of extrinsic evidence, see Mitchell v. Tilghman, 86 U.S. (19 Wall.) 287, 379-90 (1874).

to do so was rendered harmless by the court's subsequent response to Westview's post-trial motion.

We agree with the trial court that the term "inventory" refers, at least in part, to articles of clothing, contrary to Markman's contention that "inventory" may be limited to just cash or inventory receipts. As the district court noted, the claim phrase "detect and localize spurious additions to inventory as well as spurious deletions therefrom" does not make sense using Markman's definition of "inventory." Dollars or invoice totals are not "localized" since dollars do not travel through the cleaning process and the location of invoices is irrelevant. Location is relevant to clothing, since it moves through and sometimes without the establishment, where it can be lost, stolen, or damaged. Also, "spurious" additions and deletions logically relate to clothing because "dollars" would not be spuriously added to a dry-cleaner's inventory. Thus, the language of the claim itself suggests the conclusion that the dry-cleaner's "inventory" includes clothing.

The patent specification confirms this. The specification is pervasive in using the term "inventory" to consist of "articles of clothing." Rather than set forth each instance, we refer the reader to a few examples:

This invention relates to inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment. [Col. 1, lines 12-17.]

The best inventory control and management reporting information systems has [sic] the ability to determine and report the current location of any given article¹² in inventory. [Col. 5, lines 14-17.]

Every transaction is recorded, including identification of the articles placed in inventory. [Col. 5, lines 8-10.]

[I]ncoming articles to be placed in inventory are accumulated over a counter [Col. 6, lines 7-8.]

[A]rticles to be cleaned are associated with a unique bar code indicia for later automatic or semiautomatic optical scanning and data input, whereby the progress of articles through the laundry and drycleaning systems can be completely monitored. [Col. 2, lines 53-57.]

The prosecution history is also in accord. During prosecution of the original patent application in this case, Markman amended claim 1 in order to overcome an

¹²It is undisputed that "article" means "article of clothing."

obviousness rejection by adding limitations reciting among other things "whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom." Markman argued in his remarks to the examiner that

unlike the usual system in which apparatus generates non-unique indicia (e.g., Stewart's price indicia) and/or indicia that is [sic] not produced concurrently with the commencement of a transaction (e.g., pre-printed tags), applicant's system is operable to keep a running reconcilable inventory total by adding input articles and subtracting output articles, and also protects against the possibility of undocumented or spuriously-documented articles entering the system. [Emphasis in original.]

Markman also referred the examiner to "features present" in claim 1, explaining:

Means are also provided for reconciling the very same unique and concurrently-generated indicia at later points during processing whereby the entry or exit of inventory

articles in irregular ways can be localized.

Also, the prosecution history of the patent on reissue conflicts with Markman's argument now that claim 1 does not require "tracking" of articles of clothing. In order to obtain other claims in the reissue patent broader than claim 1, which was carried through to the reissue patent, Markman explained the scope of the original claims thusly:

1. Tracking of Individual Articles

It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing brought by a single consumer to a drycleaning establishment or the like. I believe that tracking of a transaction whether it involves one article or several is properly disclosed and allowable. The claim language recites entry of "descriptions of each of said articles associated with the transactions". This passage is more limited than I had a right to claim because, although individual articles, e.g. a pair of pants, could be accounted for by individual marking, scanning and reconciliation in

reports, the grouping of such articles into sets for tracking (e.g., a suit comprising pants under jacket and/or a suit and a Dress or other spearable [sic] articles grouped together) is reasonably disclosed as forming part of the invention and is allowable over the prior art.

It is evident from Markman's explanation of the claims to the examiner that he used "inventory" in the patent and the examiner understood "inventory" to consist of "articles of clothing." The prosecution history thus confirms the meaning of "inventory" as including "articles of clothing."

Markman argues that the extrinsic evidence of record provides substantial evidence in support of the jury's and his claim construction. Markman testified as an inventor of the patent in suit and as one of ordinary skill in the art (or, perhaps more accurately, one of "extraordinary" skill in the art) that "inventory" did not need to include articles of clothing. Markman's "patent expert" testified likewise, when giving his opinion on the proper construction of the claims. Finally, Markman argues that the testimony of Westview's president and some of its sales literature also support such claim construction. We do not find Markman's arguments persuasive.

First, the testimony of Markman and his patent attorney on the proper construction of the claims is entitled

to no deference. For example, they both testified as to how the patent should be construed based on the text of the patent. This testimony about construction, however, amounts to no more than legal opinion -- it is precisely the process of construction that the court must undertake. Thus, as to these types of opinions, the court has complete discretion to adopt the expert legal opinion as its own, to find guidance from it, or to ignore it entirely, or even to exclude it. See *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 797, 17 USPQ2d 1097, 1100 (Fed. Cir. 1990). When legal "experts" offer their conflicting views of how the patent should be construed, or where the legal expert's view of how the patent should be construed conflicts with the patent document itself, such conflict does not create a question of fact nor can the expert opinion bind the court or relieve the court of its obligation to construe the claims according to the tenor of the patent. This opinion testimony also does not change or affect the *de novo* appellate review standard for ascertaining the meaning of the claim language. Thus, to the extent they were testifying about construction itself, we reject Markman's and Markman's patent expert's testimony as having any controlling effect on what the court below and we perceive to be the meaning of "inventory" as used in the patent and prosecution history.

Second, the extrinsic evidence of record cannot be relied on to change the meaning of the claims. In this case, as fully discussed above, the patent and prosecution history make clear that "inventory" in claim 1 includes in its meaning "articles of clothing." The district court exercised its discretion in finding unhelpful Markman's testimony that he meant "inventory," or that one of ordinary skill in the art

would understand "inventory," to mean something to the contrary, and furthermore the district court rejected the testimony as conflicting with the meaning derived from the patent and prosecution history. In our construction of the claim term "inventory," we too find unhelpful and reject Markman's testimony. Similarly, even if they in fact used "inventory" to mean other than articles of clothing, Westview's sales literature and the testimony of its president do not dissuade us from our legal construction of the claim, based on the patent and prosecution history, that the claim term "inventory" means articles of clothing.

V.

A. This decision that claim construction is properly viewed solely as a question of law is consistent with precedent of the Supreme Court and much of this court's precedent. Yet the dissenting and one of the concurring opinions assert that our decision violates the Seventh Amendment. A close analysis of the bases underlying their arguments reveals, however, that they are unsupported by logic and precedent.

The Seventh Amendment provides "[i]n suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." U.S. Const. amend. VII. Thus, if an action could be tried to a jury in 1791, the right to a jury trial is preserved. The Seventh Amendment has also been judicially interpreted as extending the right to jury trial to statutory causes of action analogous to common law actions. *Tull v. United States*, 481 U.S. 412, 417 (1987).

The dissenting and one of the concurring opinions express in somewhat different ways why they believe our holding deprives plaintiffs of the constitutional right to a jury trial in patent infringement cases. The dissenting opinion argues there are jury triable factual inquiries involved in determining the scope of a claim and this determination is part of and often dispositive of patent infringement questions. One concurring opinion, which apparently acknowledges that sometimes claim construction is a legal question for the court, nonetheless finds a majority effort to indirectly create a "complexity exception" to the right to jury trial in patent infringement cases that will allow a three judge panel of this court to "do pretty much what it wants under its de novo retrial."

These arguments do not ring true. In this opinion we do not deprive parties of their right to a jury trial in patent infringement cases. Our opinion merely holds that part of the infringement inquiry, construing and determining the scope of the claims in a patent, is strictly a legal question for the court.¹³ The patentee's right to a jury trial on the application of the properly construed claim to the accused device is preserved as it was in 1791.

¹³Our opinion also holds that we review district court determinations on questions of claim construction under a *de novo* standard of review, like other legal questions. In this regard, we emphasize that we are reiterating the long-recognized appellate review standard for issues of law in the trial proceeding, regardless of whether the case was tried to a judge or a jury. Contrary to the contentions of the dissenting opinion, this does not "effect[] a dramatic realignment of jury, judge, and the appellate process."

Any constitutional concerns raised by this opinion must be limited to the issue of claim construction. It is significant that neither the dissenting nor the concurring opinions cite any cases supporting the proposition that claim construction was a question of fact or involved triable issues of fact to a jury in or prior to 1791. None of the briefs of the parties or amici cite such a case, nor have we found any. The search for such a case may well be a fruitless one because of the manifest differences in patent law in eighteenth century England and patent law as it exists today in Title 35 of the United States Code. *See Hogg*, 47 U.S. (6 How.) at 479-83 (citing the significant differences between English law and United States law and cautioning against reliance on the former when applying the latter); Emerson Stringham, *Outline of Patent Law* § 5000, at 266-67 (1937) ("The patent claim, first developed in the United States, is now largely relied upon as defining the scope of protections . . .") (emphasis added). *See generally*, P.J. Federico, *Origin and Early History of Patents*, 11 J. Pat. Off. Soc'y 292 (1929).

B. The dissenting and one of the concurring opinions attempt to make the case that construing claims is analogous to construing and interpreting contracts, deeds, and wills. Traditionally courts have treated the construction of these documents as being a legal question for the court, but have stated that under certain circumstances the interpretation of an agreement may raise jury triable questions. Thus, by analogy, the argument is made that although claim construction may indeed be a question of law for the court, it also involves (or, in the argument of the concurrence, may involve) triable issues of fact.

The analogy of a patent to a contract may appear to some extent to be an appropriate way of describing the circumstances surrounding the issuance of a patent.¹⁴ The inventor is required to make full disclosure of his invention to the Patent and Trademark Office (PTO) and to the public in his patent specification, which he is otherwise not obligated to do. In return, the law allows the government to confer a property right to exclude anyone else from making, using, or selling the invention covered by the claims for seventeen years, which it is otherwise not obligated to do.

The analogy of a patent to a contract is not useful, however, in the context of a patent infringement suit. Patents are not contracts per se and patent infringement actions have never been viewed as breach of contract actions. Patent infringement has often been described as a tort. In a patent infringement suit, the inventor sues a competitor for infringing upon his right to exclude. The competitor is never a party to the so-called "contract" between the government and the inventor. See Keystone, 95

¹⁴A patent, however, is not a contract. Contracts are executory in nature -- they contain promises that must be performed. See E. Allan Farnsworth, Contracts § 1.1, at 3-4 (2d ed. 1990). Once a patent is issued, any purported exchange of promises between the applicant and the Patent and Trademark Office (PTO) has been fully executed. A patent is a statutory grant of the right to exclude others from making, using, or selling the invention recited in the claims, read in light of the specification. 35 U.S.C. § 154. There is no discretion on the part of the PTO as to whether or not to grant the patent -- if the statutory requirements are met, a patent is issued. 35 U.S.C. § 151. Likewise, the other party to the transaction, the patentee, cannot "contract" with any one other than the federal government to receive a right to exclude others from making, using, or selling his invention. See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 162 (1989).

U.S. at 279 ("As patents are procured ex parte, the public is not bound by them, but the patentees are."). Nor does the competitor ever breach this contract between the government and the inventor by making, using, or selling the accused devices.

Questions of fact may arise in construing contracts, deeds, or wills in two contexts. First, the document may not reflect the agreement between, or intent of, the two parties. Thus, unless the document is fully integrated and the parol evidence rule (or its equivalent in the other areas of law) applies, extrinsic evidence may be offered to demonstrate different or additional terms. There is no parol evidence rule in patent law for obvious reasons. It is axiomatic that the invention protected by the patent must be covered by the claims, otherwise it is lost. Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 510 (1917). Parol or other extrinsic evidence cannot add, subtract, or vary the limitations of the claims.

A question of fact may also arise in construing contracts, deeds, or wills when there is an ambiguous term. In this situation, the parol evidence rule does not apply and extrinsic evidence may be offered to demonstrate what the parties intended when they used the term. Thus the factual inquiry for the jury in these cases focuses on the subjective intent of the parties when they entered into the agreement.

No inquiry as to the subjective intent of the applicant or PTO is appropriate or even possible in the context of a patent infringement suit. The subjective intent of the inventor when he used a particular term is of little or no

probative weight in determining the scope of a claim (except as documented in the prosecution history). See Senmed, 888 F.2d at 817 n.8, 12 USPQ2d at 1512 n.8. In fact, commonly the claims are drafted by the inventor's patent solicitor and they may even be drafted by the patent examiner in an examiner's amendment (subject to the approval of the inventor's solicitor). See Manual of Patent Examining Procedure (MPEP) § 1302.04 (Rev. 15, Aug. 1993) ("Examiner's Amendments and Changes"). While presumably the inventor has approved any changes to the claim scope that have occurred via amendment during the prosecution process, it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance by the PTO. See generally Senmed, 888 F.2d at 819 n.8, 12 USPQ2d at 1521 n.8. Of course the views of the other party to the "patent contract," the government, are generally not obtainable, except as reflected in the prosecution history. See Western Elec. Co. v. Piezo Tech., Inc., 860 F.2d 428, 432-33, 8 USPQ2d 1853, 1856-57 (Fed. Cir. 1988); MPEP § 1701.01 ("Office personnel not to testify").

Thus the focus in construing disputed terms in claim language is not the subjective intent of the parties to the patent contract when they used a particular term. Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.

Moreover, ideally there should be no "ambiguity" in claim language to one of ordinary skill in the art that would

require resort to evidence outside the specification and prosecution history. Section 112 of Title 35 requires that specifications "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . ." and requires that the specification "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (emphasis added). This statutory language has as its purpose the avoidance of the kind of ambiguity that allows introduction of extrinsic evidence in the contract law analogy. See, e.g., Keystone, 95 U.S. at 278 ("When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it.") (emphasis added). Patent applications, unlike contracts, are reviewed by patent examiners, quasi-judicial officials trained in the law and presumed to "have some expertise in interpreting the [prior art] references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents." American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359, 220 USPQ 763, 770 (Fed. Cir. 1984). See also Western Electric, 860 F.2d at 431, 8 USPQ2d at 1857. If the patent's claims are sufficiently unambiguous for the PTO, there should exist no factual ambiguity when those same claims are later construed by a court of law in an infringement action. See Intervet Am., 882 F.2d at 1053, 12 USPQ2d at 1476 ("Ambiguity, undue breadth, vagueness, and triviality are matters that go to claim

validity for failure to comply with 35 U.S.C. § 112-¶ 2, not to interpretation or construction.") (emphasis in original).

This does not mean there is never a need for extrinsic evidence in a patent infringement suit. A judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed. Extrinsic evidence, therefore, may be necessary to inform the court about the language in which the patent is written. But this evidence is not for the purpose of clarifying ambiguity in claim terminology. It is not ambiguity in the document that creates the need for extrinsic evidence but rather unfamiliarity of the court with the terminology of the art to which the patent is addressed.

Accordingly, the contract, deed, and will cases relied upon in the dissenting and concurring opinions serve only to highlight the differences between claim construction in a patent infringement case and contract interpretation in a breach of contract suit or construction/interpretation of a will in a will contest. They reflect the court's concern with finding the "true" intention of the parties to an agreement, deed, or will.¹⁵ This sort of inquiry is not appropriate, or

¹⁵Illustrative of the search for the intent of the parties or the makers are the following opinions cited in the dissenting and concurring opinions. Goddard v. Foster, 84 U.S. (17 Wall.) 123, 142-43 (1873) (in a contract between two parties, courts "are not denied the same light and information the parties enjoyed when the contract was executed, but they may acquaint themselves with the persons and circumstances that are the subjects of the statements in the written agreement"); Brown & Co. v. M'Gran, 39 U.S. (14 Pet.) 479, 493 (1840) ("[T]he true interpretation (continued...)

even possible, in the context of patent litigation. Infringement litigation may involve multiple actions against different defendants none of whom has any personal knowledge of or participation in the PTO proceedings where the give and take that results in the negotiated claim language occurs. Thus there can be no search for the defendant party's intent.

C. The more appropriate analogy for interpreting patent claims is the statutory interpretation analogy. Statutory interpretation is a matter of law strictly for the court. There can be only one correct interpretation of a statute that applies to all persons. Statutes are written instruments that all persons are presumed to be aware of and are bound to follow. Statutes, like patents, are enforceable against the public, unlike private agreements between contracting parties. When interpreting statutes, a court looks to the language of the statute and construes it according to the traditional tools of statutory construction, including certain well known canons of construction. United States v. John C. Grimberg Co., 702 F.2d 1362, 1365, 1368 (Fed.

¹⁵(...continued)

of the language may be left to the consideration of the jury for the purpose of carrying into effect the real intention of the parties."); Startex Drilling Co. v. Sohio Petroleum Co., 680 F.2d 412, 415 (5th Cir. 1982) (submitting case to jury "to determine what the parties meant" by ambiguous terms in the contract); In re Union Trust Co., 151 N.Y.S. 246, 249 (Sur. Ct.) ("The first and cardinal rule of interpretation of wills is the application of the meaning of the testator, not the meaning of the adjudications."), modified, 156 N.Y.S. 32 (1915); see also Reed v. Proprietors of Locks & Canals on Merrimac River, 49 U.S. (8 How.) 274, 288 (1850) ("Whereas the intention of the parties is to be found in their deed alone, which it is the duty of the court to construe.").

Cir. 1983). A court may also find it necessary to review the legislative history of the statute, which is itself a matter of public record, just as the specification and prosecution history of a patent are public records. *Id.* at 1369. While a court may seek from the public record to ascertain the collective intent of Congress when it interprets a statute, the subjective intent of any particular person involved in the legislative process is not determinative. Thus the members of Congress, or staffpersons who draft legislation, are not deposed or called on to testify in actions involving statutory interpretation. Similarly, the subjective meaning that a patentee may ascribe to claim language is also not determinative. Thus, it is from the public record that a court should seek in a patent infringement case to find the meaning of claim language.

There are, of course, differences between a statute and a patent. But because both of these public instruments may create liability in third persons who were not participants in the legislative process or the PTO proceedings, as the case may be, we conclude that the statutory interpretation model is a more accurate model than the contractual one for purposes of determining whether constitutional protections are transgressed by assigning claim construction exclusively to judges.

D. The dissenting opinion and one of the concurring opinions, along with Markman and certain of the amici, contend that assigning claim construction exclusively to judges is in conflict with certain decisions of the Supreme Court. We are not persuaded. The dissenting and concurring opinions place heavy reliance on two Supreme

Court cases, *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), and *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1869), for the proposition that questions of fact may arise in the determination of the scope of a patent claim. A close examination of these cases, however, reveals they do not support that argument.¹⁶

In *Silsby v. Foote*, the Court affirmed a trial judge who left the question of what elements were "essential" for the claimed invention to the jury. According to the Court, the claim in that case stated: "I also claim the combination, above described, by which the regulation of the heat of the stove, or other structure in which it may be used, is effected." *Id.* at 226. The Court agreed with the petitioner that "[t]he construction of the claim was undoubtedly for the court." *Id.* at 225. The Court continued, however, that "[w]hen a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result." *Id.* at 226. Thus the Court concluded that where a combination claim does not point out the elements of the claim but rather describes "machinery as effects a particular result," the jury may determine "which of the described parts are essential to

¹⁶One concurring opinion also relies on *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), as a case where the court "construed" the claim in a general manner and left it for the jury to fill in specifics. As correctly noted by the dissent, this case is more properly understood as one involving the doctrine of equivalents infringement notwithstanding the literal language of the claims.

produce that result." Otherwise, the question of claim scope belonged to the court.

It is difficult to see how Silsby supports the views set forth in the dissenting and concurring opinions. This is especially so because applicants are now required by 35 U.S.C. § 112 to particularly point out and distinctly claim the subject matter the applicant regards as his invention and this requirement applies with equal force to claims having means-plus-function limitations. The only jury-triable issue described in Silsby on the question of claim scope is now statutorily foreclosed. Further, a jury is not allowed to canvass the patent specification to evaluate what portions of a combination claim are "essential" to produce a particular result. See Keystone, 95 U.S. at 278 ("This provision [the predecessor to section 112, para. 2] was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of the previous inventions, and a comparison thereof with that claimed by him."). Both this court and the Supreme Court have made clear that all elements of a patent claim are material, with no single part of a claim being more important or "essential" than another. See Fay v. Cordesman, 109 U.S. 408, 420-21 (1883); Pennwalt Corp. v. Durand-Wayland Inc., 833 F.2d 931, 936, 4 USPQ2d 1737, 1741 (Fed. Cir. 1987) (in banc).

The reliance on Bischoff v. Wethered is even more puzzling. Bischoff did not even involve an infringement issue but rather involved a question of invalidity in a breach of contract action. The plaintiff, who sought to invalidate

the patent on the basis of a prior art patent, argued that the court, and not the jury, should have decided the question of "identity or diversity of the inventions." Bischoff, 76 U.S. at 816. The Court disagreed. While the Court again acknowledged that "construction of written instruments is the province of the court alone," it concluded that in this case "[i]t is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions." Id. at 816.

Markman's case does not involve a question of identity or diversity of inventions. The word "claim" does not even appear in the Bischoff case. Rather Bischoff is concerned with divining the "character of the thing invented" from the patent in suit and the prior art patent. It is difficult, if not impossible, to discern any legal principle from Bischoff that relates to claim construction in the context of patent infringement. To the extent the dissenting and concurring opinions view claim construction in an infringement case as a search for the "character" of the thing invented, we disagree.

Finally, the concurring opinions consider that much of our opinion is dictum because there is no "genuine" dispute as to the claim term "inventory." As we have demonstrated, Markman squarely raised the issue of whether the court acted within its power in granting JMOL after the jury had construed the claims. The trial court viewed claim construction as a legal question and determined that it could decide the meaning of the term "inventory" as a matter of law based on the patent document and prosecution history. Markman, on the other hand, viewed the construction of the

claim as one of fact with the jury verdict being supported by the evidence.

CONCLUSION

Correctly reasoning that claim construction is a matter of law for the court, the district court properly rejected the jury's verdict and granted JMOL. Upon our de novo review of the court's construction of the claim language, we agree that "inventory" in claim 1 includes within its meaning "articles of clothing." It is undisputed that Westview's device does not and cannot track articles of clothing. Accordingly, there is no substantial evidence to support the jury's finding of infringement of claims 1 and 10 of United States Reissue Patent No. 33,054 when those claims are correctly construed. The district court's grant of judgment of noninfringement as a matter of law is

AFFIRMED.

United States Court of Appeals for the Federal Circuit

92-1049

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

MAYER, Circuit Judge, concurring in the judgment.

Today the court jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment of the Constitution of the United States; it marks a sea change in the course of patent law that is nothing short of bizarre. Sadly, this decision represents a secession from the mainstream of the law. It portends turbulence and cynicism in patent litigation. For this is not just about claim language, it is about ejecting juries from infringement cases. All these pages and all these words cannot camouflage what the court well knows: to decide what the claims mean is nearly always to decide the case.

But today's action is of a piece with a broader bid afoot to essentially banish juries from patent cases altogether. If it succeeds juries will be relegated, in those few cases where they have any presence at all, to rubber stamps, their verdicts preordained by "legal" and "equitable" determinations that brook only one "reasonable" result. Indeed, this movement would vest authority over patent disputes in legislative courts, unconstrained by Article III and the Seventh Amendment. See In re Lockwood, Misc. Docket No. 394, slip op. at 6 (Fed. Cir. filed Feb. 7, 1995) (opinion dissenting from order denying rehearing in banc) ("A constitutional jury right to determine validity of a patent does not attach to this public grant. Congress could place the issue of validity entirely in the hands of an Article I trial court with particular expertise if it chose to do so."). Declaiming that the jury is a "black box" incapable of a "reasoned decision", several judges of the court have already advised that they are aboard this campaign. Id., slip op. at 20-21. The quest to free patent litigation from the "unpredictability" of jury verdicts, and generalist judges, results from insular dogmatism inspired by unwarrantable elitism; it is unconstitutional.

The question is whether the interpretation of patent claims is a purely legal exercise -- always decided by the judge as a matter of law and never raising a question of fact -- or rather a mixed question of law and fact, in which some factual matters might need to be resolved by the factfinder on the way to construing the claims as a matter of law. The answer is critical to how questions of claim interpretation are decided at the trial level and how we review them on appeal.

The ultimate issue of patent scope, depending as it does on the legal effect of the words of the claims, is a question of law. But it does not necessarily follow that the judge is to decide every question that arises during the course of claim construction as a matter of law. Cf. Graham v. John Deere Co., 383 U.S. 1, 17 (1966) (obviousness is a legal conclusion with underlying factual determinations).¹ Instead, characterization of claim construction as "legal" begs the questions whether fact issues may arise subsidiary to the ultimate legal conclusion, how such issues are to be decided, and by whom.

Contrary to what it says today, this court (including the judges in the majority) has always held that claim interpretation is a matter of law depending on underlying factual inquiries. See, e.g., Arachnid Inc. v. Medalist Mktg. Corp., 972 F.2d 1300, 1302, 23 USPQ2d 1946, 1948 (Fed. Cir. 1992) (though claim construction is issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); Lemelson v. General Mills Inc., 968 F.2d 1202, 1206, 23 USPQ2d 1284, 1288 (Fed. Cir. 1992) (same, noting that "underlying factual issues in dispute become the

¹While the ultimate question of patent validity is one of law, Graham v. John Deere Co., 383 U.S. 1, 17 (1966), there are a number of underlying inquiries that raise questions of fact. In addition to obviousness, these include anticipation, Atlas Powder Co. v. E.I. DuPont de Nemours & Co., 750 F.2d 1569, 1573, 224 USPQ 409, 411 (Fed. Cir. 1985), prior public use or sale, U.S. Envtl. Prods., Inc. v. Westall, 911 F.2d 713, 715, 15 USPQ2d 1898, 1900 (Fed. Cir. 1990) (a legal conclusion supported by underlying facts), and sufficiency of a specification's disclosure, Utter v. Hiraga, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988) (same).

jury's province to resolve in the course of rendering its verdict on infringement"); Johnston v. IVAC Corp., 885 F.2d 1574, 1579, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989) ("A disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation. However, without such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court" (citation omitted); see also Tol-O-Matic Inc. v. Proma Produkt-Und Mktg., 945 F.2d 1546, 1552, 20 USPQ2d 1332, 1338 (Fed. Cir. 1991) (substantial evidence supported jury's presumed fact findings on disputed terms and prosecution history); SmithKline Diagnostics Inc. v. Helena Lab. Corp., 859 F.2d 878, 885, 8 USPQ2d 1468, 1474 (Fed. Cir. 1988) (fact findings on disputed prosecution history clearly erroneous); Perini America v. PCM Co., 832 F.2d 581, 586, 4 USPQ2d 1621, 1625 (Fed. Cir. 1987) (in bench trial, court's interpretation of disputed claim terms not clearly erroneous); Tillotson Ltd. v. Walbro Corp., 831 F.2d 1033, 1039, 4 USPQ2d 1450, 1454 (Fed. Cir. 1987) (vacating summary judgment where construction turns on factual disputes arising from specification, prosecution history, and industry practice); Tandon Corp. v. ITC, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987) (Commission's findings on prosecution history and meaning of terms supported by substantial evidence); H.H. Robertson Co. v. United Steel Deck Inc., 820 F.2d 384, 389, 2 USPQ2d 1926, 1929 (Fed. Cir. 1987) (in bench trial, court's fact findings on claim terms not clearly erroneous); Howes v. Medical Components Inc., 814 F.2d 638, 646, 2 USPQ2d 1271, 1275 (Fed. Cir. 1987) (vacating summary judgment

because of fact issues surrounding prosecution history); Moeller v. Ionetics, Inc., 794 F.2d 653, 657, 229 USPQ 992, 995 (Fed. Cir. 1986) (vacating summary judgment where terms create underlying fact dispute); Palumbo v. Don-Joy Co., 762 F.2d 969, 976, 226 USPQ 5, 9 (Fed. Cir. 1985) (vacating summary judgment where fact question of equivalents of "means plus function" claim disputed); Bio-Rad Lab., Inc. v. Nicolet Instrument Corp., 739 F.2d 604, 614, 222 USPQ 654, 662 (Fed. Cir. 1984) (substantial evidence supported jury interpretation of disputed terms); McGill Inc. v. John Zink Co., 736 F.2d 666, 675, 221 USPQ 944, 951 (Fed. Cir. 1984) (reversing jury verdict where construction premised on facts not supported by substantial evidence). So it is remarkable that the court so casually changes its collective mind, especially when the just cited precedent was compelled by the Seventh Amendment and not the mere preference of a sufficient number of judges.² The court's revisionist reading of precedent to loose claim interpretation from its factual foundations will have profoundly negative consequences for the well-established roles of trial judges, juries, and our court in patent cases.

²The court pretends there is a line of contrary authority. Ante at 12, 14. But most of its cases arrived at this court after bench trials -- a puzzling source for guidance on the commands of the Seventh Amendment; others actually implicating the right to a jury trial sprang from facts simply inadequate to support a reasonable jury verdict. Indeed, the one case that pays lip service to this novel rule, Read Corp. v. Portec, Inc., 970 F.2d 816, 822-23, 23 USPQ2d 1426, 1432-33 (Fed. Cir. 1992), like this case, did not require excursion beyond the patent documents themselves. There may be a reason why the court is hellbent for its result, but it does not emanate from the cases.

I.

Anyone who wants to know what a patent protects must first read its claims, for they are the measure of its scope. Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336, 339 (1961). Claim language does not exist in a vacuum; it must be understood by reference to the documents annexed to the patent grant, including the specification, of which the claims are a part, and any drawings. Autogiro Co. of Am. v. United States, 384 F.2d 391, 397, 155 USPQ 697, 702 (Ct. Cl. 1967). The prosecution history often proves useful in determining a patent's scope, for it reveals the course of dealing with the Patent Office, which may show a particular meaning attached to the terms, or a position taken by the applicant to ensure that the patent would issue. Graham v. John Deere Co., 383 U.S. at 33. These documents are always available during the course of claim interpretation; they are not extrinsic evidence, though some opinions so characterize them, because they are essentially incorporated into the patent itself.

Patents are directed to those skilled in the art. The task of determining just what the claims mean to skilled artisans falls, in the first instance, to the court. But if, after consideration of all of this documentation, the judge cannot readily resolve the meaning of the claims, he resorts to extrinsic evidence to shed light on them. Moeller, 794 F.2d at 657, 229 USPQ at 995 (trial judge's failure to allow expert testimony was abuse of discretion). This evidence, in the form of prior art documentary evidence or expert testimony, can show what the claims would mean to those

skilled in the art. The content of the prior art and the testimony of technical experts can reveal how others use and understand technical terms that may appear ambiguous or opaque to the judge, who rarely has the knowledge of those skilled in the field of the patent. The inventor himself may qualify as an expert and testify what his claim would mean in the relevant art.³ The judge can even advert to the testimony of patent law experts -- that is, patent lawyers -- for advice on the interpretation of claims.⁴ If this information clarifies the meaning of the claims and is uncontested, the judge may rule as a matter of law.

³Of course, the inventor's testimony as to what he intended or how he understands the patent, as opposed to his testimony as an expert, may be relevant, but is entitled to little weight in the face of evidence to the contrary. See North American Vaccine v. American Cyanamid Co., 7 F.3d 1571, 1577, 28 USPQ2d 1333, 1337 (Fed. Cir. 1993) (inventor's "after-the-fact testimony is of little weight compared to the clear import of the patent disclosure itself"); Intellical, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("where a disputed term would be understood to have its ordinary meaning by one of skill in the art from the patent and its history, extrinsic evidence that the inventor may have subjectively intended a different meaning does not preclude summary judgment.").

⁴A fact dispute cannot arise solely from testimony of a patent law expert. While this sort of testimony is acceptable, even if often overdone, as an interpretive aid to the court, it is not evidence and cannot create a genuine fact question for the jury. See Nutrition 21 v. United States, 930 F.2d 862, 871 n.2, 18 USPQ2d 1347, 1350 n.2 (Fed. Cir. 1991) (patent law expert's "opinion on the ultimate legal conclusion is neither required nor indeed 'evidence' at all"); see also Avia Group Int'l Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1554 (Fed. Cir. 1988) (conflicting opinions of legal experts create no material issue of fact).

But sometimes extrinsic evidence results in a genuine dispute over the meaning of a term or an event during prosecution.⁵ When that happens, it falls to the finder of fact to settle it. Lemelson, 968 F.2d at 1206, 23 USPQ2d at 1288; Tol-O-Matic Inc. v. Proma Produkt-Und Mktg., 945 F.2d at 1550, 20 USPQ2d at 1336; SmithKline Diagnostics Inc. v. Helena Lab. Corp., 859 F.2d at 882, 8 USPQ2d at 1472; Palumbo v. Don-Joy Co., 762 F.2d at 974, 226 USPQ at 8.

When a question of claim construction arrives here on appeal, this court reviews the ultimate construction given the claims under the de novo standard applicable to all legal conclusions. But any facts found in the course of interpreting the claims must be subject to the same standard by which we review any other factual determinations: for clear error in facts found by a court; for substantial evidence to support a jury's verdict. Fed. R. Civ. P. 52(a); Perini America v. PCM Co., 832 F.2d at 584, 4 USPQ2d at 1624; McGill Inc. v. John Zink Co., 736 F.2d at 672, 221 USPQ at 948.

This standard recognizes the jury's important role in making factual determinations, and the role of the trial court as the primary decisionmaker in bench trials. A trial is "the 'main event' . . . rather than a 'tryout on the road.'"

⁵Of course, not every disagreement gives rise to a genuine fact question. Johnston v. I'AC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989); see also Senmed Inc. v. Richard-Allen Medical Indus., 888 F.2d 815, 819 n.8, 12 USPQ2d 1508, 1512 n.8 (1989) (inventor's testimony as to meaning of "on" contrary to ordinary meaning raised no real "dispute").

Anderson v. City of Bessemer City, 470 U.S. 564, 575 (1985). By broadly proclaiming all aspects of claim interpretation to be legal, the court today usurps a major part of the functions of both trial judge and jury in patent cases, obliterating the traditional, defined differences between the roles of judge and jury and trial and appellate courts.

II.

Beyond any policy argument supporting the traditional roles of judge and jury in patent cases, the court's decision today flies in the face of the constitutional right to a jury promised by the Seventh Amendment of the Constitution. That promise, "[i]n suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved," protects litigants' right to a jury trial where legal, as opposed to equitable, causes are to be determined. Chauffers, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 564 (1990). The amendment does not create an independent right to trial by jury but gives parties rights equivalent in scope to those that existed at common law, in England in 1791, when the Bill of Rights was ratified. Tull v. United States, 481 U.S. 412, 417 (1987). It does not stop there, however; it extends as well to statutory actions subsequently created by Congress if they are analogous to actions decided in the law courts of eighteenth century England. Id.

The Seventh Amendment does not guarantee the right to have a jury decide all issues in a case. It properly resolves only factual questions, while legal matters are for the court. Even within the realm of factual questions,

whether a particular question must always go to the jury depends "on whether the jury must shoulder this responsibility as necessary to preserve the 'substance of the common-law right of trial by jury.'" Id. at 426 (quoting Colgrove v. Battin, 413 U.S. 149, 152 (1973)). The Seventh Amendment was intended not to formalize any particular rigid procedural rules, but "to preserve the basic institution of trial by jury in only its most fundamental elements" Parklane Hosiery Co. v. Shore, 439 U.S. 322, 337 (1979) (quoting Galloway v. United States, 319 U.S. 372, 392 (1943)); see also Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 657 (1935) ("particularly to retain the common-law distinction between the province of the court and that of the jury"). But where a particular issue goes to these "fundamental elements" or the "substance of the common-law right of trial by jury," no court may constitutionally remove it from the jury. See Walker v. New Mexico & So. Pac. R. Co., 165 U.S. 593, 596 (1897) (Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative."); see also Granfinanciera S.A. v. Nordberg, 492 U.S. 33, 51 (1989) (even Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury."). The court's action in this case does just that.

An action for patent infringement is one that would have been heard in the law courts of old England. See, e.g., Bramah v. Hardcastle, 1 Carp. P.C. 168 (K.B. 1789), reprinted in I Decisions on the Law of Patents for Inventions 51, 53 (Benjamin V. Abbott ed.) (1887) [hereinafter Abbott]

(jury trial of infringement action; jury instructed that patent was invalid, but jury verdict for plaintiff not disturbed); Morris v. Bramsom, 1 Carp. P.C. 30 (K.B. 1776), reprinted in Abbott, supra, at 21 (jury trial of infringement action); see also Boulton v. Bull, 1 Carp P.C. 117 (C.P. 1795), reprinted in Abbott, supra, at 59, 74 ("[I]nfringement or not, is a question for the jury; in order to decide this case, they must understand the nature of the improvement or thing infringed"). In this country, a jury trial has always been available in patent cases where damages are sought. Indeed, the first Patent Act, in 1790, expressly provided that a patent owner was entitled to "such damages as shall be assessed by a jury." Act of April 10, 1790, ch. 7, § 4, 1 Stat. 109. In such cases, the jury has been entrusted with ruling on the ultimate question of infringement, as well as any factual disputes that arise subsidiary to the determination of the legal question of patent validity.

Not infrequently, the ultimate question of infringement, indisputably a matter for the jury, is effectively dictated by the construction given the patent claims. This happens, of course, when the judge affirmatively takes the question from the jury by granting summary judgment or judgment as a matter of law, as it did here; it can also occur when, even though the judge sends the question to the jury, his interpretation of the claims forces the jury's decision on infringement. That is to say, choosing between contending interpretations of a claim can decide the matter of infringement for all intents and purposes. Our constitutional mandate to preserve the right to jury trial therefore demands that we view any intrusion on the jury's role in deciding infringement with deep suspicion.

See Dimick v. Schiedt, 293 U.S. 474, 486 (1935) ("Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with utmost care.").

Today's decision also threatens to do indirectly what we have declined to do directly, that is, create a "complexity exception" to the Seventh Amendment for patent cases. See SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1130, 227 USPQ 577, 592 (Fed. Cir. 1985) (Markey, C.J., additional views). But there is simply no reason to believe that judges are any more qualified than juries to resolve the complex technical issues often present in patent cases. *Id.* at 1128 & n.7, 227 USPQ at 591 & n.7. Indeed, the effect of this case is to make of the judicial process a charade, for notwithstanding any trial level activity, this court will do pretty much what it wants under its de novo retrial. We have consistently stressed that the same rules apply to patent cases as apply to all other civil disputes. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1547, 220 USPQ 193, 197 (1983) ("So long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases."). The court subverts this principle and the demands of the Seventh Amendment by the ruse of reclassifying factual questions as legal ones.

III.

Those who argue for interpretation of claims solely as a matter of law by the judge spew a panoply of cases

ostensibly in support. Close examination of these cases, however, reveals that, like the one before us today, interpretation of the claims at issue before the deciding court presented no real factual question. Thus, for example, in Hogg v. Emerson, 47 U.S. (6 How.) 437, 484 (1848), the Court stated that "without the aid of experts and machinists, [we have] no difficulty in ascertaining, from the language used here," the meaning of the patent. Similarly, Winans v. New York & Erie R.R. Co., 62 U.S. (21 How.) 88, 100 (1858), allowed the possibility that "experts may be examined to explain terms of art, and the state of the art at any given time. They may explain to the court and jury the machines, models, or drawings exhibited." But the Court went on to say that there was only one construction of the patent "which the language of this specification will admit" and "it would be wholly superfluous to examine experts to teach the court, what they could clearly perceive without such information." *Id.* at 101. Brown v. Piper, 91 U.S. 37, 41 (1847), recognized that evidence on "what was old and in general use at the time of the alleged invention" was admitted at the trial but that it was unnecessary. "[W]e think the patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answers and testimony, *sua sponte*, if objection were not taken by counsel, well have adjudged in favor of the defendant." *Id.* at 44. See also U.S. Indus. Chem., Inc. v. Carbide & Carbon Chem. Corp., 315 U.S. 668, 677 (1941) ("[O]n the face of the papers, the process described in the original patent included a step [omitted from the reissue]," and the trial court erroneously relied on unnecessary expert opinion in its improper conclusion that the reissue was not invalid.); Exhibit Supply Co. v. Ace

Corp., 315 U.S. 126, 134 (1941) ("examination of the drawings and specifications indicates clearly enough" the meaning of the claim); Smith v. Snow, 294 U.S. 1, 14 (1934) ("Examination of the claim, in light of both [undisputed] scientific fact and of the particular form in which the petitioner reduced the claim to practice as described in the specifications, makes it plain" what are the claim's relevant limitations.).

These cases simply do not address the effect of extrinsic evidence giving rise to a legitimate fact question. They are cases where the documentary record alone was wholly adequate to derive the patent's proper construction.⁶ It is hardly surprising that courts would treat claim interpretation under these circumstances as a matter of law, for it could not be otherwise. See Fed. R. Civ. P. 50(a) (court may grant judgment as a matter of law where underlying facts could not support reasonable jury verdict to the contrary), and 56(c) (summary judgment appropriate where there is no genuine issue as to any material fact);

⁶In one case where it appeared the Court "avail[ed] itself of the light furnished by the evidence to enable it to understand the terms used in the patent and the devices and operations described or alluded to therein," Webster Loom Co. v. Higgins, 105 U.S. 580, 586 (1881), the evidence was examined in ruling on the issue of enablement, i.e., whether those of skill in the art would understand the terms of the patent. Even given the conflicting testimony, the Court concluded that the terms of the patent were "sufficiently clear and full in the description of the invention." Id. at 589. When it reached the question of infringement, however, it did not mention any evidence other than the specification and claims and stated "if we examine the language of the claim [in light of the specification], it seems to us that all doubt as to its meaning is removed." Id. at 598. There was no reliance on any extrinsic evidence in construing the claims for purposes of infringement.

Newell Companies, Inc. v. Kenney Mfg. Co., 864 F.2d 757, 762, 763, 9 USPQ2d 1417, 1421-22 (1988) (approving use of judgment as a matter of law and summary judgment on obviousness where underlying facts are not disputed).

Indeed, some cases cited in support of a purported rule that claim construction is always entirely a matter of law expressly limit the rule to those cases where the patent may be understood on the basis of the documents alone, without resort to extrinsic evidence; these cases acknowledge that fact questions could be raised that would require submission to a jury. In Heald v. Rice, 104 U.S. 737, 749 (1881), the Supreme Court explained:

That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what is the invention described in each, and to affirm from mere comparison that the inventions are not the same, but different, then the question of identity is one of pure construction, and not of evidence, and consequently is a matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law.

The Court there determined that it had a case in which the question could be determined "from the mere reading of the two specifications" and that it was "too plain for argument that they are perfectly distinct." *Id.* at 753; see also *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1903) ("As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed . . . the question of infringement or no infringement is one of law . . ."); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1894) (same as *Heald v. Rice*). These cases recognize that where extrinsic evidence is required and raises a real factual dispute, the question is no longer one of "pure construction," so that the jury must play its role in the construction of the claims.

But where the question has arisen -- where the proper construction of claims depends on the resolution of a factual dispute -- the Supreme Court has stated in no uncertain terms that the jury has the duty to decide. These are cases where the meaning of a patent may not be derived from its terms alone, forcing the judge to go beyond the documentary evidence for aid. This gives rise to issues of historical fact the resolution of which must be left to a jury.

The claim before the court in *Silby v. Foote*, 55 U.S. (14 How.) 218 (1852), was directed to "the combination, above described, by which the regulation of the heat of the stove, or other structure in which it may be used, is effected." *Id.* at 226. The specification disclosed a stove containing a number of discrete parts. To be sure, the judge "construed the claim"; he instructed the jury that it covered "a combination of such of the described parts as were combined and arranged for the purpose of producing a particular effect, viz., to regulate the heat of a stove." *Id.* at 225. But the defendants asked the judge to rule as a

matter of law that the parts referred to in the claim were "the index, the detaching process, and the pendulum." *Id.* at 226. The trial court refused, holding that this question was for the jury.

The Supreme Court affirmed asking, "How could the Judge know this as a matter of law?" *Id.* Once the trial court had construed the claim and instructed the jury, "it therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* Only then could the jury determine if the accused device contained all of these elements and was therefore an infringement. The Court said the "defendants' counsel exhibited to the court the models of the machines of the defendants and the plaintiff, for the purpose of satisfying the court the jury must have understood they were at liberty to construe the claim, and that they did in truth so construe it, as to exclude from the combination claimed by the plaintiff, what is called the detaching process." *Id.* (emphasis added).

Again, in *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the court "construed" the claim in a general manner and left it for the jury to fill in the specifics. The claim at issue was directed to a rail car for the transportation of coal "in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions." *Id.* at 342. The defendant requested the jury be instructed that the claim was limited to a circular form only, as was described in the specification and did not cover the defendant's rectilinear design. The Supreme Court affirmed the trial court's refusal of the instructions, stating that "where the whole substance of the invention may be copied in a different form, it is the

duty of the courts and juries to look through the form for the substance of the invention -- for that which entitled the inventor to his patent, and which the patent was designed to secure." Id. at 343.

The Court considered how far an alleged infringing car could depart from the form of a perfect circle and still infringe, and determined that the claim encompassed anything "so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same result as was reached by his invention." Id. at 344. It cited evidence, including expert testimony as to the mode of operation of the patentee's car and whether the accused car attained the same results as the claimed car. The Court unmistakably left it to the jury to determine the meaning of the claim, its scope, and refused to proclaim it a matter of law outside the province of the jury. Id.

These cases are especially relevant because they show that the jury has always had a role in determining a patent's scope. This historic reliance on juries to aid the court in deciding exactly what patents protect matters here because the Seventh Amendment demands that courts preserve the right to jury trial as it existed at common law. Old cases are obviously instructive under this peculiar standard. Accordingly, efforts to distinguish Silsby and Winans because of their age are disingenuous. This court has no office to invoke desuetude to evade the Seventh Amendment and the Supreme Court.

Our patent laws have always required inventors to point out their inventions in detail sufficient to both distinguish the prior art and tell the public what protection the patent confers. The very first patent act required that letters patent "describ[e] the said invention or discovery,

clearly, truly, and fully." Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109. The applicant for a patent was at the time required to submit "a specification in writing, containing a description . . . of the thing or things by him or them invented or discovered, . . . which specification shall be so particular . . . as . . . to distinguish the invention or discovery from other things before known and used." Id. § 2. The word "claim" first appeared in the Act of 1836, ch. 357, § 6, 5 Stat. 117 (July 4, 1836), requiring that the applicant "shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention." Claims, per se, were not expressly required until the Act of 1870, ch. 230, § 26, 16 Stat. 198 (July 8, 1870), which said the applicant "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery", but they were in common use much earlier in rudimentary form. See, e.g., Evans v. Eaton, 20 U.S. 161, 194, 7 Wheat. 356, 428 (1822) (Specification concluded: "I claim as my invention, the peculiar properties or principles which this machine possesses, in spreading, turning and gathering the meal, at one operation, and the rising and lowering its arms, by its motion, to accommodate itself to any quantity of meal it has to operate on.").

In light of this history, it is apparent that the 1870 Act simply codified the preference for particular claiming already expressed by the Supreme Court. See Brooks v. Fiske, 56 U.S. (15 How.) 212, 215 (1853) (specification and drawings to be considered "only for the purpose of enabling us to correctly interpret the claim"). This change from a regime of "central" claiming to one of "peripheral" claiming may seem a major step in the patent discipline, but the distinction it represents is irrelevant to the Seventh Amendment. When the trial court in Silsby construed the

claim there at issue, it was performing essentially the same task of claim construction as courts perform today. When the judge then left it for the jury to clarify the ambiguity as to just what elements the claims encompassed, he recognized the existence of a jury question precisely the same as that which the court rejects today.

Even if it were correct that the 1870 Act created a new and different claiming requirement out of whole cloth, I see no evidence that Congress thereby intended to strip the jury of its traditional role in determining patent scope. Indeed, the Seventh Amendment's command that we preserve jury trial rights as they existed at common law dictates that Congress could not have taken the question from the jury even if it wanted to. See Granfinanciera, 492 U.S. at 51 (Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury"; private rights involve "the liability of one individual to another under the law as defined" (quoting Crowell v. Benson, 285 U.S. 22, 50 (1932))).

Cases involving patent interpretation in the validity context reach the same result.⁷ For example, in Bischoff v. Wethered, 76 U.S. (9 Wall.) 812 (1869), the Court explained that although it was normally the "province of the court, and not the jury, to construe the meaning of documentary evidence," the "specifications of patents for inventions are documents of a peculiar kind." Id. at 815. The Court stated further that inventions, the subjects of

⁷Cases about patent validity are authoritative on the issue of claim construction. A claim must be interpreted the same for both validity and infringement. E.g., SmithKline Diagnostics Inc. v. Helena Lab. Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1471 (Fed. Cir. 1988). A claim must be construed before determining its validity just as it is first construed before deciding infringement.

patents, "have their existence in pais, outside of the documents themselves; and which are commonly described by terms of art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright." Id. Accordingly, an understanding of the patented invention "is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence in pais," outside of the patent document. Id. This inquiry "belong[s] to the province of evidence, and not that of construction," and thus falls to the jury. Id. at 816.

This illustrates how claim construction may sometimes require the resolution of factual matters before a claim can be authoritatively construed. The exercise is further informed by decisions interpreting analogous instruments, for patents are legal documents like contracts or deeds. See Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 227 (1880) (patent as contract); Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 510 (1917) (patent as deed). The analogies are most apt. A patent can be conceived of as a contract between the inventor and the government. In return for full disclosure of the invention the government gives a monopoly of sorts for a time. The rest of us may be third party beneficiaries of this deal, partaking of the advancement of knowledge the patent represents. Or a patent may be thought of as a form of deed which sets out the metes and bounds of the property the inventor owns for the term and puts the world on notice to avoid trespass or to enable one to purchase all or part of the property right it represents. The public holds a vested future interest in the property. Accordingly, patents should be interpreted under the same rules as govern interpretation of

kindred documents. Merrill v. Yeomans, 94 U.S. 568, 571 (1877).

The interpretation of a contract or a deed, like a patent, is ultimately a question of law. There is nothing novel about the principle that, in the words of Justice Story, "the interpretation of written documents properly belongs to the Court, and not to the jury." Brown & Co. v. McGran, 39 U.S. (14 Pet.) 479, 493 (1840). This principle has been routinely evoked in the context of contract law. See Levy v. Gadsby, 7 U.S. 109, 112, 3 Cranch 180, 186 (1805) ("the construction of a written evidence is exclusively with the court"); Goddard v. Foster, 84 U.S. (17 Wall.) 123, 142 (1872) ("[I]t is well-settled law that written instruments are always to be construed by the court . . ."); see also Meredith v. Picket, 22 U.S. 253, 254, 9 Wheat. 573, 575 (1824) (interpreting a deed, "[t]he Judges must construe the words of an entry, or any other title paper, according to their own opinion of the words as they are found in the instrument itself").

In light of such emphatic Supreme Court language, one might conclude that the meaning of a contract is first and last a question of law which in no instance should be resolved by a factfinder. But as Justice Story also was careful to point out in McGran, "there certainly are cases, in which, from the different senses of the words used, or their obscure and indeterminate reference to unexplained circumstances, the true interpretation of the language may be left to the consideration of the jury for the purpose of carrying into effect the real intention of the parties." 39 U.S. (14 Pet.) at 493.

Story used the facts of McGran to illustrate the point. One issue was the meaning of certain words used by the

parties in letters which formed an agreement on the sale of cotton. The language was susceptible of more than one interpretation and its meaning would depend on the surrounding circumstances. Therefore, the trial judge properly refused to tell the jury what the letters meant, because to do so would have removed from the jury "matters of fact in controversy before the jury upon which it was exclusively their province to decide." Id.

Goddard v. Foster similarly held that written instruments are for the court "except when they contain technical words, or terms of art, or when the instrument is introduced in evidence collaterally, and where its effect depends not merely on the construction and meaning of the instrument, but upon extrinsic facts and circumstances, in which case the inference to be drawn from it must be left to the jury." 84 U.S. (17 Wall.) at 142. See also Reed v. Proprietors of Locks & Canals on Merrimac River, 49 U.S. (8 How.) 274, 289 (1850) (allowing jury to interpret vague or ambiguous deed, where "it necessarily becomes a fact for the jury to decide, whether the land in controversy is included therein").

The principle that documentary interpretation is a matter of law has become a basic tenet of modern contract law. Equally established, however, is the caveat that extrinsic evidence, such as custom and usage of the trade and course of dealing between the parties, akin to prior art, level of skill in the art, and events in the Patent Office, may be introduced to inform the meaning of terms in the contract. And when such evidence is brought in and creates a real conflict, it results in a question of fact for the jury. Great N. Ry. Co. v. Merchants Elevator Co., 259 U.S. 285, 292 (1922); cf. Reed, 49 U.S. (8 How.) at 290 (meaning of deed). This is true even though in some circumstances the

factual exercise of assigning meaning to a term of a contract serves to decide the meaning of the contract. Until today, the same rule has applied in the interpretation of patents.⁸

⁸After emphasizing that patents are construed according to the same rules that apply to other legal instruments, the court decides that a patent is like a contract or a deed in the context of disputes over its creation or its validity, but that when it comes to the question of infringement, a patent is like a statute. Wholly aside from the metaphysical implications of this curious duality to the traditional rule that patents are interpreted for validity just as they are for infringement, it is simply a bogus analogy.

Patents cannot be baby statutes because they are prepared *ex parte* by interested parties, drafted in the lower reaches of an executive department, and issued ministerially by a political officer. They have none of the indicia of a real statute, but the court imbues them with a transconstitutional power to compromise the role of juries in the third branch of government. Not even a congressionally passed, presidentially signed law can match that. See *Granfinanciera S.A. v. Nordberg*, 492 U.S. 33, 51 (1989).

92-1049

United States Court of Appeals for the Federal Circuit

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

RADER, Circuit Judge, concurring in the judgment.

The result in this case is the same whether or not claim construction may sometimes involve subsidiary fact issues. In this case, the claims, specification, and prosecution history irrefutably show that cash transaction totals are not "inventory." Inventor Markman's "after-the-fact testimony" to the contrary "is of little weight compared to the clear import of the patent disclosure itself." *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1577, 28 USPQ2d 1333, 1337 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1645 (1994). The testimony of Markman's patent law expert is not evidence at all. *Cf. Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2, 18 USPQ2d 1347, 1350 n.2 (Fed. Cir. 1991). In sum, the record lacks substantial evidence supporting Markman's asserted claim interpretation. Thus, the trial court correctly granted judgment as a matter of law that Westview did not

infringe. See Read Corp. v. Portec, Inc., 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992).

To dispose of this case, this court need not decide whether subsidiary fact issues may sometimes arise. Markman cannot manufacture a fact issue where none exists. This court's extensive examination of subsidiary fact issues is dicta.

In commenting on this concurrence, the court claims that whether claim construction can involve subsidiary fact issues "is before us and it is our obligation to decide it." The court, however, neglects the logically antecedent question of whether substantial evidence supports the jury finding rejected by the trial court. See Reed, 970 F.2d at 821. Where, as here, substantial evidence does not support the finding, it does not matter whether the issue is one of law or fact.

Whether claim construction can involve subsidiary fact issues is not before us. It is our duty not to rule on this question. The court should decline to answer a question better left to a case that truly raises it, and therefore provides an informed basis for its resolution.

Transaction totals are not, as a matter of law, "inventory." Westview infringes only if transaction totals are "inventory." Therefore, the district court correctly granted judgment as a matter of law that Westview does not infringe. I concur in the judgment.

United States Court of Appeals for the Federal Circuit

92-1049

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

NEWMAN, Circuit Judge, dissenting.

I INTRODUCTION

The issue is the role of the jury in patent infringement cases. The majority opinion resolves the issue by designating, as law, factual disputes about the meaning and scope of the technologic terms and words of art used to define patented inventions. By holding that these disputed technologic questions are matters of law, the court holds that issues of patent infringement, previously triable to a jury as of right, will now be decided by the trial judge and then re-decided de novo by this court on appeal.

Patent infringement is a factual question. Its resolution often requires finding the factual meaning and scope of the terms of scientific art and technology and usage

by which the patentee described and claimed the invention. These findings usually require testamentary and documentary evidence and occasionally experiments or demonstrations, as illustrated in many of our previous decisions that are now overruled.

Deciding the meaning of the words used in the patent is often dispositive of the question of infringement. Thus in the case at bar the infringement controversy is decided by finding the meaning and scope of the term "inventory" in Markman's patent, in light of the accused Westview system: if "inventory" is limited to clothing, the patent is not infringed; if "inventory" includes invoices, it is. The majority holds that this is a matter of law, devoid of any factual component; and subject to *de novo* appellate determination. The jury is eliminated, and new and uncertain procedures are imposed on trial judges.

This holding not only raises a constitutional issue of grave consequence, but the court creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust. Thus I must, respectfully, dissent.

I shall discuss three principal concerns:

1. The Meaning of Disputed Technologic Terms and Words of Art

Patents are technologic disclosures, written by and for the technologically experienced: those "of skill in the art." The meaning and scope of the terms that define the patented technology is often in dispute in infringement litigation, for it often decides the case. In resolving such dispute the trier of fact often makes findings that depend on the weight, credibility, and probative value of conflicting evidence, such

as that offered on behalf of Markman and Westview. Heretofore, the disputed meaning of technologic terms and words of art has been treated by Federal Circuit precedent as an "underlying fact" on which the legal effect of the patent is based. The majority now simply rules that these are not "underlying factual inquiries." However, the meaning and scope of disputed technologic and other terms of art in particular usage are classical questions of fact. Their nature as fact does not change because their finding, like most findings in litigation, has a legal consequence. By redesignating fact as "law" the court has eliminated the jury right from most trials of patent infringement.

2. The Trial and Appellate Roles in Technologic Disputes

The trial process is the vehicle for determining truth. Thus the trier of fact is present in the courtroom along with the witnesses, the advocates, the exhibits, and the demonstrations. Indeed, when the technologic issues are complex, appellate fact finding is probably the least effective path to accurate decisionmaking. And if a factual question is technologically simple, it is not thereby transformed into a matter of law and removed from the trial process. Even were there no constitutional infirmity, I doubt that the correct resolution of technologic or scientific disputes is more likely to be achieved by removing disputed facts from the procedures of trial and consigning them to the appellate court. Appellate briefs and fifteen minutes per side of attorney argument are not designed for *de novo* findings of disputed technologic questions.

3. *The Constitution*

Jury trial in patent cases is protected by the Seventh Amendment. Elimination of the jury is not this court's choice to make.

The constitutional right alone bars the majority's new rule. The majority today denies 200 years of jury trial of patent cases in the United States, preceded by over 150 years of jury trial of patent cases in England, by simply calling a question of fact a question of law. The Seventh Amendment is not so readily circumvented.

II

FACT AND LAW IN PATENT INFRINGEMENT

A. *LEGAL "CONSTRUCTION" V. FACTUAL "INTERPRETATION"*

The majority's explanation for removing these factual issues from the jury is that it is "construing" the patent claims, and that the "construction" of documents is a matter of law. The legal construction of documents--patent documents and other documents--is indeed a matter of law. The legal effect of the patent claim is to establish the metes and bounds of the patent right to exclude; this is a matter of law. But this does not deprive the underlying facts of their nature as fact. These facts are found on evidence that includes the patent specification, relevant prior art, the prosecution history, the testimony of experts in the field, and other relevant evidence such as tests and demonstrations, all as I shall discuss *post*. These findings to not become rules

of law because they relate to a document whose legal effect follows from the found facts.

An extensive body of law, statutory and judgemade, governs the construction and legal effect of patent claims; for example, that a claim is construed the same way in determining both patent validity and infringement, that a dependent claim includes all of the limitations of the independent claim; that the claims as filed are part of the technical disclosure; that the right to exclude is divisible into making, using, or selling the claimed subject matter; that a claim is not infringed unless every element thereof is met in the accused device, either literally or by an equivalent. These and other rules of law are applied when appropriate to the facts of the particular case: either undisputed facts, or facts that are found by the trier of fact. The procedure of applying law to facts does not convert the finding of facts into a matter of law.

In patent infringement litigation there is often a factual dispute as to the meaning and scope of the technical terms or words of art as they are used in the particular patented invention. When such dispute arises its resolution is not a ruling of law, but a finding of fact. Such findings of meaning, scope, and usage have been called the "interpretation" of disputed terms of a document, as contrasted with the "construction" or legal effect of a document. Professor Corbin has explained this distinction, in the context of contracts, as reflecting the difference between "language" and the "legal operation" of language:

It may be helpful to note that the word interpretation is commonly used with respect to *language* itself -- to the symbols (the words and acts) of expression. In about the same degree, we speak of the construction of a *contract*. It is true that we also speak of construing language and of interpreting a contract; but by the latter phrase is certainly meant interpreting the *words* of a contract. The word "contract" has been variously defined; but it is seldom identified with mere symbols of expression. By "interpretation of language" we determine what ideas that language induces in other persons. By "construction of the contract," as that term will be used here, we determine its legal operation -- its effect upon the action of courts and administrative officials.

3 Arthur L. Corbin, Corbin on Contracts §534 (1960) (footnotes omitted). The Restatement (Second) of Contracts §200 and Comment c (1981) describes the distinction between "construction" and "interpretation" as reflecting the difference between the "meaning" of a term and its "legal effect":

Interpretation of a promise or agreement or a term thereof is the ascertainment of its meaning.

* * *

Interpretation is not a determination of the legal effect of words or other conduct.

The Reporter's Note explains that the purpose is "to make it clear that 'interpretation' relates to meaning and to avoid confusion with the ascertainment of legal operation or effect, sometimes called 'construction.'" (Citations omitted). The analogy is apt, although a patent is not a contract, for this distinction has been recognized for many kinds of written instruments. See, e.g., In re XTI Xonix Technologies Inc., 156 Bankr. 821, 829 n.6 (D. Ore. 1993) (proceeding in bankruptcy):

Interpretation and construction of written instruments are not the same. A rule of construction is one which either governs the effect of an ascertained intention, or points out what the court should do in the absence of express or implied intention, while a rule of interpretation is one which governs the ascertainment of the meaning of the maker of the instrument.

Williams v. Humble Oil & Ref. Co., 432 F.2d 165, 179 (5th Cir. 1970), cert. denied, 402 U.S. 934 (1971) (contract):

In the law of contracts (conventional obligations) a proper distinction exists between the "interpretation" of written instruments and their "construction." "Interpretation" refers to the process of determining the meaning of the words used; that process is traditionally thought to be a function of the jury. On the other hand, the process of determining the legal effect of the words used -- once we know their meaning --

is properly labelled "construction"; it is peculiarly a function of the court.

Hornick V. Owners Ins. Co., 511 N.W.2d 370 (Iowa 1993) (insurance policy):

Construction of an insurance policy--the process of determining its legal effect--is a question of law for the court. Interpretation--the process of determining the meaning of words used--is also a question of law for the court unless it depends on extrinsic evidence or a choice among reasonable inferences to be drawn.

In re Union Trust Co., 151 N.Y.S. 246, 249-50 (Sur. Ct. 1915) (will):

A rule of construction is one which either governs the effect of an ascertained intention or points out what a court should do in the absence of express or implied intention. A rule of interpretation is one which governs the ascertainment of the meaning of the maker of a written document.

Reed v. Proprietors of Locks & Canals on Merrimac River, 49 U.S. (8 How.) 274, 288-89 (1850) (deed):

It is true, that it was the duty of the court to give a construction to the deed in question, so far as the intention of the parties could be elicited therefrom But after all this is

done, it is still a question of fact to be discovered from evidence dehors the deed . . . for the jury to decide, whether the land in controversy is included therein, or, in other words, was *intended* by the parties so to be.

It is indeed well understood that the legal effect or construction of the terms of a document, a matter of law, is not to be confused with resolution of disputes concerning the factual meaning of the terms. The former is for the court, the latter for the jury. That the thing whose terms require interpretation is a patent, instead of a deed or a will or a contract, does not convert the finding of disputed facts into a matter of law. Factual findings concerning a particular patented invention do not become matters of law simply because the patent document serves a legal purpose.

Although purity of language has occasionally slipped, for the words "construction" and "interpretation" have been loosely used, the distinction between the concepts has been recognized when it mattered. For example, Walker in his 1904 Textbook used the phrase "construction of the patent," but he left no doubt as to the role of the jury as trier of fact:

[W]here the question of infringement depends on the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left for the jury; and the dependent question of infringement should also be left for the jury to decide.

A.H. Walker, Textbook on the Patent Laws of the United States of America §536 (4th ed. 1904).

This recognition that the factual issues that underlie the "construction of the patent," and that determine patent infringement, are for the jury is manifest even in the early Supreme Court cases that are relied on by the majority, as I discuss in Part IV-C, *post*. The majority's authority does not show removal of factual disputes from the jury. Indeed, several of the cases that are relied upon were bills in equity, and irrelevant to jury trials.

B. EVIDENCE RELEVANT TO CLAIM INTERPRETATION

The areas of evidentiary inquiry commonly encountered in patent infringement cases are illustrated in Markman's case. The infringement trial (validity and damages were severed) included evidence relating to the patent specification, the patent claims, the prosecution history, the inventor's usage of "inventory," and the defendant's understanding of the term. Although Markman's invention was not complex, this phase of the trial took three days.

1. The Specification

The patent specification contains the description of the invention, including the claims. It fulfills the inventor's obligation to make known the technology for which the patent is granted, and must meet certain legal requirements. It must be written, and clear. It must be complete yet

concise. It must enable one of skill in the field to make and use the invention, but need not include that which is known to the field. It must describe the best mode known to the inventor. It is a technical document, written for persons experienced in the technology. See 2 Irving Kayton et al., Patent Practice 9-1 to 9-3 (4th ed. 1989) (describing thirteen functions of the patent specification).

The claims are part of the specification. Their purpose is to identify -- "particularly pointing out and distinctly claiming," 35 U.S.C. §112 -- that which is the subject of the patent grant. Patent claims are terse summaries, and do not repeat the technologic content of the specification. When there arises a question as to whether a term in a patent claim is of a meaning and scope that reaches particular subject matter, the interested public and in turn the courts look to the body of the specification for elaboration and illustration of the usage of the term to define the patented technology.

When litigation ensues, it may be helpful to the trier of fact to hear from the inventor what he/she meant by the terms of art and science and technology used to describe the invention. Markman, as the inventor, testified on this aspect. It may also be helpful to hear, from others in the field of the invention, what was conveyed to them by the now-disputed terms. Markman's witness and Westview's president so testified. Not unexpectedly, the evidence was conflicting. The trier of fact may have to assess the technical content, weight, and credibility of all of the evidence, including but not limited to the specification, in finding the meaning and scope of disputed terms as used in

the patent. Whether the term "inventory" in Markman's Claim 1 includes Westview's invoices can not be found in the abstract, nor by consulting a dictionary; it is found on the evidence of this case, for the specific invention and the specific accused system. This has historically been a question of fact.¹

The Federal Circuit has explained the relationship between law and fact in claim interpretation in many cases, all now overruled, as I illustrate in Part IV-A,B, *post*. For example, in Perini America, Inc. v. Paper Converting Mach. Co., 832 F.2d 581, 4 USPQ2d 1621 (Fed. Cir. 1987) the patented invention related to machines having embossed rolls used in manufacturing paper towels. Typical of the technologic terms in dispute was "the projections in one web intermediate the projections in the other web" to describe the alignment of the embosser rolls. This court recognized that the meaning of its term was a factual issue, and explained that claim interpretation rests on underlying facts:

Like all legal conclusions, that conclusion [that a claim must be interpreted in a certain way] rises out of and rests on a foundation built of established (undisputed or correctly

¹The Federal Circuit, finding this fact *en banc*, holds that the inventor Markman's testimony is "of little or no probative weight" to explain his invention, apparently because he was represented by an attorney before the patent office. The majority states that it is "not unusual" for the inventor not to know what his attorney has patented. Maj. op. at 31. This will be a revelation to the nation's patentees. The majority earlier in its opinion "rejects" Markman's testimony, maj. op. at 26, apparently based on its weight, a question of fact, not on its admissibility, a ruling of law.

found) facts. Interpretation of a claim, or of its scope, should not be assayed until a foundation is in place. If the meaning of terms in the claim, the specification, other claims, or prosecution history is disputed, that dispute must be resolved as a question of fact before interpretation can begin.

Id. at 584, 4 USPQ2d at 1624. The court observed that the finding of disputed facts can "dictate" the ultimate conclusion of what the claim means:

Confusion may be caused by the circumstance in which resolution of the question of the meaning of a term or terms dictates the interpretation of the claim, but that is not unusual, legal conclusions being dictated by established facts and not the other way around, and does not change the nature of the meaning-of-terms inquiry from one of fact to one of law.

Id. The majority now criticizes and expressly overrules these statements in Perini, holding that these facts are not fact, but "law," and that they are removed from the trier of fact and are determined *de novo* on appeal. In my view the Perini court's analysis is in accord with precedent, and properly preserves the role of the trier of fact, whether trial is to the bench or to a jury.

2. *Prior Art*

When there is a dispute as to the meaning and scope of a technologic term or word of art in a patent claim, it is

often helpful to look at the prior art: that is, what was known to persons in the field of the invention at the time the invention was made. The scope and content of the prior art, the differences between the claimed invention and the prior art, the level of ordinary skill in the field of the invention, are all questions of fact, Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and are not subject to reclassification by us.²

The prior art may provide evidence of how the disputed technologic terms and words of art or science were used by others in the field of the invention, and thus evidence of what was conveyed to the field by the terms as used by the patentee. Indeed, the infringement analysis can sometimes stop with the prior art, for if the accused device is found in the prior art, then it is a rule of law that the patent claims can not be interpreted to reach that device. This too requires findings of the scope and content of the prior art, a question of fact, Graham v. John Deere, that is found with an eye upon the accused device.

I do not attempt to catalogue the myriad kinds of information, findings and inferences that may flow from the prior art, in determining the technologic scope of the patentee's invention. This evidence, and the findings and

²In Graham v. John Deere the Court described the issue of "obviousness" in patent cases as one of law based on underlying facts. An analogous pattern has heretofore applied in connection with "claim construction", i.e., as a question of law based on underlying facts. I suggest that these ultimate questions have a strong policy component, and that the Federal Circuit's responsibility for imparting consistency to patent decisions is a significant factor in the law/fact dichotomy.

inferences that are drawn, are the province of the trier of fact. The majority's insistence that these are purely legal matters of "claim construction" does indeed serve to replace the trier of fact with the Federal Circuit; I doubt that it improves the quality of the decision, at great cost to efficiency of the trial/appellate process.

3. *The Prosecution History*

The prosecution history is the record in the Patent and Trademark Office of what transpired during examination of the patent application. It is a public record. It sometimes is lengthy and detailed, sometimes sketchy and brief. The prosecution history may provide evidence of how the inventor or the patent examiner viewed the now-disputed technologic and other terms. In Howes v. Medical Components, Inc., 814 F.2d 638, 645, 2 USPQ2d 1271, 1274-75 (Fed. Cir. 1987) this court observed that "during the prosecution of a patent, claim language may take on new meanings, possibly different from that which was originally intended." The way patentability was argued by the inventor, concessions made or positions adjusted, may be relevant to the factual issue in dispute, and may create an estoppel against the patentee's now-proposed interpretation.

The determination of what occurred in the prosecution of the patent application is a factual matter, SmithKline Diagnostics Inc. v. Helena Lab. Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1471-72 (Fed. Cir. 1988), specific to the particular patent. It is often based on technological arguments, experimental evidence submitted to the patent office, discussions of the meaning and relevance

of prior publications and prior knowledge, explanations of the technical content of the specification, and other evidence of the applicant's and the examiner's positions. This evidence, and appropriate findings and inferences, are for the trier of fact.

The majority refers to the "undisputed" prosecution history, in asserting that there are no factual aspects to this evidence. Indeed, the official government record is fixed. But the significance of the exchanges, compromises, and explanations contained in the correspondence between the inventor and the examiner; the inferences to be drawn as to the technology, the invention, and the meaning and scope of now-disputed technologic terms or words of art; may depend on this and other evidence. If disputed, their finding is for the trier of fact. The meaning, significance, and weight of the content of a documentary record does not become a matter of law simply because the content of the record is not in dispute.

4. *Technologic/Scientific Facts*

Decision of the question of patent infringement usually turns on findings of technologic fact; sometimes relatively simple technology, sometimes at the frontier of scientific advance and its practical applications. When scientific and technologic disputes arise in litigation, they are subject to the rules of evidence and procedure. See Daubert v. Merrell Dow Pharmaceuticals, Inc., 113 S. Ct. 2786 (1993) (discussing issues of scientific evidence). The complexity of the technologic/scientific evidence will of course vary with the issue. See, e.g., Brooktree Corp. v.

Advanced Micro Devices, Inc., 977 F.2d 1555, 24 USPQ2d 1402 (Fed. Cir. 1992) (color video display semiconductor chips); Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991) (blood clotting factor VIII); Halliburton Co. v. Schlumberger Technology Corp., 925 F.2d 1435, 17 USPQ2d 1834 (Fed. Cir. 1991) (neutron logging of oil wells); Bey v. Kollonitsch, 806 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (irreversible enzyme inhibitors); Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985) (silicated lithography plates).

The Court stressed in Daubert that the admissibility of scientific evidence depends on its reliability and relevance, and that the judge's responsibility, when the trier of fact is a jury, is to assure the adequacy of the methodology upon which the evidence is based. 113 S. Ct. at 2795-96. This emphasis on methodology is as well suited to practical applications of technology and engineering as to basic scientific principles. Evidence in patent cases is often provided by scientists or engineers as expert witnesses, and may include explanations of the technology and its scientific basis, comparisons with the prior art or with the accused device, experiments, demonstrations, and interpretations. The evaluation of technologic evidence is often required of the trier of fact. See Lee Loevinger, Science as Evidence, 35 *Jurimetrics J.* 153 (1995); Jack B. Weinstein, The Effect of Daubert on the Work of Federal Trial Judges, 2 *Shepard's Expert and Scientific Evidence Quarterly* 1 (1994).

Nor is it rare in patent cases to encounter incomplete data, theoretical uncertainties, untested inferences, and

speculative conclusions. Experimental procedures, the sources of data, and the bases of opinions that are offered to prove/disprove a technologic fact are often in evidentiary conflict in patent disputes. Engineers and scientists know very well the uncertainties of the experimental process, the fluctuations and glitches in the data, the human and machine error, the forks in the road to objective truth. Indeed, understanding of the fallibility of technologic and scientific experimentation is soon acquired by those who labor in the field of litigation. "The community of trial lawyers and judges knows perhaps better than any other professional group just how unruly science often is in practice." Sheila Jasanoff, What Judges Should Know About the Sociology of Science, 77 *Judicature* 77, 80 (1993) (discussing the "social dimension [that] gives legitimacy to particular scientific 'facts'").

Now that the Federal Circuit holds that resolution of disputes as to the meaning and scope of technologic terms and words of art as used in a particular patent is law, not fact, removing the jury from this issue, is the trial judge excused from determining the admissibility and relevance of technologic evidence? What about the requirement that "[c]redibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). In a patent case the trier of fact may receive extensive evidence related to the meaning and scope of technologic or scientific terms or words of art, their usage and their perception in the field of a particular invention. The evidence often includes technical publications, scientific articles, experimental data,

demonstrations, and opinion testimony. The factual nature of such evidence can not be squared with the majority's criticism of such cases as Palumbo v. Don-Joy, 762 F.2d 969, 226 USPQ 5 (Fed. Cir. 1985), which is today overruled for its holding that "when the meaning of a term in a claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises." *Id.* at 974, 226 USPQ at 8. In addition to my concern about how a record will be developed for the Federal Circuit's de novo decision, I doubt that an appellate court's de novo finding of technologic facts is more likely to attain accuracy, than the decision of a jury or judge before whom a full trial was had:

Duplication of the trial judge's efforts in the court of appeals would very likely contribute only negligibly to the accuracy of fact determination at a huge cost in diversion of judicial resources.

Anderson v. City of Bessemer City, 470 U.S. 564, 574-75 (1985).

5. *The Testimony of Experts*

Disputed questions of the meaning and scope of technologic terms and words of art are decided from the viewpoint of persons of skill in the specific field of technology. It is rare to come upon a technologic issue in litigation for which differing and often plausible views are not offered by qualified witnesses. The Federal Rules of Evidence contemplate the provision of specialized knowledge to assist the trier of fact:

R. 702 If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto

In Moeller v. Ionetics, Inc., 794 F.2d 653, 229 USPQ 992 (Fed. Cir. 1986) this court held that the trial court's rejection of expert testimony in that case was an abuse of discretion:

Although use of experts is generally a matter of discretion with the trial judge, that discretion is not unlimited. In a patent case involving complex scientific principles, it is particularly helpful to see how those skilled in the art would interpret the claim.

Id. at 657, 229 USPQ at 995 (citations omitted). In Moeller the claims related to an electronic process for measuring the concentration of cations, the dispute centering on the particular meaning of the term "electrode body." Moeller too is now criticized and overruled for its statement that

although claim construction is a legal question, underlying fact disputes may arise pertaining to extrinsic evidence that might preclude summary judgment treatment of claim construction.

Id. (citation omitted). I do not see how the Federal Circuit could have decided, de novo on appeal, the meaning of

"electrode body" in this particular invention without finding disputed technologic facts.

The majority's stated recognition that expert testimony may be useful, while holding that "extrinsic evidence of record cannot be relied on to change the meaning of the claims," majority op. at 26, denying all deference to the trier of fact's findings based on that evidence, illustrate the confusion in the court's plan of de novo claim interpretation as a matter of law. The majority has created a procedural quandary, for extrinsic evidence can apparently be received, but no jury can weigh it. When the extrinsic evidence is in conflict--as it invariably is--what then? Will the Federal Circuit itself weigh the evidence of expert witnesses? Will we receive a collection of self-serving affidavits, without examination and cross-examination? Such a procedure surely is not optimal for cases that may require decision of complex engineering or electronics, or chemical or biological processes.

The Court in Daubert referred to the value of the adversary system in matters of scientific proof. The cross-examination of technical experts, with the adversarial guidance of other technical experts, can be as rigorous as any "peer review" process. See generally Margaret A. Berger, Procedural Paradigms for Applying the Daubert Test, 78 Minn. L. Rev. 1345 (1994). In resolving litigation controversy by determining mechanical or chemical or electronic truth, it is hard to understand why justice should be handicapped in the Federal Circuit by replacement of a live trial with cold documents.

In eliminating all sources of "fact" that might implicate the jury right, the majority has denied to the trial of patent cases the assistance that Federal Rule of Evidence 702 is designed to provide, as well as the benefits of Rules 403, 703, and 706. The purpose of these rules is "that the truth may be ascertained and proceedings justly determined." Fed. R. Evid. 102. It seems to me that we have constructed a Hobson's choice whereby either (1) there will indeed be factual evidence of technologic meaning entered into the trial record, for de novo decision on the record by the Federal Circuit, (2) there will be scant evidence admitted at trial, in view of our pronouncement that there is only law in claim interpretation. Either way, one might call this the "omniscience of the learned man" theory of dispute resolution in the Federal Circuit.³

Findings of the meaning of technologic terms and words of art in particular usages are the province of the trier of fact. Discussing words and their jurisprudential treatment, Justice Holmes wrote:

A word is not a crystal, transparent and unchanged; it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.

Towne v. Eisner, 245 U.S. 418, 425 (1918) In Autogiro Co. of America v. United States, 384 F.2d 391, 397, 155

³Nathan Isaacs, The Law and the Facts, 22 Colum. L. Rev. 1, 13 (1922) (warning courts of "medieval assumptions as to the omniscience of the learned man").

USPQ 697, 702 (Ct. Cl. 1967) one of our predecessor courts remarked: "The very nature of words would make a clear and unambiguous [patent] claim a rare occurrence." Justice Story explained the roles of the judge and jury with respect to the meaning of "words of art, and technical phrases" in patent documents:

In respect of another objection, viz. that the court was bound to state what in point of law the invention claimed by the patentee was, I agree, that this is generally true, so far as the construction of the words of the patent, and specification is concerned. But then this doctrine is to be received with qualifications, and sub modo, as the very opinion of Mr. Baron Parke, cited by the counsel, in the case of Neilson v. Harford, Webster Pat. Cas. 295, 370,⁴ abundantly shows; and the jury are to judge of the meaning of words of art, and technical phrases, in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification.

Washburn v. Gould, 29 F. Cas. 312, 325 (C.C.D. Mass. 1844) (emphasis added). Justice Story recognized that the meaning of words of art may depend on "the surrounding circumstances." Indeed, the Federal Circuit recognized that words do not always have the same meaning when they are adapted to new uses. See Fromson v. Advance Offset Plate,

⁴English patent cases were cited by United States courts well into the nineteenth century.

Inc., 720 F.2d 1565, 1569, 219 USPQ 1137, 1140 (Fed. Cir. 1983) (patentee may be his own lexicographer).

Inventors' usages of words to describe their inventions, and the meaning thereby conveyed to persons skilled in the field, are questions of fact, not matters of law, in patent documents as in other written instruments. Disputes concerning the meaning and usage of technical terms and words of art arise in many areas of law. These disputes are resolved by the triers of fact, whether judge or jury, in their established roles in the adjudicatory process. For example, the role of the jury with respect to technical terms in a contract for drilling oil wells was explained in Startex Drilling Co. v. Sohio Petroleum Co., 680 F.2d 412 (5th Cir. 1982):

It is more apt to say that the undefined technical terms on which the contract's application to the present dispute depends convey little meaning without explanation. So, while we agree with Sohio that we are free to determine the ambiguity question anew, we also affirm the district court's ruling that the contract is ambiguous. Thus it was proper to submit to the jury the evidence from both sides as to the meaning attached to these technical terms by the parties, and by the industry.

Id. at 415 (citation omitted). In Zell v. American Seating Co., 138 F.2d 641 (2d Cir. 1943), Judge Frank wrote for the court that:

Thayer delightfully described the fatuous notion of a "lawyer's Paradise, where all words have a fixed, precisely ascertained meaning; where men may express their purposes, not only with accuracy, but with fullness; and where, if the writer has been careful, a lawyer, having a document referred to him, may sit in his chair, inspect the text, and answer all questions without raising his eyes."

Id. at 648 n.26 (quoting Thayer, A Preliminary Treatise on Evidence (1898)).

It has not heretofore been seriously challenged that findings of the weight and credibility of evidence are for the jury, whether the issues are technologic, scientific, or otherwise. See Sartor v. Arkansas Natural Gas Corp., 321 U.S. 620 (1944):

[The weight and credibility of a witness' testimony] "belongs to the jury, who are presumed to be fitted for it by their natural intelligence and their practical knowledge of men and the ways of men; and so long as we have jury trials they should not be disturbed in their possession of it, except in a case of manifest and extreme abuse of their function."

Id. at 628 (quoting Aetna Life Ins. Co. v. Ward, 140 U.S. 76, 88 (1891)). In Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 220 USPQ 929 (Fed. Cir.), cert. denied, 469 U.S. 871 (1984) this court instructed a party who sought de novo appellate review after a jury trial:

Thus [Railroad Dynamics] misconceives our role as an appellate court. In the concert hall of justice, each musician has a part to play. When one on whom plays not his own but another's part, discord is certain. Moreover, our parts are played under well defined rules.

Id. at 1514, 220 USPQ at 937.

Implementing this court's departure from the established appellate role, in reviewing Markman's case on this appeal the majority does not mention the jury instructions, or discuss whether a reasonable jury could have reached the verdict that was reached on the evidence adduced, or decide whether there was substantial credible evidence of such content and weight as could support the jury's verdict. The majority finds for itself the disputed fact of whether the term "inventory" includes the invoices of the Westview system, without any deference to the trial process. Whether or not this court believes that it is a superior finder of technologic fact, that is not our place in the judicial structure.

I wonder how this new system will work. The majority states that the trial judge should have decided the meaning of "inventory" before giving the case to the jury,⁵

⁵Attempting to understand how this procedure would work for complex technologies, at the en banc argument I inquired of Westview's counsel:

J. Newman: If the claim is sufficiently complex -- technologically or just complex in general -- that the judge can't decide what it means without taking testimony, hearing the
(continued...)

but that the error was harmless since the trial judge reached the correct meaning "as a matter of law" after the jury verdict. There was no return to the jury after the trial judge re-decided what "inventory" meant, making the jury superfluous. The Federal Circuit now decides de novo whether "inventory" includes "invoices," ignoring the trial. What of the trial process, if trial judge and jury are ciphers upon appellate review? In the Introduction to the Reference Manual on Scientific Evidence (1994), Judge Schwarzer wrote:

⁵(...continued)

experts, hearing the inventor, hearing whatever else it is that each side needs to, wants to, adduce that the judge permits . . . I can envision, can't you, that a judge would have to hold some kind of evidentiary hearing, at least, if not a mini-trial, in order to learn enough about the claim to decide, as a matter of law, disputed issues?

Mr. Griffin:

Yes your honor.

J. Newman:

We are assuming the issues are disputed, that this is not just a matter of explanation, but a matter of requiring a choice between one side's viewpoint and another. And that the judge should then have a preliminary trial to decide what the claim means by making whatever choices need to be made, and then tell the jury: "Take it from here now, apply this to the accused device"?

Mr. Griffin:

Yes your honor.

J. Newman:

That is quite unusual, is it not? Have you seen this done?

Mr. Griffin:

Personally no your honor.

J. Newman:

I wonder how the trial judges would take to that.

Mr. Griffin:

Probably would not like it your honor, because that would impose a burden which in most cases can be avoided.

The bedrock of [the justice] system is the adversary process, which depends on attorneys to present evidence on behalf of their clients, judges to make the necessary and appropriate rulings concerning admissibility, and juries to resolve disputed issues of fact.

Id. at 1.

In patent cases, no less than for other causes of action, it is the trier of fact on whom the system of justice is founded. The extensive exposition of disputed facts that is available at trial can not be duplicated on appeal. Even were there no constitutional infirmity, I can discern no practical benefit sufficient to justify this court's departure from the established procedures of trial and appeal. Implicit in the appellate process is an expected degree of deference to the trial process. The majority's elimination of the jury as trier of fact, and elimination of the deference owed to the judge upon bench trial of disputed facts, removes from the parties the benefit of the trial process. It distorts the trial/appellate relationship in a manner unique to patent litigation, and manifests a heady misperception of our assignment as a national appellate court.

C. *THE "CLASSIFICATION POWER"--TURNING FACT INTO LAW*

Commentators have remarked on the temptation of appellate courts to redefine questions of fact as questions of law in order to impose the court's policy viewpoint on the decision. Professor Martin Louis calls the appellate

assertion of power to treat fact as law "drastic in that it amounts to a direct judicial assault on the prerogatives of fact finders." Martin B. Louis, Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion, 64 N.C. L. Rev. 993, 1018 (1986). Louis observes that the "classification of ultimate facts as questions of law amounts to a manipulation of the law-fact doctrine to take questions from the jury or to subject the trial level's resolution of questions to free appellate review." *Id.* at 1028. Although the Seventh Amendment has provided a safeguard against this autocracy of the judiciary, concerned observers have long counselled vigilance. Thus definitions of fact and law--the methodology of this appellate power--have attracted the attention of legal scholars.

"Law" is usually defined as a statement of the general principle or rule, predicated in advance, awaiting application to particular facts as they may arise. See Francis H. Bohlen, Mixed Questions of Law and Fact, 72 U. Pa. L. Rev. 111, 112 (1924). Louis, *supra*, at 994, states the principle:

Declarations of law are fact-free general principles that are applicable to all, or at least to many, disputes and not simply to the one sub judice.

There is an additional element to "law;" that is, the duty of judicial enforcement. As Professor Thayer explained, "nothing is law that is not a rule or standard which it is the duty of judicial tribunals to apply and enforce." James B.

Thayer, "Law and Fact" in Jury Trials, 4 Harv. L. Rev. 147, 153 (1890).

Thayer defines "fact" as follows:

["Fact"] is what Locke expresses when he speaks of "some particular existence, or, as it is usually termed, matter of fact." The fundamental conception is that of a thing as existing, or being true. It is not limited to what is tangible, or visible, or in any way the object of sense; things invisible, mere thoughts, intentions, fancies of the mind, propositions, when conceived as of existing or being true, are conceived of as facts. The question of whether a thing be a fact or not, is the question of whether it is, whether it exists, whether it be true. All inquiries into the truth, the reality, the actuality of things are inquiries into the fact about them.

Id. at 151-52. A compilation of definitions of "fact" is provided in Black's Law Dictionary 591-92 (6th ed. 1990):

A thing done; an action performed or an incident transpiring; an event or circumstance; an actual occurrence; an actual happening in time or space or an event mental or physical; that which has taken place.

.... "Fact" means reality of events or things the actual occurrence or existence of which is to be determined by evidence.

In sum, the law is a general proposition, while the fact is a case-specific inquiry. Clarence Morris, Law and Fact, 55 Harv. L. Rev. 1303, 1304 (1942), observed that a controlling distinction between law and fact is whether evidence is needed, for a question of fact usually calls for proof, whereas matters of law are established not by evidentiary showing but by intellectual abstraction.

These distinctions have often been discussed, usually in the course of considering the complexities that can arise, and how they have been, or should be, treated. Thus commentators and judges have written to explain the distinctions among historical facts, ultimate facts, and mixed law/fact questions, in the course of relating these distinctions to trial procedures and judicial review. The nicety that has been generated was criticized in Armour & Co. v. Wilson & Co., 274 F.2d 143, 124 USPQ 115 (7th Cir. 1960), as follows:

We have come to speak of questions of "fact," "primary facts," "subsidiary facts," "evidentiary facts," "ultimate facts," "physical facts," "documentary facts," "oral evidence," "inferences," "reasonable inferences," "findings of fact," "conclusions," "conclusions of law," "questions of fact," "questions of law," "mixed questions of law and fact," "correct criteria of law," and so on ad infinitum. The simple answer is that we are all too frequently dealing in semantics, and our choice of words does not always reflect the magic we would prefer to ascribe to them.

274 F.2d at 155, 124 USPQ at 124-25 (footnote omitted). See generally Steven A. Childress & Martha S. Davis, Federal Standards of Review (2d ed. 1992).

The character of what is a fact does not change, even in those special cases that have been held to warrant plenary appellate review.⁶ The subject matter that the majority now designates as "law"--the disputed meaning and scope of technologic terms and words of art as used in particular inventions--is not law, but fact. On any definition of fact and law, the question of whether "inventory" as used in Markman's Claim 1 means only clothing or can include invoices is a question of fact: on Thayer's criterion of whether the fact exists; on Morris' criterion of whether there is a need for evidence; on Bohlen's inquiry of whether the meaning is specific to the situation sub judice. The meaning of "inventory" is specific to this invention, this patent, this claim, this system, this defendant. Its determination is for the trier of fact.

⁶Among the rare exceptions to deferential appellate review of factual findings are the "constitutional facts", discussed in Bose Corp. v. Consumers Union of United States, Inc., 466 U.S. 485 (1984). In Bose the Court cautioned against enlarging its holding beyond the conflict between constitutional provisions there exemplified. The "constitutional fact" exemplified in Bose does not place all facts in the hands of appellate courts for de novo finding. Such exceptions to the otherwise firm rule of deference to the trier of fact have always been narrow. See generally Frank R. Strong, Dilemmic Aspects of the Doctrine of "Constitutional Fact", 47 N.C. L. Rev. 311 (1969).

III

THE CONSTITUTION

The most egregious lapse in the majority's ruling is its discard of the jury right in patent cases. As I said at the outset, patent infringement has been tried to a jury in the United States for two hundred years, and in England since at least 1623. Disputes concerning "letters patent" for inventions were tried in the English courts, as for other forms of letters patent, as I shall illustrate. Patent infringement trials at common law included determination of validity as well as infringement. Whatever version of "law/fact" this court now chooses to adopt, it can not redact the history of jury trials. The judicial obligation to safeguard the constitutional rights is not defeasible by calling a patent a "statute," or otherwise diminishing the vitality of the Seventh Amendment.

Thus the court, sitting en banc to overrule is contrary precedent, removes the jury from its role as the trier of fact. That right is assured by the Seventh Amendment:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, then according to the rules of the common law.

U.S. Cons. amend. VII.

The importance of the jury right to the Framers can not be overemphasized. Alexander Hamilton wrote:

The friends and adversaries of the plan of the convention, if they agree in nothing else, concur at least in the value they set upon the trial by jury; or if there is any difference between them it consists in this: the former regard it as a valuable safeguard to liberty; the latter represent it as the very palladium of free government.

The Federalist No. 83, at 499 (Clinton Rossiter ed., 1961). In discussing the history of the jury in England and in the United States, Judge Arnold has explained:

It is almost impossible to exaggerate the centrality of the institution of the jury to almost all the important episodes of Anglo-American legal history. Many of the central ideas of the American and English common law owe their origin to the fact that the jury was the chief mechanism for trying factual disputes. It is the single most important institution in the history of Anglo-American law.

Morris Sheppard Arnold, The Civil Jury in Historical Perspective, in The American Civil Jury 9, 10 (1987).

The value that the Framers placed on this "palladium of free government" has been guarded by the courts:

Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.

Dimick v. Schiedt, 293 U.S. 474, 486 (1935).

The deference that courts give to jury verdicts is the mechanism by which the Constitution protects the jury right from encroachment by judges. It is not this court's option to violate that right, whether by denying such deference or by taking from the jury the trial of factual issues. Whatever one's personal view of the relative capabilities of a jury and the Federal Circuit in finding technologic facts in patent cases, it is not within our authority to readjust that role to our taste:

The Seventh Amendment . . . requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative.

Walker v. New Mexico & So. Pac. R. Co., 165 U.S. 593, 596 (1897).

The Federal Circuit early affirmed its inheritance of this responsibility, as we undertook our assignment to provide nationwide uniformity in patent cases. In Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1547, 220 USPQ 193, 197 (Fed. Cir. 1983) the court stated:

So long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases.

In Railroad Dynamics v. Stucki, 727 F.2d at 1515, 220 USPQ at 937, the court stated:

There is, of course, no reason for considering patent cases as somehow out of the mainstream of the law and rules of procedure applicable to jury trials for centuries under our jurisprudence.

In any ensuing decisions we reaffirmed this obligation. However, this court's fidelity to fundamental law slipped in recent years, culminating in today's trivializing of our heritage as we defeat the jury right in patent infringement cases.

A. *THE HISTORICAL TEST*

There are no fine lines to be drawn in interpreting the Seventh Amendment, for all cases at common law in England were tried to a jury. In explaining the "historical test," Justice Story described England as "the grand reservoir of all our jurisprudence":

Beyond all question, the common law here alluded to [in the Seventh Amendment] is not the common law of any individual state, (for it probably differs in all), but is the common

law of England, the grand reservoir of all our jurisprudence. It cannot be necessary for me to expound the grounds for this opinion, because they must be obvious to every person acquainted with the history of the law.

United States v. Wonson, 28 F.Cas. 745, 750 (1812). The historical test assured the largeness of the embrace of the Amendment. I can find no support in history for the restriction today adopted. In England in 1791, as of at least 1623, actions of the "force and validity" of letters patent were tried according to the rules of the common law.

Letters patent were grants of the Crown, made for a variety of purposes. During the 1500s to early 1600s, the Star Chamber considered all infringements of letters patent to be contempts of royal authority. See Millar v. Taylor, 4 Burr. 2303, 2374 (K.B. 1769) (contempt proceeding applied by the Star Chamber to infringement of "any patent the Crown thought proper to grant"); Coke, 3 Inst. 182-83 (discussing abuses). In 1623 the Statute of Monopolies prohibited all monopolies except patents for inventions, which continued to be granted for terms that were limited to fourteen years. Section 6 of the Statute stated:

6. Provided also, that any declaration before mentioned, shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufacturers, which others at the time of making such letters patents and grants shall

not use, so as also they be not contrary to the law nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient . . .

21 Jac. I, c.3, s.6 (1623).⁷ Section 2 of the Statute provided that the "force and validity" of the subject matter of the Statute shall be "examined, heard, tried, and determined" according to the common law:

2. And all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and every of them, ought to be, and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.

21 Jac. I, c.3, s.2 (1623). Lord Coke explained that the purpose of Section 2 was to remedy the "mischief" of Star Chamber actions by placing the authorized grants under the common law. 3 Inst. at 183.

The litigation procedures that applied to letters patent for inventions did not differ from those applied to other

⁷The date of the Statute of Monopolies is variously reported as 1623 or 1624 depending on whether the old or new English calendar is used. Edward C. Walterscheid, The Early Evolution of the United States Patent Law: Antecedents (Part 2), 76 J. Pat. & Trademark Off. Soc'y 849, 873 n.98 (1994).

letters patent. See Benjamin Vaughan Abbott, Decisions on the Law of Patents for Inventions Rendered by English Courts 8 n.2 (1887) (the rules for letters patent stated in the case of Rex v. Mussary (K.B. 1738) were also generally applicable to letters patent for inventions). English cases of the period show similar procedures whether the subject was a charter, an invention, a literary work, a trademark, an interest in land, or a trade route.

Trial by jury was the way of the common law, and did not depend on the subject of the letters patent. See, e.g., East India Company versus Sandys, 1 Vern. 127 (Ch. 1682) (validity of grant of exclusive trade route tried to jury); Mayor of Kingston upon Hall versus Horner, 1 Cowp. 102, 108 (K.B. 1774) (dispute concerning meaning of terms of a charter from the Crown relating to a port "most proper to be left to the decision of the jury"); Blanchard v. Hill, 2 Atk. [2d ed. 1794] 484 (Ch. 1742) (injunction to restrain the use of a tradesman's mark granted by the Crown could not be issued without a hearing at law); Anon., 1 Vern. 120 (Ch. 1682) (the Lord Keeper (or Chancellor) required trial at law to determine the validity of letters patent for printing of the Bible); Collins v. Sawrey, 4 Bro. P.C. [2d ed. 1803] 692 (H.L. 1772) (rejecting argument that since the issue depended on written evidence, the "construction" of the letters patent for a vicarage was for the chancery court); Donaldson v. Beckett, 2 Bro. P.C. [2d ed. 1803] 129, 138 (H.L. 1774) ("Between such inventions and copies of books, no sensible distinction can be drawn."); Millar v. Taylor, 4 Burr. at 2323:

In letters patent, all conditions required by 21 Jac. 1 must be observed. Patentees for new inventions are left, by that statute, to the common law, and the remedies which follow in their nature.

There simply is no way, in 1995, to rewrite the history of England and the place of the jury under the common law in 1791.

Actions for infringement of letters patent for inventions were initiated either in the law courts or in Chancery, depending on the relief sought.⁸ When equitable relief was sought, patent actions began with the filing of a bill in the Ordinary side of Chancery (called the Petty Bag or Latin Side), for that is where the letters patent were

⁸There were two courts in Chancery, the Ordinary court and the Extraordinary court. The Extraordinary side of Chancery was so termed because matters requiring the exercise of the King's Conscience were there addressed, for extraordinary relief. Abridgment at 127; Coke, 4 Inst. at 79. The Ordinary side of Chancery has been referred to as "common-law chancery," see *Kirker v. Owings*, 98 F. 499, 506 (6th Cir. 1899), and proceeded according to the laws and statutes of England, exercising the ordinary powers of Chancery. Middle Temple, *General Abridgment of Cases in Equity* 127 (1739) ("Abridgment"); Coke, 4 Inst. at 79.

The Ordinary court had the power to repeal letters patent, by plea of *scire facias*. However, if the matter "descended to issue" the court was without jurisdiction to try it to a jury, and the Chancellor would direct the issue to a court of law, where the issue would be tried to a jury, "because for that Purpose both Courts are but one." Abridgment at 128; see Coke, 4 Inst. at 80. After trial, with jury verdict rendered, the cause was returned to Chancery for further disposition consistent with the verdict. Abridgment at 130 ("A Cause shall not be examined upon Equity in the Court of Requests, Chancery, or other Court of Equity, after Judgment at the Common Law.")

"enrolled." Issues relating to invalidity and noninfringement, if raised by the defendant, were directed by the Chancellor to the courts of law for trial to a jury, and then returned to Chancery if the verdict warranted. The procedure of filing a bill in Chancery and then trying the issue at law was explained by Davies:

[T]he Court of Chancery never decides upon the validity of a patent, the practice there being nothing more than to grant an injunction, at the prayer of the patentee, against any person infringing his patent, and to order an account of profits; but if any question arises upon the validity of the patent, novelty of the invention, or the sufficiency of the specification, it is uniformly referred to a court of law.

John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees* ix (1816).

In infringement suits, the Chancery court could grant the patentee's bills seeking an injunction, or a writ of *scire facias* to repeal the patent, after trial to a jury in a court of law. See, e.g., *Brewster v. Weld*, 6 Mod. 229 (1704) (a *scire facias* to repeal letters patent may be sued in Chancery by any person prejudiced by a patent, as well as by the Crown; when Chancery issues writ returnable to Queen's Bench [requiring trial to a jury] Chancery neither has jurisdiction nor can it supersede such writ); *Rex v. Else*, 1 Carp. P.C. 103 (K.B., N.P. 1785) (proceeding brought by writ of *scire facias* to repeal patent on ground that there was

no new invention described in the specification; tried in King's Bench wherein the jury rendered a verdict for the Crown). Not all matters required the Chancellor to direct issues to the law courts to be tried. For example, when the Crown granted letters patent, for invention or otherwise, the grant had to be enrolled in Chancery's Petty Bag Office within four months for the patent to be enforceable. Thus a bill could be filed in Chancery to seek equitable relief for a patentee's failure to enroll the patent before the time expired. *E.g.*, *Ex parte Beck*, 1 Bro. P.C. [2d ed. 1803] 578 (Ch. 1784).

These relationships were well established by the date of the Seventh Amendment. Issues of patent infringement and the validity were tried only to a jury, in the courts of King's Bench, Common Pleas, or Assize. In a common procedure the patentee would seek an injunction against infringement, the defendant would assert invalidity, and the matter would be directed to a court of law for trial. This process is illustrated in *Newsham v. Gray*, a patent infringement action that started with a bill in equity, seeking to enjoin Gray, the alleged infringer. The Lord Keeper directed the plaintiff to bring an action at law. The following is from Lord Chancellor Hardwicke's opinion in the subsequent proceeding in Chancery, where Gray was seeking to recover costs since the plaintiff was nonsuited for failure to prosecute:

The plaintiff had obtained letters patent of the crown for a new invention of fire engines.

A bill was brought by him to establish his letters patent, and for a perpetual injunction against the defendant, who had

taken upon him to make and vend these engines, notwithstanding the plaintiff had sole right and property under the letters patent.

The defendant, by his answer, insisted it was not a new invention, so as to entitle the plaintiff to an injunction.

There was no replication, but the cause came on at the Rolls, upon bill and answer, in *September* 1740, before Mr. Justice *Parker*, who, not thinking the answer sufficient, directed an action at law to be brought by the plaintiff, for a breach of the letters patent, and retained the bill for a twelvemonth; the plaintiff was nonsuited at law upon the merits; and the cause is now set down by the defendant for a dismissal of the bill, and for costs.

2 Atk. [2d ed. 1794] 286, 286-87 (Ch. 1742).

When the patentee did not seek equitable relief, the action was brought directly at law. The cause of action was trespass on the case. The action was an offspring of the criminal law, and knew no form but trial by jury. *See* H.G. Hanbury and D.C.M. Yardley, *English Courts of Law* 64 (5th ed. 1979) (1944). The defendant could assert defenses including invalidity and noninfringement. All issues, including damages, were for the jury.

The burden of proof was on the patentee. Since letters patent of invention were issued without examination, simply upon declaration, actions to enforce the patent began with proof of entitlement to the patent, if disputed by the defendant. The burden of proving infringement was also on

the plaintiff, if infringement was disputed. The English reports show that often patent infringement actions turned on the issue of entitlement or validity, whereupon when validity was found, verdict would be rendered for infringement. For example, Dolland's Case, 1 Carp. P.C. 28 (C.P. 1766)⁹ was an action for trespass on the case, seeking damages resulting from infringement of Dolland's 1758 patent on a telescope. The defendant asserted invalidity due to prior use. The jury verdict was for Dolland.

Morris v. Bramson, 1 Carp. P.C. 30 (K.B. 1776) was an action for infringement of Morris' patent, a patent previously tried and adjudged valid and infringed in Morris v. Else. (Morris v. Else is unreported in the English Reports; the case is discussed in Boulton v. Bull, 2 H. Bl. at 489.) In Morris v. Bramson the defendant argued that an addition to an old machine was not patentable as a matter of law. The judge instructed the jury on the law, and the jury found for the plaintiff, awarding 500 pounds in damages for infringement. 1 Carp. P.C. at 31.

Bramah v. Hardcastle, 1 Carp. P.C. 168 (K.B. 1789), was an action in trespass on the case for infringement of letters patent for a new construct of a water closet. The defendant asserted invalidity due to prior use and lack of novelty. Lord Kenyon is reported as telling the jury "the patent was void, the invention not being new," *id.* at 171,

⁹Carpmael lists the date of the decision as 1758, and Abbott *supra*, at 9, states the date as 1766. The date of the patent grant is 1758, suggesting that Abbott may be correct. There is no official report of Dolland's Case, but the decision is discussed in Boulton v. Bull, 2 H. Bl. 463, 482-87 (K.B. 1795).

and that they should find for the defendant.¹⁰ The jury sustained the patent, and found infringement. The court entered judgment in accordance with the jury verdict.

Arkwright v. Nightingale, 1 Carp. P.C. 38 (C.P. 1785), was an action for infringement of a 1775 letters patent for "machines of utility in preparing silk, cotton, flax and wool for spinning." At trial the defendant claimed that the patent was invalid because of an inadequate disclosure in the specification. At the close of the trial, Lord Loughborough provided a lengthy summary of the evidence, and concluded his charge with: "Therefore the single question is, whether you believe these five witnesses are perjured, or that they speak the truth. According as you are of the opinion, one way or the other, you will find your verdict for the plaintiff or the defendant." 1 Carp. P.C. at 53. The jury rendered a verdict for the plaintiff, that is, infringement by the defendant.

Rex v. Arkwright, 1 Car. P.C. 53 (K.B. 1785): After the decision in Arkwright v. Nightingale, *supra*, a *scire facias* was filed with the High Court of Chancery to repeal the patent from the rolls, the petitioner asserting in part that the invention was not new as to use in England, and that Arkwright was not the inventor. The issue was tried to a jury in King's Bench. After the close of the evidence, the court instructed the jury:

¹⁰Hanbury, *supra*, at 87-88, explains that the court was not instructing the jury on what verdict it must render. The practice was for the judge to summarize the evidence and the testimony, and frequently provide a "hint" to the jury. However, this did not diminish the authority of the jury to decide the matter.

Gentlemen, thus the case stands as to the several component parts of this machine; and if upon them you are satisfied none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant; upon either of these points the prosecutor is entitled to your verdict.

1 Car. P.C. at 101. The jury found for the prosecutor.

Turner v. Winter, 1 T.R. 602 (K.B. 1787), reports a ruling on a motion to set aside a jury verdict of patent infringement and grant a new trial. The court granted the motion, explaining that:

And if it appear that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. Here it does appear to me, that there is at least such a doubt on the evidence, that I cannot say this matter has been so fully and fairly examined, as to preclude any further investigation of the subject.

1 T.R. at 605. The case was remanded for a new trial.

Administrators of Calthorp v. Waymans, 3 Keb. 710 (K.B. 1676) was an action for infringement of a patent on an engine. The jury was instructed that English law required novelty only in England, and did not require that an importer/patentee of a device new to England be the actual inventor. The jury found for the patentee, the report of the

case explaining that "it appeared in evidence to a jury at Bar, that the fashion came out of Holland, and was there used above fifty years since, but never before used in England." 3 Keb. at 710.

I again stress that actions at law were tried to a jury. With respect to letters patent for inventions, and in accordance with the Statute of Monopolies, in seventeenth- and eighteenth- century England patent infringement was tried to a jury at common law. I have come upon no exception in the cases reported during this period.

B. CONTINUITY IN THE UNITED STATES

The reports of English patent cases do not manifest the turmoil in preserving the jury right in England, the imprisonment of jurors before 1670, and attempts to limit the jury right in England as well as in the American colonies. Reflecting this experience, there was in the new United States a reverence for the place of the jury as, in the words of Thomas Jefferson, "the only anchor yet imagined by man, by which a government can be held to the principles of its constitution." Parklane Hosiery Co. v. Shore, 439 U.S. 322, 343 n.10 (1979) (Rehnquist, J., dissenting) (quoting 3 The Writings of Thomas Jefferson 71 (Washington ed. 1861)).

The Supreme Court summarized a long history in the statement:

The trial by jury is justly dear to the American people. It has always been an object of deep interest and solicitude, and

every encroachment upon it has been watched with great jealousy.

Parsons v. Bedford, 28 U.S. (3 Pet.) 433, 445 (1830). Justice Story made clear that the right was not limited to the precise causes of action that existed in the law courts of England. Id. at 446-47. See generally James Fleming, Jr., Right to a Jury Trial in Civil Actions, 72 Yale L.J. 655 (1963). In Curtis v. Loether, 415 U.S. 189 (1974) the Court wrote:

Although the thrust of the Amendment was to preserve the right to jury trial as it existed in 1791, it has long been settled that the right extends beyond the common-law forms of action recognized at that time.

415 U.S. at 193. In Tull v. United States, 481 U.S. 412, 417 (1987) the Court reiterated that the right to jury trial extends to causes of action created by Congress which are similar to common law forms of action. As a recent example, in Chauffeurs, Teamsters, and Helpers Local No. 391 v. Terry, 494 U.S. 558 (1990), the Court considered whether a suit in which an employee sought back pay, for breach of a union's duty of fair representation, carried the right to a jury trial. The Court stated:

To determine whether a particular action will resolve legal rights, we examine both the nature of the issues involved and the remedy sought. "First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we

examine the remedy sought and determine whether it is legal or equitable in nature." Tull, supra, at 417-18 (citations omitted). The second inquiry is the more important in our analysis. Granfinanciera, S. A. v. Nordberg, 492 U.S. 33, 42 (1989).

494 U.S. at 565 (footnote omitted). Observing that the cause of action of a union's duty was unknown in eighteenth-century England, the Court looked to analogous actions, including an action to set aside an arbitration award, an action of a beneficiary against a trustee, and an attorney malpractice action. Id. at 555-56. The Court held that the respondents were entitled to a jury trial under the Seventh Amendment, despite the equitable nature of the underlying action, since the relief sought was legal in nature. See, e.g., Beacon Theaters, Inc. v. Westover, 359 U.S. 500 (1959):

As this Court said in Scott v. Neely, 140 U.S. 106, 109-110: "In the Federal courts this [jury] right cannot be dispensed with, except by the assent of the parties entitled to it, nor can it be impaired by any blending with a claim, properly cognizable at law, of a demand for equitable relief in aid of the legal action or during its pendency."

359 U.S. at 510 (footnote omitted). See also Atlas Roofing Co. v. Occupational Safety and Health Review Comm'n, 430 U.S. 442 (1977).

On this history, it is jarring to come upon the majority's argument that the Seventh Amendment no longer applies because there are now "claims" in the United States

patents, whereas the old English patents did not have claims as we know them. The removal of the jury right is not so casually achieved:

[T]he Constitution is concerned, not with form, but with substance. All of vital significance in trial by jury is that issues of fact be submitted for determination with such instructions and guidance by the court as will afford opportunity for that consideration by the jury which was secured by the rules governing trials at common law.

Gasoline Prods. Co. v. Champlin Ref. Co., 283 U.S. 494, 498 (1931).

However, the argument about claims does bring out a point of curiosity, for the law of eighteenth-century England required specifically in "particularly describing" what was patented, and the patent grant ended with a concise summary of the subject matter, with details annexed in the specification; patent "claims," in turn, are concise summaries of the subject matter, with details annexed in the specification. Following is a portion of a representative letters patent dated March 28, 1764:

To all to whom these presents shall come,
John Morris, of the town of Nottingham,
hosier, sendeth greeting.--

Whereas, the King's Most Excellent Majesty, by letters patent under the Great Seal of Great Britain, bearing the date at Westminster, [gave and granted to the

inventors] sole privilege . . . to make, use, exercise, and vend their invention . . . in which said letters patent is contained a proviso that if the said Thomas and John Morris, and John and William Betts, or any one of the should not particularly describe the nature of the said invention and in what manner the same is to be performed by an instrument, in writing under their hands and seals, or the hand and seal of one of them, and cause the same to be enrolled in the High Court of Chancery . . .

[The specification ending with:] Now know ye, that I, the said John Morris, in pursuance of the said proviso in the said letters patent contained, do hereby declare that the said invention of an engine or machine, on which is fixed a set of working needles, which engine or machine if fixed to a stocking-frame for the making of oilet-holes or net-work in silk, thread, cotton, or worsted, as mitts, gloves, hoods, aprons, handkerchiefs, and other goods usually manufactured upon stocking-frames by a method entirely new, is particularly described in the plans hereunder to annexed.

Morris v. Bramson, 1 Carp. P.C. at 31-31 n.* (emphasis added). The requirement that the inventor "particularly describe" the invention was carried into the United States Patent Act of 1790:

Sec. 2. *And be it further enacted,*
That the grantee or grantees of each patent

shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same

Patent Act of 1790, ch. 7, §2, 1 Stat. 109, 110 (1790) (emphasis added).

This requirement was continued in all subsequent revisions, which were successively more explicit. In 1836 the Patent Act required that the inventor "particularly specify the part, improvement, or combination which he claims as his own invention." Ch. 357, §6, 5 Stat. 117, 119. Again revised in 1870, the statute required that the inventor "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." Ch. 230, §26, 16 Stat. 198, 201. The present statute, enacted in 1952, states that "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35

U.S.C. §112, ¶2. This evolution in statutory directive, requiring the inventor to be more specific as to what had been invented, did not remove the jury from trial of patent infringement cases.

The majority's other response to the Constitution is to call a patent a "statute," arguing that "statutory interpretation" is not for the jury. Designating a patent a statute in order to avoid the Seventh Amendment simply denies history and our heritage. Our judicial responsibility is to uphold the Constitution, not devise ways to circumvent it.

IV

PRECEDENT

A. *FEDERAL CIRCUIT CASES SELECTED FOR CRITICISM AND OVERRULE*

The Federal Circuit early in its existence deplored the "risk of effectively denying the constitutional right spelled out in the first clause of the Seventh Amendment." Railroad Dynamics v. Stucki, 727 F.2d at 1515, 220 USPQ at 937-38. Many Federal Circuit decisions implemented the correct standard of trial and appellate review in patent infringement cases. The majority now expressly disapproves appellate deference to the trier of fact on the issues of fact that are determined in the course of "construing" the meaning and scope of patent claims, issues of fact that are dispositive of the question of patent infringement. The majority singles out seven cases for specific criticism, and fatally taints the many

other cases that applied the correct standard of deference to the trier of fact.

The majority explains that it overrules these cases because this court held that the interpretation of disputed technologic terms in patent claims raises jury-triable issues, or because the panel applied a deferential standard of appellate review. Majority op. at 13-14. The majority does not tell us how such cases will be tried, now that appeal includes mandatory de novo adjudication of what were once recognized as triable facts. Even the least cynical observer must wonder at the court's capacity for this technological overload. A glance at the subject matter of the seven expressly disapproved cases illustrates these problems.

1. McGill, Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984).

The disputed technical term in the patent claim was "recovered liquid hydrocarbon absorbent." On McGill's view of what this term meant, the Zink process would infringe McGill's claim; on Zink's view, the Zink process would not infringe. There was conflicting testimony of technical experts, and the issue was submitted to the jury. On appeal the Federal Circuit made the now-excoriated statement:

If, however, the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, construction of the claims could be left to the jury. In the

later instance, the jury cannot be directed to the disputed meaning for the term of art.

Id. at 672, 221 USPQ at 948 (citations omitted). On appellate review the court considered the meaning of the claims upon the following criterion:

In the instant case, the jury's finding of infringement was predicated on construction of claim 2. To obtain a reversal, Zink must demonstrate that no reasonable juror could have interpreted the claim in the fashion that supports the infringement finding. . . . Zink must convince us that there is not set facts, consistent with McGill's interpretation, that was supported by substantial evidence.

Id. The majority now holds that the meaning of "recovered liquid hydrocarbon absorbent" and the other disputed technical terms that were at issue was not a jury triable issue, and that the Federal Circuit should have, and hereafter will, decide such questions as a matter of law.

2. Bio-Rad Labs., Inc. v. Nicolet Instrument Corp., 739 F.2d 604, 222 USPQ 654 (Fed. Cir.), cert. denied, 469 U.S. 1038 (1984).

The patented device was an interferometer that contained an oscillating mirror that varied the lengths of two of four possible paths of split beams of reflected light, whereby the thickness of the epitaxial layer of a semiconductor was determined from the points of locally maximum constructive interference, by comparing phase

differences. The jury trial lasted forty-four days. On appeal this court stated that we review to determine

whether reasonable jurors, after reviewing all the evidence, could have interpreted the claims to include the sequence of events followed by [the accused optical apparatus].

Id. at 613, 222 USPQ at 661 (citing Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 893, 221 USPQ 669, 673 (Fed. Cir.), cert. denied, 469 U.S. 857 (1984)). This court declined the losing party's request that we make a de novo interpretation of the claims:

We emphasize that our task is not to interpret the claims as though no trial occurred. Both parties submitted testimony in support of their interpretation before the jury. Bio-Rad's interpretation prevailed and was not overturned by the trial judge. On appeal, we consider only whether reasonable jurors could have interpreted the claim in the manner presumed.

Id. at 614, 222 USPQ at 661-62. This practice can no longer be followed, and the Federal Circuit shall somehow conduct these technological analyses for ourselves, as a matter of law.

3. Palumbo v. Don-Joy Co., 762 F.2d 969, 226 USPQ 5 (Fed. Cir. 1985).

This case too is criticized for its holding that the findings of disputed facts of the meaning of claim terms is

for the trier of fact. The appeal reached us on summary judgment. Palumbo sued Don-Joy for infringement of a patent to a patellar brace used in diagnosis and treatment of patellar subluxation (dislocation of the kneecap). In holding that summary judgment was improperly granted, this court referred to the disputed factual issues that had been raised in the depositions, as well as ambiguity in the prosecution history and the need for expert witnesses to present the viewpoint of those of skill in this art. The court stated:

If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law. But when the meaning of a term in a claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction.

Id. at 974, 226 USPQ at 8. Overruling the statement that the meaning of claim terms can raise underlying factual questions and that disputed "claim construction" should be left to the trier or jury, the majority now requires that the Federal Circuit shall make these decisions de novo.

4. Moeller v. Ionetics, Inc., 794 F.2d 653, 229 USPQ 992 (Fed. Cir. 1986).

As I mentioned supra, the majority also disapproves this case, criticizing its holding that "disputes over the meaning of claim language may raise factual questions reviewed for substantial evidence or clear error as the case may be," in the majority's words. The invention was a

system of selectively measuring the concentration of certain cations in the presence of other components, by interposing a membrane barrier and using specified electrodes whereby cation-specific components such as nonactin, gramicidin, and valinomycin form positively charged complexes with the sensing device. The disputed term claims were "electrode," "electrode body," and "disposed in said body." The technologic meaning of these terms, in this usage and this invention, decided whether the terms encompassed the accused system. On appeal this court observed that the meanings of these terms were "clearly disputed," referring to conflicting evidence, and held that the matter required trial, vacating the grant of summary judgment. It appears that this court will now decide what these terms mean as a matter of law.

5. H.H. Robertson Co. v. United Steel Deck, Inc., 820 F.2d 384, 2 USPQ2d 1926 (Fed. Cir. 1987).

In connection with a motion for preliminary injunction, the dispositive issue before the district court was the meaning of "bottomless trench" in a patent for a concrete deck structure for distributing electrical wiring. The defendants argued that their structure was not "truly bottomless" because "horizontal metal sections" and a "horizontal metal strip" constituted a partial bottom. After a four-day hearing, the district court granted the preliminary injunction. In affirming, this court described its standard of review:

Claim construction is reviewed as a matter of law. However, interpretation of a claim may depend on evidentiary material about which

there is a factual dispute, requiring resolution of factual issues as a basis for interpretation of the claim. In this case, there was extensive testimony on the issue of claim construction, including the conflicting views of experts on both legal and factual questions. Those factual considerations that are pertinent to the district court's construction of the term "bottomless" are reviewed under the clearly erroneous standard.

Id. at 389, 2 USPQ2d at 1929 (citations omitted). The majority condemns this case for its recognition that "claim construction" may require resolution of factual issues, and the use of the clearly erroneous standard of review for those factual findings. Not only juries, but trial judges, will now be denied the deference owed to their factual findings.

6. Perini America, Inc. v. Paper Converting Mach. Co., 832 F.2d 581, 4 USPQ2d 1621 (Fed. Cir. 1987).

This too was a bench trial, and had been fully tried to the court. As I mentioned supra, the dispute related to various aspects of machines used in manufacturing paper towels. This court recognized that these were factual issues, reviewed on the clearly erroneous standard:

A trial court's conclusions on the scope of the claims are reviewable as matters of law, but findings on disputed meanings of terms in the claims and on the infringement issue must be shown to have been clearly erroneous.

Id. at 584, 4 USPQ2d at 1624 (citations omitted). The court observed that "legal conclusions [are] dictated by established facts and not the other way around, and does not change the nature of the meaning-of-terms inquiry from one of fact to one of law." Id. The majority strongly criticizes, and overrules, these statements.

7. Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H., 945 F.2d 1546, 20 USPQ2d 1332 (Fed. Cir. 1991).

This was a jury trial. The technology related to rodless piston-cylinders. The invention was for a yoke structure that reduces the forces tending to widen the slit through which the external load is moved by the piston, thereby avoiding loss of cylinder pressure. At issue was the meaning of the term "to provide for lateral support of the portions of the cylinder separated by the slit and spanned by the yoke." The decision required a choice between Tol-O-Matic's position that this term meant that the yoke must prevent all widening of the slit, and Proma's position that this term required only some resistance to slit widening. At the trial there was testimony by engineers representing both sides, who ran tests on rodless cylinders under various conditions and reached inconsistent results. The jury was instructed to consider all of the evidence and find the meaning of the disputed term, and then to apply it to the accused device. On appeal this court endorsed the procedure:

The interpretation of claims is defined as a matter of law based on underlying facts. Interpretation of the claim words "provide for

lateral support" required that the jury give consideration and weight to several underlying factual questions, including in this case the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technologic evidence offered by the expert witnesses. When the meaning of a term in a patent claim is unclear, subject to varying interpretations, or ambiguous, the jury may interpret the term en route to deciding the issue of infringement. The jury's verdict of noninfringement is reviewed, in accordance with the rules governing review of jury determinations, to ascertain whether reasonable jurors could have interpreted the claim in a way that supports the verdict.

Id. at 1549-50, 20 USPQ at 1335-36 (emphasis added) (citations omitted).

This case is severely criticized for the emphasized statements. According to the majority these questions are not factual, can not be given to the jury, are not reviewed with deference to the trier of fact, and will be decided de novo by the Federal Circuit.

B. OTHER IMPUGNED FEDERAL CIRCUIT CASES

The court in Tol-O-Matic cited Tillotson, Ltd. v. Walbro Corp., 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); Tandon Corp. v. United States Int'l Trade Comm'n.

831 F.2d 1017, 4 USPQ2d 1283 (Fed. Cir. 1987); Howes v. Medical Components, Inc.; Moeller v. Ionetics, Inc.; Snellman v. Ricoh Co., Ltd., 862 F.2d 283, 8 USPQ2d 1996 (Fed. Cir. 1988) *cert. denied*, 491 U.S. 910 (1989); Vieau v. Japax, Inc., 823 F.2d 1510, 3 USPQ2d 1094 (Fed. Cir. 1987); Data Line Corp. v. Micro Technologies, Inc., 813 F.2d 1196, 1 USPQ2d 2052 (Fed. Cir. 1987); Palumbo v. Don-Joy Co.; Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.; Perkin-Elmer Corp. v. Computervision Corp.; and McGill, Inc. v. John Zink Co. Only some of these decisions are today singled out for criticism; but all explicitly recognized the now-rejected difference between fact and law as applied to the meaning of disputed terms in patent claims, and all deferred, on appellate review, to the findings of the trier of fact.

For example, Data Line v. Micro Technologies related to computer technology wherein the jury, hearing expert testimony, interpreted "means for sensing the presence or absence of output data"; this court on appeal rejected the appellant's argument that the trial court should have "determine[d] the scope and construction of claim 1," and instead gave deferential review to the jury verdict. In Snellman v. Ricoh the jury verdict was reviewed on the substantial evidence standard, not *de novo*. In Delta-X Corp. v. Baker Hughes Production Tools, Inc., 984 F.2d 410, 415, 25 USPQ2d 1447, 1450 (Fed. Cir. 1993), this court approved the trial procedure whereby "because of disputes over claim terms, the judge instead left resolution of these disputes to the jury."

There are many more cases than those I have listed, in which the jury decided technological and other factual disputes concerning the meaning and scope of terms of patent claims, thereby also deciding the fact of infringement, and where the jury verdict was reviewed on the usual substantial evidence/reasonable jury standard. There are many more cases than those I have listed, in which the district court at bench trial found the facts of what the claim terms mean and cover, and on appellate review this court applied the clearly erroneous standard of review. These procedures, which are in accord with factual determinations in other areas of litigation, have now been rejected. The new and unique treatment of disputed facts in patent cases does not appear to offer advantages to outweigh its disadvantages.¹¹

C. THE MAJORITY'S CITED AUTHORITY

The authority on which the majority relies simply does not support its statement that "the Supreme Court has repeatedly held that construction of a patent claim is a matter of law exclusively for the court." Majority *op.* at 15. That statement is of course correct when deciding the legal effect

¹¹Although some *amici curiae* encouraged the Federal Circuit to find technological facts for ourselves, none explained the procedure by which we are to do so. Are we to read the entire record of the trial, re-create the demonstrations, decipher the literature of the science and art; are we to seek our own expert advice; must the parties be told the technical training of our law clerks and staff attorneys? No *amicus* explained how improved technological correctness -- that is, truth -- would be more likely to be achieved during the appellate process of page-limited briefs and fifteen minutes per side of argument.

of a patent claim, and when stating the law to be applied by the trier of fact in interpreting disputed terms. However, it is not correct with respect to findings of disputed factual issues, issues that usually relate to the meaning and scope of the technologic terms and words of technical art that define the invention. Even the majority's selected authority recognized that such issues are factual, to be found by the jury. Although the majority now equates these factual findings with "construction of a patent," the Supreme Court did not.

In Winans V. Denmead, 56 U.S. (15 How.) 330 (1854) the invention was the conical shape of a coal-carrying railroad car, whereby the car could carry several times its weight in coal. The car described and claimed in Winans' patent had a circular cross-section; the accused care of Denmead had an octagonal cross-section. The trial court instructed the jury that since the patent described the circular shape, it was so limited. The Supreme Court held that the instruction was in error, and that the jury should have been instructed on the legal rule that the thing patented was not limited to the exact shape or form illustrated, but depended on whether the same function was performed in substantially the same way and with the same result -- the rule now called the "doctrine of equivalents."

As the majority states, the Court indeed "construed" the "thing patented." 56 U.S. at 338. The "construction" was the legal rule that the claim could be infringed by an equivalent structure. Having corrected this error of law in the jury instructions, the Court did not then answer the factual question for itself, as now does the Federal Circuit.

The Court remanded for retrial to the jury, on the correct instruction of law:

Whether, in point of fact, the defendant's cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.

56 U.S. at 344.

In Silsby v. Foote, 55 U.S. (14 How.) 218 (1853), also relied on by the majority, the Court again did not remove factual issues from the jury. The Court construed the patent claim as a combination claim, and stated that the trial judge correctly instructed the jury on the law that all of the necessary parts of the claimed combination must be present in an infringing device. These were indeed matters of law. The Court stated that the trial judge properly left to the jury the question of which parts of the claimed device were necessary to its operation (which was to regulate the heat of a stove by automatically varying the position of the damper in response to temperature changes), as well as whether the defendants used these necessary parts.

The defendants had argued that the trial judge had impermissibly left a question of law to the jury. The Court pointed out that the question of which parts were necessary to regulate the heat of the stove was not a matter of law, but a question of fact to be decided by the jury:

The substance of the charge is, that the jury were instructed by the Judge, that the third claim in the specification was for a combination of such parts of the described mechanism as were necessary to regulate the heat of the stove; that the defendants had not infringed the patent, unless they had used all the parts embraced in the plaintiff's combination; and he left it to the jury to find what those parts were, and whether the defendants had used them.

We think this instruction was correct. The objection made to it is, that the court left to the jury what was matter of law. But an examination of this third claim, and of the defendants' prayers for instruction, will show that the Judge left nothing but matter of fact to the jury. The construction of the claim was undoubtedly for the court. The court rightly construed it to be a claim for a combination of such of the described parts as were combined and arranged for the purpose of producing a particular effect, viz., to regulate the heat of a stove.

. . . . But the defendants also desired the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination. How could the Judge know this as matter of law?

Id. at 225-26. The Court affirmed that the factual question of what the claim covered was for the jury to decide, in the course of determining the question of infringement. Indeed, the Court's query was pointed: "How could the Judge know this as a matter of law?" Id. at 226.

In Coupe v. Rover, 155 U.S. 565 (1895) the Court held that there was legal error in the trial judge's description of the invention to the jury, and in the withdrawal of the question of infringement from the jury. The Court held that the trial judge had omitted a limitation contained in the claims of the patent (viz., that the orientation of the machine was vertical). It was indeed legal error to omit a claim limitation, then as now, and the Court, correcting this error, remanded for a new trial to the jury. The Court declined to give a peremptory instruction to the jury, stating that all of the differences are "the subject of legitimate consideration by the jury":

[T]he question of infringement, arising upon a comparison of the Royer patent and the machine used by the defendants, should be submitted to the jury, with proper instructions as to the nature and scope of the plaintiffs' patent as hereinbefore defined, and as to the character of the defendants' machine.

155 U.S. at 579-80. This case again illustrates the Court's role as assuring that the law is correctly stated to the jury, and the jury's role as trier of fact. Again, a case relied on by the majority does not support the majority's position.

In Bischoff v. Wethered, 76 U.S. (9 Wall.) 812 (1870) the Court distinguished between the construction of the patent as a legal instrument, and the factual nature of the thing invented:

It is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions.

76 U.S. at 816. The issue was identity of invention, and the Court reiterated that the meaning of disputed terms of art is "a question of fact for the jury." Id. at 814. The majority includes Bischoff as authority for its removal of these findings of fact from the jury. That is a curious reading of the holding in Bischoff:

A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of the evidence. But in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the court. And under this rule of practice, counsel would not have the right to require the court, as a matter of law, to pronounce upon the identity or

diversity of the several inventions described in the patents produced.

Id. (emphasis added). Indeed, only two years later the Court again considered the issue, and in Tucker v. Spalding, 80 U.S. (13 Wall.) 453 (1872) the Court held that a prior patent and related expert testimony on the issue of "diversity or identity" were improperly withheld from the jury, describing the issue as a "mixed question of law and fact," and stating:

Whatever may be our personal opinions of the fitness of the jury as a tribunal to determine the diversity or identity in principle of mechanical instruments, it cannot be questioned that when the plaintiff, in the exercise of the option which the law gives him, brings his suit in the law in preference to the equity side of the court, that question must be submitted to the jury, if there is so much resemblance as raises the question at all. And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may on this mixed question of law and fact, lay down to the jury the law which should govern them, so as to guide them to truth, and guard them against error, and may, if they disregard instructions, set aside their verdict, the ultimate response to the question must come from the jury.

80 U.S. at 455.

In Winans v. New York and Erie R. Co., 62 U.S. (21 How.) 88 (1859) infringement was conceded, and the issue at trial was "originality." The Court stated that the trial judge "has given the only construction which the language of this specification will admit," *id.* at 101, in explaining to the jury that the invention was in the manner of arranging the wheels and the car body. Having explained the invention to the jury, the question of originality was held to be for the jury, not the court.

In discussing the appropriate use of expert witnesses, the Winans Court stated that "professors or mechanics" can not prove "legal construction of any instrument of writing," but may testify on matters of art or science:

Experts may be examined to explain terms of art, and the state of the art, at any given time. They may explain to the court and jury the machines, models, or drawings, exhibited. They may point out the difference or identity of the mechanical devices involved in their construction. The maxim of "unique in sua arte credendum" permits them to be examined to questions of art or science peculiar to their trade or profession; but professors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument in writing.

62 U.S. at 100-01. On this aspect, too, the case does not stand for the removal of factual findings from the jury; indeed the Court recognized the various kinds of evidentiary facts on which technical experts routinely testify in patent cases.

In Heald v. Rice, 104 U.S. 737 (1882) the Court stated that when there was no dispute about the technology, no need for evidence, and no question of fact requiring resolution by a jury, the "mere comparison" of a reissue and original patent was a matter of law for the court. Other cases related to a directed verdict when no fact was in dispute, e.g., Singer Mfg. Co. v. Cramer, 192 U.S. 265 (1904) (the trial court should have granted a directed verdict when there was no dispute as to the meaning of any term of art and no substantial evidence of infringement); or the grant of a new trial, e.g., Market St. Cable Ry. Co. v. Rowley, 155 U.S. 621 (1895) (since the facts were not disputed and no extrinsic evidence was given or needed, the court should have instructed the jury on lack of patentable novelty; the Court remanded with directions to set aside the verdict and grant a new trial). The new trial and the directed verdict are modes of judicial management of the trial process, and quite different from the majority's decision simply to eliminate the jury.

Hogg v. Emerson, 47 U.S. (6 How.) 437 (1848), another case relied on by the majority, was part of a lengthy litigation. There was a jury trial, review by a circuit panel, retrial to a jury, and two appeals to the Court. In this appeal the Court considered which documents were properly considered when "construing" the patent, in view of the fire that destroyed the Patent Office files in 1836. In reviewing the question of whether the patent in suit covered the entire steam engine or only the improvement, the Court "construed" the patent as covering only the improvement. *Id.* at 484. The Court affirmed the trial court, which the report states "left the question of fact as to reasonable

diligence of the patentee or not in this respect, and also all questions of fact involved in the points of the case for the defendants, to the jury." Id. at 445.

The majority also relies on Levy v. Gadsby, 7 U.S. (3 Cranch) 180 (1805), wherein the Court rules that a certain document was a contract and not some other form of transaction, and was subject to the usury law. This was legal construction of a document, and was decided by the Court. This case says nothing about removing disputed factual questions from the jury. The majority also cites Eddy v. Prudence Bonds Corp., 165 F.2d 157, 163 (2d Cir. 1947), cert. denied, 333 U.S. 485 (1948), wherein the court, reviewing the legal operation of a court-approved Supplemental Trust Agreement in bankruptcy in view of a court order, stated that "appellate courts have untrammelled power to interpret written documents." This determination of legal effect is indeed "construction" of a legal document.

I shall not dwell on the majority's reliance on other cases that were bills of equity and tried to the court, for they do not raise the issue of the jury right. See Loom Co. v. Higgins, 105 U.S. 580 (1881) (determining if patentee was the true inventor, and whether patent claim was sufficiently described in the specification); Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222 (1880) (limiting Goodyear's claims to dentures manufactured by vulcanization); Bates v. Coe, 98 U.S. 31 (1878) (determining which elements constituted the invention and which constituted equivalents); Merrill v. Yeomans, 94 U.S. 568 (1876) (construing patent claim in light of specification as only for process of manufacture); and Seymour v. Osborne, 78 U.S. (11 Wall.)

516, 546 (1871) (discussing "scientific witnesses to aid the court in coming to a correct conclusion"). The majority cites Merrill v. Yeomans as "applying 'well-settled rules of construing all instruments.'" The rule the Court applies at this quotation is that words and phrases are to be construed so as to give them meaning. 94 U.S. at 571. This is indeed a rule of law; the Court did not convert findings of fact into rules of law. Nor should it be necessary to point out that when cases are tried "to the court," majority op. at 21-22, the resolution of disputes as to what claim terms mean is indeed "for the court."

Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 52 USPQ 275 (1942), also cited by the majority, turned on prosecution history estoppel resulting from an amendment to the claims in the Patent Office. The Court stated the rule of law that "what the patentee, by a strict construction of the claim, has disclaimed . . . cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction." There was no dispute as to the meaning of technical terms, and the Court applied this rule of law to the undisputed facts. This had been a bench trial, on bill of equity. Ace Patents Corp. v. Exhibit Supply Co., 119 F.2d 349, 48 USPQ 667 (7th Cir. 1941). It is difficult to discern the relevance of this case to the issues in Markman.

Many dozens of patent cases reached the Supreme Court. Some of those relied on by the majority as support for trial to the court were bills in equity. Of those in law, most were tried to a jury. It is not possible to diminish the great weight of precedent wherein patent infringement was

tried to a jury, the jury deciding disputed factual questions of what the patent covered, and applying these findings to the accused device. The court today effects a dramatic realignment of jury, judge, and the appellate process.

D. THE SPECIAL RESPONSIBILITY OF THE FEDERAL CIRCUIT

The Federal Circuit is responsible for establishing consistent national law in its area of assigned subject matter. The court early in its existence took note that patent cases were only one of many areas of commercial dispute, only one of many areas of intellectual property dispute, that are tried in the district courts. We have striven to assure that unnecessary burdens are not placed upon the district courts of the nation by virtue of the separate path of appellate review of patent cases. We acted to assure that the same procedures would apply in the trial of patent cases as in other civil actions. *See, e.g., Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1563, 5 USPQ2d 1769, 1774 (Fed. Cir.) (for matters not unique to patent law the procedural law of the regional circuit applied in patent trials), *cert. denied*, 488 U.S. 850 (1988). Thus the litigation process that served other civil disputes also served in patent litigation. Today's ruling, with its departures from the rules of evidence, its changed standards of deference and review, its conflict with established jury and bench procedures, challenges the principle on which this comity was based.

Patent cases are not unique in their usage of specialized terms and words of art, in their reliance of

technologic or scientific evidence, in their dependence on findings of technologic fact. Evidentiary conflicts with respect to technology and science arise in a variety of cases; and the conflicting testimony of expert witnesses is ubiquitous. Trial judges have extensive experience in assuring a fair trial, and finding, within human limitations, the truth.¹² Today this court severs patent cases from all others, requiring different (and uncertain) procedures at trial, taking unto ourselves a different, and uncertain, appellate role.

It is the responsibility of the appellate court to assure that the law is correctly stated. The rules of patent law include an ever-enlarging body of nuance and clarification, flowing from twelve years of Federal Circuit jurisprudence and the rich history on which we have built. This court has undertaken the fine-tuning of the law, appropriate to the importance of technology in today's world. Much of this fine-tuning relates to new fields of science and technology (computers, biotechnology, materials); but it also relates to traditional concepts of patent law as applied to modern technologic and commercial needs.

¹²Many aids to the trial process are at hand when the issues are scientific and technologic. The *Manual for Complex Litigation, Second* (1985) points out the utility of special verdicts and interrogatories *see*, § 21-633, and that Fed. R. Evid. 706 is particularly useful when experts have divergent opinions, *see* § 21.51. Important studies have been made, *see* the Federal Judicial Center's *Reference Manual of Scientific Evidence* (1994). No study that I have seen or heard of proposes simply to turn complex factual determinations of technical issues over to the appellate court. To replace the trier of fact with the Federal Circuit is as unfriendly to the search for truth, as it is unworkable.

The appellate role is to apply these principles in wise implementation of the policy of the law, as litigants probe the grey areas that test conflicting policy considerations. The appeal is not designed for de novo finding of the facts. I doubt the practical feasibility of the majority's holding that this court will "construe" the meaning of technical terms and words of art without benefit of the trial experience. It is of course appropriate for this court to be alert to methodologies of resolution of disputes that involve science and technology. The trial of scientific/technologic disputes was explored, for example, in the Report of the Carnegie Commission, Science and Technology in Judicial Decision Making (1993); the Report of the Brookings Institution, Charting a Future for the Civil Jury System (1992); and in ongoing studies and Reports of the Federal Judicial Center. However, in this complexity of problems and solutions, it is an illusion to think that patent litigation difficulties can be resolved by turning factual issues into matters of law and assigning them to the Federal Circuit.

The deference that appellate courts must give to the trial process is fundamental to the efficiency, and the effectiveness, of the judicial system. It implements the two-tier litigation right, and provides stability to the trial process while preserving appellate authority for the law, its policy and its purposes. The court's decision today denies the critical values of the trial, and moves the Federal Circuit firmly out of the juridical mainstream.

V

THE MERITS

Both sides testified on the meaning and scope of the term "inventory," as used by Markman and in light of the Westview system. The issue was whether "inventory" meant only clothing, or could reach the invoices of the Westview system. Markman presented four witnesses. Westview presented one witness. After the jury verdict in favor of Markman the district court, applying recent Federal Circuit panel opinions that required de novo determination of the issue (foreshadowing today's en banc holding), reviewed the evidence independently and decided in favor of Westview. The district court did not discuss the jury verdict, or state whether there was evidentiary support for the jury verdict.

The district court did not apply the proper standard on post-trial motions, viz. whether there was substantial credible evidence of such quality and weight that a reasonable jury could have reached the verdict that was reached by this jury. It is for the trial judge to decide, in the first instance, whether the jury verdict can stand, or whether the judgment should have been directed, or whether a new trial should be granted. I would remand for redetermination on the correct standard.

160a

Appendix B

**United States Court of Appeals
for the Federal Circuit**

92-1049

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

JUDGMENT

ON APPEAL from the

UNITED STATES DISTRICT
COURT FOR THE EASTERN
D I S T R I C T O F
PENNSYLVANIA

in CASE NO(S).

91-940

*This CAUSE having been heard and considered,
it is*

ORDERED and ADJUDGED:

161a

AFFIRMED

*ENTERED BY ORDER OF THE
COURT*

DATED APR 5 1995

*/S/ FRANCIS X. GINDHART
Francis X. Gindhart, Clerk*

[ISSUED AS A MANDATE: April 26, 1995]

162a

Appendix C

**United States Court of Appeals
for the Federal Circuit**

92-1049

HERBERT MARKMAN and POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

ORDER

The appeal, having been submitted after oral argument to a panel of the court and, thereafter, a majority of the circuit judges who are in regular active service having ordered, sua sponte, that the appeal be heard by the court in banc,

IT IS ORDERED that the appeal shall be heard in banc.

163a

The parties will be advised in due course if additional briefing and oral argument will be required.

FOR THE COURT

/S/ FRANCIS X. GINDHART

Francis X. Gindhart

Clerk

11/5/93

**[FILED
U.S. COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT
NOV 5 1993]**

cc: William B. Mallin, Esq.
Frank H. Griffin, III, Esq.

**FRANCIS X.
GINDHART
CLERK**

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

Appendix D**United States Court of Appeals
for the Federal Circuit**

91-1393, -1394, -1409

PALL CORPORATION,

Plaintiff/Cross-Appellant,

v.

MICRON SEPARATIONS, INC.,

Defendant-Appellant.

92-1049

HERBERT MARKMAN and POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Defendants-Appellees.

ORDER

On further consideration of the appeals now pending before the court in banc, and because the above appeals raise significant issues related to interpretation of a claim in a patent, it is

ORDERED that additional briefing by the parties and by amici curiae may be filed as follows:

The briefs for appellants on rehearing in banc shall be filed on or before February 14, 1994. The briefs for appellees on rehearing in banc shall be filed on or before March 14, 1994.

The court is particularly interested in briefing on:

(1) Are disputes over the meaning of a term in a claim (a) issues of law to be decided on a documentary record, similar to questions of statutory construction, or (b) are there some claim construction disputes that can only be resolved by resort to extrinsic evidence which requires the taking of factual and expert testimony?

(2) If factual or expert testimony is proffered to resolve a particular dispute, what are the respective roles of the trial judge and jury?

(3) When a claim construction dispute is on appeal to this court, what is the standard of review this court should apply to the judgment below on the merits? With regard to permissible post-trial motions?

(4) When the meaning of a claim term must be decided in the course of deciding the question of infringement, what are the respective roles of trial judge and jury?

Amicus curiae briefs on rehearing in banc may be filed in accordance with Rule 29.

Oral argument will be scheduled after the briefs have been filed.

Briefs shall be filed in 30 copies.

FOR THE COURT

1/7/94 /S/ FRANCIS X. GINDHART
Francis X. Gindhart
Clerk

cc: Steven M. Bauer
H. Michael Hartmann
William B. Mallin
Frank H. Griffin, III
Michael E. Zall

[FILED]
U.S. COURT OF
APPEALS FOR THE
FEDERAL CIRCUIT
JAN 7 1994
FRANCIS X.
GINDHART]
CLERK

91-1393, -1394, -1409
92-1049

168a

Appendix E

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF
PENNSYLVANIA**

HERBERT MARKMAN and POSITEK, INC.	
v.	CIVIL ACTION
	NO. 91-0940
WESTVIEW INSTRUMENTS, INC. and ALTHON ENTERPRISES, INC.	

J U D G M E N T

AND NOW, this 1st day of October, 1991, it is hereby **ORDERED** that judgment is entered in favor of defendants and against plaintiffs.

BY THE COURT:

/S/ MARVIN KATZ, J.

MARVIN KATZ, J.

[ENTERED: 10/2/91

CLERK OF COURT]

169a

Appendix F

**IN THE UNITED STATES
DISTRICT COURT
FOR THE EASTERN
DISTRICT OF
PENNSYLVANIA**

HERBERT MARKMAN and POSITEK, INC.	
v.	CIVIL ACTION
	NO. 91-0940
WESTVIEW INSTRUMENTS, INC. and ALTHON ENTERPRISES, INC.	

O R D E R

AND NOW, this 30th day of September, 1991, upon consideration and hearing of the Motion For A Directed Verdict, it is hereby **ORDERED** that the Motion is **GRANTED**.

BY THE COURT:

/S/ MARVIN KATZ, J.

MARVIN KATZ, J.

Appendix G

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF
PENNSYLVANIA**

HERBERT MARKMAN and POSITEK, INC. <p align="center">v.</p> WESTVIEW INSTRUMENTS, INC. and ALTHON ENTERPRISES, INC.	CIVIL ACTION NO. 91-0940 [Filed SEP. 30, 1991] [ENTERED: 10/1/91 CLERK OF COURT]
--	---

MEMORANDUM

M. Katz, J.

September 30, 1991

The issue is a motion for a directed verdict in this patent infringement case about an inventory control device used by laundries and dry cleaners. Defendants argue that the language of the patent and evidence presented at trial require an interpretation by the court of the patent claims at

issue. Defendants argue that the undisputed facts concerning the capabilities of its product coupled with the correct reading of the patent claims require a verdict in its favor. For the following reasons, this court grants the motion for a directed verdict. The ruling controls as to both defendants. The jury verdict in favor of defendants controls as to claim 14. This ruling controls as to claims 1 and 10.

The question of claim construction is a matter of law for the court. Kraus v. Bell Atlantic Corp., 716 F. Supp. 182, 184 (E.D. Pa. 1989). As the court stated in Becton Dickinson and Co. v. C. R. Bard, Inc., 922 F.2d 792, 797 (Fed. Cir. 1990), "A mere dispute concerning the meaning of a term does not itself create a genuine issue of material fact." Plaintiffs' expert did attempt to redefine several common words in unusual ways. Thus, plaintiffs have attempted to give novel meaning to the terms "inventory", "report" and "attached to" in order to sustain the claims of infringement.

The patent-in-suit, in pertinent part, states the following claims at issue:

CLAIM 1. The inventory control and reporting system, comprising;

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transaction;

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

CLAIM 10. The system of claim 1, wherein the input device is a keyboard having alpha-numeric keys, and also having keys specific to a plurality of common attributes of the articles and common optional attributes of the sequential transactions, said common attributes being recorded using single key strokes.

Plaintiffs' expert testified that these claims "read on" Westview's system because: "report" means "invoice"; "attached to said articles" means "attached to a plastic bag that covers a batch of the articles"; and "inventory" means "cash" or "invoices" not "articles of clothing." These definitions are contrary to the ordinary and customary meaning of these terms, as well as the obvious meaning intended by the patentee, determined from the specifications, the drawings and the file histories of the original patent and the patent-in-suit. In interpreting the meaning of patent claims, "[w]ords in a claim 'will be given their ordinary and accustomed meaning unless it appears that the inventor used them differently.'" Jonsson v. Stanley Works, 903 F.2d 812, 820 (Fed. Cir. 1990) (quoting Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759 (Fed. Cir. 1984); quoting Universal Oil Prods. Co. v. Globe Oil & refining [sic] Co., 137 F.2d 3, 6 (7th Cir. 1943), aff'd, 322 U.S. 471 (1944)). The inventor may not change the meaning of his words to fit the particular circumstances of a trial. Chicago Steel Foundry Co. v. Burnside Steel Foundry Co., 132 F.2d 812, 814-15 (7th Cir. 1943).

Plaintiffs' technical expert's testimony is based on an artificial interpretation of key words and phrases that runs counter to their ordinary meaning. The patent expert's testimony about the interpretation of the claim is not helpful because that is a legal issue for the court. "Construction of claim scope (claim interpretation), ... is a question of law for decision by the trial judge on motion for JNOV Once an interpretation has been made, that same interpretation must be employed in determining literal infringement and infringement under the doctrine of equivalents." Senmed,

Inc. v. Richard-Allan Medical Industries, 888 F.2d 815, 818 (Fed Cir. 1989).

A finding of literal infringement requires that the accused device include every element of the claim as properly interpreted. Texas Instruments, Inc. v. I.T.C., 805 F.2d 1558, 1562 (Fed. Cir. 1986). In the absence of literal infringement, a finding of infringement under the doctrine of equivalents is warranted only when the accused device performs substantially the same function, in substantially the same way, to obtain substantially the same overall result as the claimed invention. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed. Cir. 1987), cert. denied, 485 U.S. 961 (1988).

In this case, the patent-in-suit relates to inventory control devices capable of monitoring and reporting upon the location of inventory in a dry cleaning and laundry establishments. Simply put, defendants' device lacks such capability. Inventory means articles of clothing. The patent claims track articles of clothing by using computer memory. Defendants' device has no "means to maintain" inventory in memory. Claims 1 and 10 define a system that includes a data processor, or computer, which has sufficient memory to record information about sequential transactions, including the identity and descriptions of the articles of clothing involved, and which also has the means or ability to generate at least one report of inventory total and transaction totals in which the unique sequential indicia, or invoice number, and the description of the articles in the transaction can be reconciled against one another. A system, like defendants', which does not have memory operable to record and store

and later use information about clothing articles does not infringe the patent-in-suit.

Claims 1 and 10 also define a system in which the data processor has both the memory to and the means to maintain an inventory total. A system like defendants' which lacks both that memory and the means to maintain an inventory total does not infringe the patent-in-suit. Inventory means articles of clothing, not just dollars. To read the word inventory otherwise would lead to "semantic antics" in reading the claim that the "... system can detect and localize spurious additions to inventory as well as spurious deletions therefrom." It is difficult to visualize a system that would detect and localize spurious dollar deletions and additions to inventory. A construction of "inventory" which excludes articles of clothing in the shop would hardly be one ordinary meaning of that word. Plaintiffs' device tracks articles of clothing; defendants' device does not.

Further, claims 1 and 10 define a system which, unlike defendants', has at least one optical scanner connected to the data processor operable to detect bar codes on all articles of clothing which pass a predetermined, or fixed station. A system, like defendants', lacking that capacity, does not infringe this patent. Tracking invoices is different from tracking articles of clothing.

Claims 1 and 10 are for an inventory and control system which must be able to detect and localize spurious additions to inventory as well as deletions from inventory. As used in claim 1, inventory refers to both cash inventory and the actual physical inventory of articles of clothing. A

system like defendants' lacking such dual capacity does not infringe this patent. Since claim 10 is dependent on claim 1, that claim of infringement also fails. Wahpeton Canvas Co. v. Frontier, Inc., 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

While it may be true that defendants' sales or instructions literature exaggerated its systems' capabilities, spurious advertising claims for defendants' products do not a patent infringement case make. National Union Fire Ins. Co. v. Siliconix Inc., 729 F. Supp. 77, 79 (N.D. Cal. 1989); Welding Engineers v. Aetna-Standard Engineering Co., 169, F. Supp. 146, 149 (W.D. Pa. 1958). Plaintiffs' patent claims are for a sophisticated inventory control device tracking individual articles of clothing. Defendants sell a rudimentary invoice printer, like a cash register that produces a receipt, one copy of which is handed to the customer while the other copy is attached to batches of clothing. Plaintiffs' claims are for a device with computer memory storing descriptions of the clothing. Defendants' device has no memory of a transaction after it prints the invoice. Defendants' device does not include every element of the claims, nor does it perform the same function as the claimed invention. Therefore, defendants' device does not infringe either literally or equivalently. See, Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed. Cir. 1987), cert. denied, 485 U.S. 961 (1988); Texas Instruments, Inc. v. I.T.C., 805 F.2d 1558, 1562 (Fed. Cir. 1986).

An appropriate order follows.

3

Supreme Court U.S.
FILED
AUG 7 1995
OFFICE OF THE CLERK

No. 95-26

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

**RESPONDENTS' BRIEF IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI**

FRANK H. GRIFFIN, III
Counsel of Record

PETER A. VOGT
POLLY M. SHAFFER
GOLLATZ, GRIFFIN & EWING, P.C.
Two Penn Center Plaza
Sixteenth Floor
Philadelphia, PA 19102
(215) 563-9400

*Attorneys for Respondents
Westview Instruments, Inc. and
Althon Enterprises, Inc.*

37 002

QUESTION PRESENTED

Did the Court of Appeals for the Federal Circuit properly hold that the granting of judgment as a matter of law was correct in a patent infringement case where there was no reasonable dispute about the meaning of claim language and no genuine issue as to any material fact concerning the accused device?

LIST OF PARTIES PURSUANT TO RULES 14.1(b) AND 29.1

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief in Opposition to Petition for Writ of Certiorari.

Neither Respondent Westview Instruments, Inc. nor Respondent Althon Enterprises, Inc. has any parent companies or subsidiaries.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED.....	i
LIST OF PARTIES PURSUANT TO RULES 14.1(b) AND 29.1.....	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES.....	v
STATUTES OR OTHER PROVISIONS INVOLVED..	1
STATEMENT OF THE CASE	1
SUMMARY OF ARGUMENT.....	3
REASONS FOR DENYING THE WRIT	4
I. The Grant Of JMOL In This Case Was Necessary To Assure The Application Of The Correct Legal Standard	4
II. The Federal Circuit's Holding That The Terms In Markman's Patent Should Be Construed As A Matter Of Law Is Consistent With English Com- mon Law And Is Not In Conflict With This Court's Precedent	6
A. The Petition's Seventh Amendment Argu- ments Are Historically Flawed.....	6
B. English Common Law Teaches That Claim Construction Is A Matter Of Law For The Court	7
C. The Majority Opinion Of The Federal Circuit Is Consistent With Supreme Court Precedent	10
III. The Policies Underlying The Federal Circuit's Decision Are Sound	14
IV. This Case Is Inappropriate For The Court To Review Because All Claims Of The Patent Have Been Rejected By The Patent Examiner	15
CONCLUSION.....	16

TABLE OF CONTENTS—(Continued)

	Page
APPENDIX	
A. 7/26/94 Patent Examiner Order of Final Rejection (Patent and Trademark Office 1994) ..	B-1

TABLE OF AUTHORITIES

Cases:	Page
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	10, 14
<i>Brooks v. Steele and Currie</i> , 14 R.P.C. 73 (1896)	7, 8
<i>Cardinal Chemical Co. v. Morton Int'l, Inc.</i> , 113 S.Ct. 1967 (1993)	16
<i>Collins v. Sawrey</i> , 4 Bro. P.C. 692 (H.L. 1772)	10
<i>Coupe v. Royer</i> , 155 U.S. 505 (1895)	10, 11
<i>Davis v. United States</i> , 417 U.S. 333 (1974)	15
<i>Ex Parte Fressola</i> , 1993 Pat. App. Lexis 3, 27 USPQ2d 1608 (Bd. Pat. App. & Interferences 1993)	7
<i>Heald v. Rice</i> , 104 U.S. 737 (1882)	10, 11, 13, 14
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	10, 13
<i>Intellicall, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992)	5
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574, 12 USPQ2d 1382 (Fed. Cir. 1989)	4, 5
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	10, 12
<i>Kimble v. D.J. McDuffy, Inc.</i> , 454 U.S. 1110 (1981)	15
<i>Liardet v. Johnson, K.B.</i> (1778)	8, 9
<i>Looms v. Higgins</i> , 105 U.S. 580 (1881)	13
<i>Market St. Cable Ry. Co. v. Rowley</i> , 155 U.S. 615 (1895)	10, 13, 14
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995)	1
<i>Mayor of Kingston Upon Hull v. Horner</i> , 1 Cowp. 102 (K.B. 1774)	10
<i>Neilson v. Harford</i> , Webster Patent Cas. 295 (1841)	9

TABLE OF AUTHORITIES—(Continued)

Cases:	Page
<i>Newell Cos., Inc. v. Kenney Mfg. Co.</i> 864 F.2d 757, 9 USPQ2d 1417 (Fed. Cir. 1988), <i>cert. denied</i> , 493 U.S. 814 (1989)	5
<i>Nutrition 21 v. United States</i> , 930 F.2d, 18 USPQ2d 1347 (Fed. Cir. 1991)	5
<i>Pall Corp. v. Micron Sys., Inc.</i> , Appeal Nos. 91-1393,-1394,-1409	2
<i>Ratchford v. Gay Lib</i> , 434 U.S. 1080 (1978)	15
<i>Read Corp. v. Portec, Inc.</i> , 970 F.2d 816, 23 USPQ2d 426 (Fed. Cir. 1992)	5
<i>Senmed, Inc. v. Richard-Allen Medical Indus., Inc.</i> , 888 F.2d 815, 12 USPQ2d 1508 (Fed. Cir. 1989), <i>reh'g denied</i> , 1989 U.S. App. Lexis 17023 (Fed. Cir. 1989), <i>reh'g denied in banc</i> , 1990 U.S. App. Lexis 107 (Fed. Cir. 1990)	5
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1852)	10, 11
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 245 (1904)	10, 13, 14
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	9
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854) .	10, 11, 13
<i>Winans v. New York and Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1858)	10, 13
Statutes Or Other Provisions:	
35 U.S.C. §112	9, 14
H.R. No. 97-312, 97th Cong., 1st Sess. at 9 (1981)	14
Federal Rule Of Civil Procedure 50	1, 4, 5
Other Sources:	
Adams and Averley, "The Patent Specification The Role of Liardet v. Johnson," <i>The Journal of Legal History</i> 156 (1986)	7

TABLE OF AUTHORITIES—(Continued)

Other Sources:	Page
T. Brett, <i>Commentaries on the Present Laws of England</i> Vol. 1 (1890)	7
F. Buller, <i>An Introduction to the Law Relative to Trials at Nisi Prius</i> ch. VII (6th ed. 1791)	9
A. Deller, <i>Patent Claims</i> Sec. 4 (2d ed. 1971)	7
Justice Harlan, "Manning the Dikes," 13 <i>Record of N.Y.C. Bar Assn.</i> 541 (1958)	15
E.W. Hulme, "On the History of the Patent Law in the 17th and 18th Century," 18 <i>Law Quarterly Review</i> 280 (1902)	8
Walker, <i>Textbook of the Patent Law of the United States of America</i> (3d ed. 1895)	12

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents Westview Instruments, Inc. and Althon Enterprises, Inc. ("Westview") respectfully submit this brief in opposition to the Petition for a Writ of Certiorari of Herbert Markman and Positek, Inc. ("Markman" or "Petitioners").

STATUTES OR OTHER PROVISIONS INVOLVED

Federal Rule of Civil Procedure 50 provides:

Rule 50. Judgment as a Matter of Law in Actions Tried by Jury; Alternative Motion for New Trial; Conditional Rulings

(a) Judgment as a Matter of Law

(1) If during a trial by jury a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue against that party and may grant a motion for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue.

(2) **Renewal of Motion for Judgment After Trial; Alternative Motion for New Trial.** Whenever a motion for a judgment as a matter of law made at the close of all the evidence is denied or for any reason is not granted, the court is deemed to have submitted the action to the jury subject to a later determination of the legal questions raised by the motion If a verdict was returned, the court may, in disposing of the renewed motion, allow the judgment to stand or may reopen the judgment and either order a new trial or direct the entry of judgment as a matter of law.

STATEMENT OF THE CASE

Markman's petition is from a 10 to 1 decision¹ of an in banc panel of the United States Court of Appeals for the Fed-

1. *Markman v. Westview*, 52 F.3d 967 (Fed Cir. 1995) (Archer, C.J.) (concurrences by Mayer and Radar, JJ.) (dissent by Newman, J.) Originally, this case was heard by the in banc panel in conjunction with another case,

eral Circuit which concluded that the district court was correct to grant judgment as a matter of law (JMOL) to Westview and to hold that Westview did not infringe Markman's dry-cleaning tracking device patent (United States Reissue Patent No. 33,054) (hereinafter, the "054 patent" or the "Markman patent"). The Federal Circuit held that

Correctly reasoning that claim construction is a matter of law for the court, the district court properly rejected the jury's verdict and granted JMOL. Upon our *de novo* review of the court's construction of the claim language, we agree that "inventory" in claim 1 includes within its meaning "articles of clothing." It is undisputed that Westview's device does not and cannot track articles of clothing. *Accordingly, there is no substantial evidence to support the jury's finding of infringement of claims 1 and 10 of United States Reissue Patent No. 33, 054 when those claims are correctly construed.* The district court's grant of judgment of non-infringement as a matter of law is **AFFIRMED**. (Emphasis added.)

App. 56a. Eight judges joined in the majority opinion of the Court. Judge Mayer filed a separate opinion in which he concurred in the judgment but took issue with the majority opinion's statements about the role of juries in infringement cases in which claim construction might require extrinsic evidence. App. 57a-80a. Judge Radar also concurred in the judgment, but filed a separate opinion on the basis that the jury's role was not at issue in this case since there were no real fact disputes. App. 82a-83a. Finally, Judge Newman dissented from the majority, arguing that the case should have been remanded because the trial judge had failed to apply the "substantial evidence" standard to the jury verdict. App. 159a.

The majority opinion of the Federal Circuit accurately sets forth the statement of facts relevant to the case and Westview incorporates that portion of the opinion by reference. App. 4a- 18a, §I-IIA.

NOTES (Continued)

Pall Corp. v. Micron Sys., Inc., Appeal Nos. 91-1393, -1394, -1409, which raised similar issues.

There is an additional factor bearing on this case that was not part of the appeal to the Federal Circuit and that is absent from Markman's petition. On July 26, 1994, the Patent Examiner issued an order rejecting all 15 claims of the '054 patent on the basis of prior art. (See 7/26/1994 Patent Examiner Order of Final Rejection, attached hereto as Appendix "A.") An appeal is now pending before the Board of Patent Appeals and Interferences.

SUMMARY OF ARGUMENT

In this case the Federal Circuit overwhelmingly agreed, in an in banc determination, that the trial court correctly granted judgment as a matter of law to Westview. The documentary record revealed the one susceptible meaning of the claim, and extrinsic evidence was not a necessary part of proper claim construction. Claim construction in the case clearly was a matter exclusively for the judge and it was his duty to grant JMOL.

The Seventh Amendment arguments made in the petition misunderstand the history upon which they are supposedly based. There are substantial differences between modern patent practice and both 18th Century English patent practice and the original method of patent claiming in this country.

The position of the eight judge majority of the Federal Circuit that claim construction is a question of law for the court even when extrinsic evidence might be necessary to reveal the meaning of the claim is consistent with both English common law and the precedent of this court. There is no conflict with this court's decisions nor is there an important question posed by the petition.

Finally, the final rejection of all claims in the Markman patent and the uncertain future of the patent's validity is an additional factor which makes this case an inappropriate vehicle for the Court to use to consider any of the arguments raised in the petition.

REASONS FOR DENYING THE WRIT

I. THE GRANT OF JMOL IN THIS CASE WAS NECESSARY TO ASSURE THE APPLICATION OF THE CORRECT LEGAL STANDARD.

Markman, the petitioner, contends that "[t]his case presents the question whether the Seventh Amendment permits courts, in jury patent infringement actions for damages, to resolve as a matter of law genuinely disputed questions about meanings of patents." Pet. 2. This case, however, does not necessarily present that question. There was no genuine dispute over the meaning of the patent.

The central issue in the case was whether the term "inventory" in the patent should be construed to include only cash or invoice totals, as Markman urged, or should be construed to include "articles of clothing." If it should be construed to include articles of clothing, there would be no infringement, since it was undisputed that the accused system did not track articles of clothing.

The claim language, prosecution history, and specification made it clear that the word "inventory" did include "articles of clothing" and that therefore, there was no infringement. To get around this inescapable conclusion, Markman sought to manufacture a different interpretation of the term by introducing testimony at trial. Markman presented a patent lawyer who testified over defendants' objection about the meaning of the patent claims. This witness had no skill or expertise in the subjects taught in the patent, the application of bar codes to an inventory control system. He was allowed to testify that the meaning of the word "inventory" did not include "articles of clothing."

His testimony did not give rise to a real factual dispute. See *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579, (Fed. Cir. 1989) ("[A] mere dispute over the meaning of a term does not itself create an issue of fact.") The trial court disregarded it.²

2. The action of the trial court in ruling on the legal question was nothing more than the correct application of one prong of the standard established by Rule 50 of the Federal Rules of Civil Procedure: the trial court

App. 173a. As the Federal Circuit put it, "When legal 'experts' offer their conflicting views of how the patent should be construed, or where the expert's view of how the patent should be construed conflicts with the patent document itself, such conflict does not create a question of fact" App. 42a.³

While the Federal Circuit majority addressed the issue raised before the court by Markman, whether the judge acted properly in granting JMOL after the jury had construed the claims, App. 55a, it did so only after noting that the testimony offered by Markman did not create a fact issue, was entitled to no deference and amounted to no more than legal opinion. App. 42a. In reality, there were no facts for the jury to find.⁴

insured that the correct legal standard was applied. In a patent infringement case, a party raising a Rule 50 motion to overturn a jury verdict must establish either that the jury's fact-finding was not supported by substantial evidence or that the legal standards implied by the jury verdict were incorrect as a matter of law. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992).

3. See Judge Mayer's concurrence at App. 63a n.4: ("A fact dispute cannot arise solely from testimony of a patent law expert It is not evidence and cannot create a genuine fact question for the jury"); Judge Rader's concurrence at App. 81a ("The testimony of Markman's patent law expert is not evidence at all") (both citing *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2, (Fed. Cir. 1991). See also *Senmed, Inc. v. Richard-Allen Medical Indus.*, 888 F.2d, 815, 818-19, (Fed. Cir. 1989), *reh'g denied*, 1989 U.S. App. Lexis 17023 (Fed. Cir. 1989), *reh'g denied in banc*, 1990 U.S. App. Lexis 107 (Fed. Cir. 1990) (lawyers try to create a 'dispute' about any word, but this cannot alter the undisputed documentary record); *Johnson, supra*, 885 F.2d at 1580.

4. There is no right to have a jury decide an issue of law. *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 763 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989) "a party has a right to a jury trial in an action at law, not a right to a jury verdict" (emphasis in original).

Like the patent lawyer's construction, Markman's own subjective construction of the word "inventory" as meaning only "cash invoices" did not create a genuine fact dispute. (See App. 42a-43a, 63a n.3, 81a); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, (Fed. Cir. 1992) (where a "disputed" term has a clear meaning from the documentary record, testimony of the inventor's intent for a different meaning does not create a genuine dispute of fact.) The substantial evidence standard has no application to an "invented" claim, for "one employs evidence to prove facts, not legal conclusions." *Senmed*, 888 F.2d at 818.

The judgments below have their foundation in the application of the correct legal standard required for any jury's verdict.

II. THE FEDERAL CIRCUIT'S HOLDING THAT THE TERMS IN MARKMAN'S PATENT SHOULD BE CONSTRUED AS A MATTER OF LAW IS CONSISTENT WITH ENGLISH COMMON LAW AND IS NOT IN CONFLICT WITH THIS COURT'S PRECEDENT.

Petitioners argue, in effect, that 200 years of American law and several hundred years of English common law are turned upside down by the judgments below.⁵ That just is not so. The case law is uniform that there is no issue for a jury to decide where the meaning of a claim is clear from the documentary record and it supports the Federal Circuit's judgment. Beyond that, the Federal Circuit's majority position that claim interpretation is exclusively a matter of law for the court is consistent with and is supported by both English common law and this Court's precedent.

A. The Petition's Seventh Amendment Arguments Are Historically Flawed.

It is axiomatic that when one looks to history, one must examine events in context. The petition's Seventh Amendment arguments fail to do that. There are substantial differences between patent practice in 18th Century England and patent practice in the United States today, just as there are substantial difference between original patent practice in this country and patent practice today. For example, at the end of the 18th Century in England, there was uncertainty about how a patent should be drafted and what a specification should contain. There was no patent examination system which considered questions such as novelty or adequacy of a specifica-

⁵ The petition makes a series of arguments that the Federal Circuit's holding in this case is in violation of controlling legal precedent and prevents factual questions from reaching the jury in violation of the Seventh Amendment right to a jury trial. The arguments, again, are premised on the supposition that there were real factual disputes about claim language before the jury in the case.

tion. John N. Adams and Gwen Averley, *The Patent Specification The Role of Liardet v. Johnson*, 7 *The Journal of Legal History*, 156, 160-61 (1986). Patent specifications were often very general, vague and even evasive. *Id.* The cases decided at that time should be read against that background.

In this country, the system of patent claiming at the end of the 18th and during the 19th Century was different than it is today. That original system of patent claiming operated on the central claiming theory, in which claims were not required to be rigorously defined and named the broad features of the invention by reference to its specification. *Ex parte Fressola*, 1993 Pat. App. LEXIS 3, *4; 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Interferences 1993). Under this system "the drawings and descriptions were the main thing, the claims merely an adjunct to." A. Deller, *Patent Claims* Sec. 4 (2d ed. 1971), cited in *Ex parte Fressola*, 1993 Pat. App. LEXIS at *4, 27 USPQ2d at 1609. In this century the patent process evolved into a peripheral claiming system, strictly defining the invention and therefore setting the boundary of the area marked by the claim. *Id.* Cases involving claim construction under the old central definition system focused on a comparison of what the patent disclosed with the accused device to decide if they were technical equivalents. This, obviously, is not the situation today.

B. English Common Law Teaches That Claim Construction Is A Matter Of Law For The Court.

Even under the old English patent system, courts construed patent language as a question of law, even where extrinsic evidence was required to understand the claim. As explained by Thomas Brett in his *Commentaries on the Present Laws of England*, Vol. I, (1890) at 289, "The construction of a specification is the province of the Court, but evidence will be heard in explanation of technical terms used in the arts, or phrases used in particular trades. The rules of construction applicable to specifications are those applied to the interpretation of written instruments." See also *Brooks v. Steele and Currie*, 14 R.P.C. 73 (1896), where the Court said:

The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification But after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. *This is familiar law, although apparently often disregarded when witnesses are being examined.* (Emphasis added.)

Id.

The petition's conclusions about English common law cases are misleading. It is not accurate, as Petitioners assert, that the historical record shows that juries, not judges, interpreted patents in England in 1791. A close reading of each of the cases cited by Markman demonstrates that juries, dealing with the issues created by the patent system then in effect, performed factual analyses about whether specifications adequately "taught" a person skilled in the art how to reconstruct the invention, whether the patented inventions at issue could be copied by skilled craftsmen.⁶

In *Liardet v. Johnson*, K.B. (1778), an unreported case which the petition labels a "leading" King's Bench decision, Markman claims that a defendant asserted that a patent was invalid because its specification had not adequately described how to make the invention. App. 13-14. In fact, this was not true; the defendant did not raise a challenge to the sufficiency of the specification, and Lord Mansfield's instruction to the jury on the question of whether the specification adequately instructs others to make the invention is dictum. E. Wyndham Hulme, *On the History of Patent Laws in the Seventeenth and Eighteenth Centuries*, 18 Law Q. Review 280, 285 n.2 (1902). Furthermore, Lord Mansfield's instruction is without a mod-

6. This factual inquiry, which is now performed by the Patent and Trademark Office, bears a similarity to a jury's role today in an infringement trial when it looks at the accused device to see whether it is covered by the claim language as construed by the court.

ern correlate, since an "inadequate teaching" of the invention today in the specification would be foreclosed under 35 U.S.C. §112.⁷

Similarly, *Turner v. Winter*, 1 T.R. 602 (K.B. 1787) involved jury instructions that have no correlation to modern patent practice and law. As with the dictum in *Liardet*, the question at issue in *Turner* was whether the specification was adequate to teach the public how to make the invention. *Id.* at 605. The jury heard testimony from witnesses who literally followed the "recipe" of the instructions in the specification to see whether the substances produced were what was claimed by the patent. *Id.* "Therefore, if the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void." *Id.* Again, this has no modern correlate in an infringement trial. The adequacy of the "instructions" in the specification is governed by the application of 35 U.S.C. §112 and by the PTO in the patent process.

Finally, Markman's reliance on *Neilson v. Harford*, Webster Patent Cas. 295 (1841) is curious, since it directly supports the Federal Circuit's opinion. The judge in *Nielson* made it clear that he construed the specification language at trial, since specifications, like all written documents, are to be construed as a matter of law. *Id.* at 370. As in *Liardet* and *Turner*, the jury's role was limited to ascertaining whether the instructions in the specification could produce the claimed invention and arose from a defendant's claim that the patent specification was inadequately ambiguous. The jury's duty at trial was to ascertain whether a competent workman could follow the instructions in the patent — there was necessarily testimony

7. Likewise, Markman's citation to the "influential 1791 authority," Francis Buller, erroneously implies that Buller states that juries must determine the meanings of specifications. Pet. 14. The authority cited, *Trials Nisi Prius*, says nothing about juries. Actually, Buller summarizes the *Liardet* case by stating, "The general questions on patents are, 1st, whether the invention were known and in use before the patent. 2d, whether the specification is sufficient to enable others to make it up. The meaning of the specification is, that others may be taught to do the thing for which the patent is granted" F. Buller, *An Introduction to the Law Relative to Trials at Nisi Prius* ch. VII (6th ed. 1791).

on the actual process of making the invention in accordance with the "recipe" given in the specification to see whether the specification was proper.⁸

C. The Majority Opinion Of The Federal Circuit Is Consistent With Supreme Court Precedent.

This Court has held repeatedly that claim construction is a matter of law for the court.⁹ In infringement cases, this principle means that the judge defines the patent and the jury decides whether the accused device is covered by the patent claim. In an early decision, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), the Court explained it this way:

On . . . trial for [infringement] two questions arise. The first is, what is the thing patented; the second, has the thing been constructed, used, or sold by the defendants. The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to the jury.

8. Markman's summary of *Collins v. Sawrey* 4 Bro. P.C. 692 (H.L. 1772) is similarly misstated. In *Collins* the question was whether the claims at issue sought equitable rights and remedies or legal ones. It was held that the case involved legal issues and so should not be heard by the Court of Exchequer, but rather at law — i.e., "before a single judge, by a jury at an assize . . ." *Id.* at 699. Markman's omission of the phrase "before a single judge" and connection of the phrase "written evidence" to "buy a jury" makes it seem as if the question of whether the jury, as opposed the judge, should construe written evidence. This was not at issue in the case. Likewise, in *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102 (K.B. 1774) the holding was not, as Markman tells it, that the interpretation of a charter is a question of fact for the jury. The holding was that the jury properly determined upon strongest possible evidence that a port was an ancient port because it had been enjoyed for 350 years. The meaning of a term in the charter was not at issue; the length of use of the port was. *Id.* at 108.

9. *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895); *Coupe v. Royer*, 155 U.S. 565, 579 (1895); *Heald v. Rice*, 104 U.S. 737, 749 (1882); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1870); *Winans v. New York and Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1858); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 339 (1854); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225-226 (1852); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848).

Id. at 338. Likewise, in *Coupe v. Royer*, 155 U.S. 565 (1895), this Court said:

The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol. 3, page 378, as follows: "Where the defense denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant."

Id. at 579. In practice, the judge construes the words of the patent claim, while the jury makes fact findings about the capabilities of the invented devices. Thus, the *Winans* Court construed the letters patent by determining structure, mode of operation, and the result obtained from a patent. *Winans*, 56 U.S. at 338. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), construction of the combination patent claim was for the court; it was for the jury to determine as a matter of fact what parts of the machine were necessary to effect a particular result. *Id.* at 225-26. In *Coupe v. Royer*, the court's job was to give proper instructions to the jury on the scope of the patent, and the jury was to decide the question of infringement. *Id.* at 579.

Like the Federal Circuit below, this Court has found repeatedly that where the documentary record is capable of revealing the meaning of the patent, it is exclusively the role of the court to determine that meaning as a matter of law. The Federal Court's decision in this case — that the claim language, specification and prosecution history show clearly that "inventory" includes "articles of clothing" — thus stands squarely in line with Supreme Court precedent.¹⁰

10. This Court's decisions cited by Markman as contradictory to the Federal Circuit's decision are in reality firmly in support. See *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (face of the instruments allows the judge to determine as a matter of law what the inventions described in the patents are by mere comparison); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (in an anticipation case, issue of whether prior patents were for the same invention as the patent at issue was matter of law; court could decide the issue by comparing the patents); *Heald v. Rice*, 104 U.S. 737, 749

Not surprisingly, the petition fails to recognize the consistency of the Federal Circuit's holding with precedent and centers its contention of an alleged conflict with Supreme Court case law on the question of extrinsic evidence. Here again, however, the petition's citation to Supreme Court case law is misleading. Although this Court has never directly considered the question in the Seventh Amendment context, there is support in the precedent that the necessity of extrinsic evidence does not change the character of claim construction as one of a pure legal issue for the judge.

As stated in the influential textbook on patent law, Albert H. Walker, *Textbook of The Patent Law of The United States of America* (3d ed. 1895):

Questions of construction are questions of law for the judge, not questions of fact for the jury. As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases. The judges are not, however, obliged to blindly follow such testimony. They may disregard it if it appears to them to be unreasonable. While the testimony of experts relevant to the meaning of particular words or phrases in letters patent is to this extent admissible, such testimony is wholly inadmissible relevant to the construction of the letters patent as a whole.

Id. at 173-174.¹¹

NOTES (Continued)

(1882) (Court interpreted the issue of whether a reissue patent was for the same invention as the original patent and found it a matter of law for the court where no extrinsic evidence was necessary); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877) (Court found that the claim language clearly did not cover the defendant's inventions, so no verdict of infringement).

11. Obviously, this text was written from the perspective of a patent practitioner at the time of the decisions of this Court relied on by Petitioners.

There are cases in which this Court indicates — as the Federal Circuit has instructed — that it is for the Court to consider extrinsic evidence where it is necessary to construe the claims. Rather than supporting a Seventh Amendment right to jury trial when extrinsic evidence is necessary to explain terms of art in a patent, this Court has indicated that it is the role of the court to avail itself of such information on the way to performing its legal duty of construing the claim. In *Looms v. Higgins*, 105 U.S. 580 (1881), the Court availed itself on appeal of the testimony supplied by weaving industry experts in construing the meaning of a looming patent in an infringement case. *Id.* at 586. In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854) the court relied on the testimony of experts at trial to understand the mode of operation of the patent in suit. *Id.* at 341. In *Winans v. New York and Erie Railroad Co.*, 62 U.S. (21 How.) 88 (1858) the specification was construed by the Court. It was held that the court was free to accept or reject testimony of experts on information regarding matters the judge did not understand on the way to proving the proper legal construction of the instrument. *Id.* at 100-01. And in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848) the Court found the specification to be clear by its terms while approving of the lower court's reference to models, drawings and testimony in reaching the same conclusion. *Id.* at 484, 485.

The petition's attempt to create a conflict with this Court's precedent on the question of whether claim construction ever requires fact-finding by a jury is flawed on several accounts. The cases cited by the petition refer to the use of extrinsic evidence in dictum only. In every case relied on by Markman, the Court determined the patent meaning on the record before it. See *Singer*, 192 U.S. at 275; *Market St. Cable Ry. Co.*, 155 U.S. at 625; *Heald*, 104 U.S. at 737 (1882). Moreover, the allusion to the use of extrinsic evidence in these cases is not in the same context as claim construction in an infringement action under the current system of claiming. See discussion, *supra*, at IIA. Rather, the consideration of "extrinsic evidence" in those cases involved a determination of what the invention did — much as the jury today in an infringement case determines the capabilities of the accused device. In

Singer, for example, the court was making a determination of whether a claim defined solely by its specification was the technical equivalent of the accused device. 192 U.S. at 275. In *Market St. Cable Ry. Co. and Bischoff*, the question was whether the prior patent disclosed the same invention as the current patent. 155 U.S. at 625; 76 U.S. at 816. In *Heald*, the question was whether the reissue patent was for the same invention as the previous patent. 104 U.S. at 737.

Here, as with the petition's discussion of English common law, the suggestion of conflict with this Court's precedent is illusionary. This Court's authority holds that claim construction is a matter of law for the court, regardless of whether extrinsic evidence is necessary to inform the court of the meaning of the claim language. The Federal Circuit's holding does not conflict with precedent nor does it present an important question which should be reversed by this Court.

III. THE POLICIES UNDERLYING THE FEDERAL CIRCUIT'S DECISION ARE SOUND.

Congress created the Federal Circuit for the express purpose of promoting uniformity, predictability, and fairness in patent law. See H.R. No. 97-312, 97th Cong., 1st Sess. at 9 (1981). The Federal Circuit is thus a court of particular expertise and in that way differs from other federal circuit courts of appeal. The aims are achieved in the policies underlying the Federal Circuit's decision in this case, and that court is the appropriate body to make this decision. The court's analysis reaches a compelling conclusion: patents are fully integrated written instruments that should be interpreted uniformly as a matter of law. Statute requires that a patentee particularly point and distinctly claim the subject matter of his or her invention. 35 U.S.C. §112 para. 1. Because of the exclusive grant of right to the patentee, it is only fair that competitors "be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." App. 28a. The only way a patent claim can receive universal treatment is for it to be construed as a matter of law by a judge. If not, the same patent language could be subject to different interpretations by different juries in different infringement actions. There would be no unifor-

mity, and definitely no certainty. This analysis is further compelled by the most relevant and useful analogy of a patent to a statute or government grant. App. 45a-52a.

The fact that, as Markman points out, the Federal Circuit by this decision chose to clarify inconsistencies in its case law is not, in and of itself, reason for the grant of certiorari. Clarification of conflicting precedent is precisely the reason for *en banc* panels, the device used in this case. It is the role of the circuit court, and not this Court, to dispose of intra-circuit conflict. The presence of intra-circuit conflict does not present an important or compelling reason for Supreme Court review.¹² Certainly, a reviewable question cannot be posed when the Circuit Court has done its own job in resolving a real or apparent intra-circuit conflict, by an 8-3 (and 10-1) margin.¹³

IV. THIS CASE IS INAPPROPRIATE FOR THE COURT TO REVIEW BECAUSE ALL CLAIMS OF THE PATENT HAVE BEEN REJECTED BY THE PATENT EXAMINER.

Markman's petition notably omits an essential fact in the procedural history of this case on appeal. On July 26, 1994, two and a half months after oral argument before the Federal Court in banc, the Patent and Trademark Office issued a final rejection of all claims in the Markman patent.¹⁴ The rejection was based on claims of prior art in a challenge raised after the

12. See *Taylor v. United States*, 493 U.S. 906 (1989) (petition for certiorari denied despite intra-circuit conflict); *Ratchford v. Gay Lib*, 434 U.S. 1080, 1081 (1978) (same); *Davis v. United States*, 417 U.S. 333, 340 (1974) (same). See also Mr. Justice Harlan, "Manning the Dikes," 13 *Record of N.Y.C. Bar Ass'n* 541, 552 (1958): "Contrary decisions between different panels of the same Court of Appeals will not be considered to present a reviewable conflict, since such differences of view are deemed an intramural matter to be resolved by the Court of Appeals itself."

13. See *Kimbel v. D.J. McDuffy, Inc.*, 454 U.S. 1110, 1111 (1981) (certiorari petition denied even though a "severely divided" 11-10 *en banc* panel voted to reverse a previous holding that was itself issued by a divided panel).

14. Markman did not disclose the status of the patent to the Federal Circuit even though the challenge was filed nearly ten months before the Court's in banc opinion was issued.

trial of this case.¹⁵ (See Appendix A.) This fact was learned only recently by counsel for respondent.

At the very least, it can be said that the Markman patent has a uncertain future.¹⁶ It is respectfully submitted that even if this Court viewed the issues addressed by the Federal Circuit to be significant, this case is not the appropriate one for this Court to accept for the purpose of addressing these issues.

CONCLUSION

For all of the reasons given, Markman's petition should be denied.

Respectfully submitted,

Frank H. Griffin, III
Counsel of Record

Peter A. Vogt
Polly M. Shaffer
Gollatz, Griffin & Ewing, P.C.
Two Penn Center Plaza
16th Floor
Philadelphia, PA 19102
(215) 563-9400

*Attorneys for Respondent
Westview Instruments, Inc. and
Althon Enterprises, Inc.*

Date:

15. Although the invalidity of the patent on the basis of prior art was raised by Westview at trial, that issue was not reached after the judge ruled as a matter of law that there was no infringement. The trial predated this Court's decision in *Cardinal Chemical Co. v. Morton Int'l, Inc.*, 113 S.Ct. 1967 (1993).

16. The case is currently pending appeal before the Board of Patent Appeals and Interferences, but to respondent counsel's knowledge, the hearing date has not been set.

Appendix

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND
TRADEMARKS
Washington, D.C. 20231

DO NOT USE IN PALM PRINTER
(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Christopher J. Palermo
Fish & Richardson
2200 Sand Hill Rd. Ste. 100
Menlo Park, CA 94025

**REEXAMINATION COMMUNICATION
TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/003175

PATENT NO. 33054

ART UNIT 2505

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

B-2

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
----------------	-------------	----------------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED

OFFICE ACTION IN REEXAMINATION

- ☒ Responsive to the communication(s) filed on 6/17/94. ☒ This action is made FINAL.

A shortened statutory period for response to this action is set to expire one month from the date of this letter. Failure to respond within the period for response will cause termination of the proceeding and issuance of a reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

PART I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892. 3. ☐ Notice of Informal Patent Drawing, PTO-948.
2. ☐ Information Disclosure Citation, PTO-1449. 4. ☐ _____

PART II SUMMARY OF ACTION:

- 1a. ☒ Claims 1-15 are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are confirmed.
4. ☐ Claims _____ are patentable.
5. ☒ Claims 1-15 are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ is ☐ approved, ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received, ☐ not been received, ☐ been filed in Serial No. _____ filed on _____.
10. ☐ Since the proceeding appears to be in condition for issuance of a reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1959 C.D. 11, 435 O.G. 213.
11. ☐ Other

B-3

ReExam 003,175

Art Unit 2505

The invention is best understood by considering the patent owner's statement, page 2, last paragraph:

"As of April 13, 1984, the filing date of the original patent application, the art of inventory control and reporting for dry-cleaning stores and the like was well developed. The Liberty Lister system shown in Requester's Exhibits 10 and 11, described in the Specification at column 2, line 62 through column 3, line 19, and which was of record in the reissue application, discloses an inventory control and reporting system for drycleaners that uses bar coded written records bearing product descriptions."

The novelty resides in the generation and printing of the bar codes at the time of the customer submitting items into the controlled inventory of the vendor, as a part of the transaction involving the purchase of vendor service by the customer, as opposed to the use of preprinted forms by Lister.

The issue appears to have arisen due to an extrapolation by both parties of the claim language "transaction" from a customer/vendor interaction involving submission of items by the customer into the controlled inventory of the vendor, which is the disclosed invention, to other areas such as manufacturing in-house inventory systems, as has been cited in re-examination.

The presentation by both parties has been stand or fall with regard to claims 1 and 14.

Claims 1-15 were rejected under 35 USC 103 over Noel (Exh. 13 or Krause (Exh. 30) in view of Lister (exh. 11) Countmaster (Exh. 6 and 7) and Thermopatch (Exh. 9) considered in combination.

The essential language of independent claims 1 and 14 compare with Noel as set forth below.

Claim Element**Noel et al.**

a data input device for manual operation by an attendant the input means having switch means operable to encode information relating to sequential transactions

Model 3002 terminal with keyboard (Exh. 13 at 1, col. 1 and Photo 1). keyboard (see Photo 1) "Inspectors using special machines create a mapping sheet and history of each roll of denim, which also records defects and their location if any occur. Each

B-4

acceptable roll goes to the weight station . . . [t]here an operator access style number and description information from disk. Certain entries are made automatically, *others are entered by the operator.*" Exh. 13 at col. 2 1.

each of the transactions having articles associated therewith

The transaction is creation of a roll of denim and entry of the roll into inventory stock. Articles associated with the transaction are rolls of denim. Exh. 13 at col. 1 4 to 2 3.

said information including transaction identity and descriptions of each article

"The result of information entries is a seven-segment pressure-sensitive label that includes the bar code equivalent of the package's identification number ['transaction identity']." Exh. 13 at col. 1 photo 2. Operators enter description information or retrieve it from disk and associate it with the article. See Exh. 13 at col. 2 1.

a data processing including memory operable to record said information

Standard Register Model 3002 intelligent terminal with dual disk drive (Exh. 13 at 1 col. 1). "Shading data is numerically classified and stored on disk in the Shade Room." Exh. 13 at 1 col. 1 5. Description information is stored on disk. Exh. 13 at 1 col. 2.

and means to maintain an inventory total

"Rolls are selected for shipment by the Sales department based on customer requirements and

B-5

available inventory." Exh. 13 at 2. Compilation of inventory totals is described at 3. Thus, an inventory total is inherently maintained.

said data processor having means to associates sequential transactions with uniuqesequential indicia

The Swift system bar code labels include a roll identification number associated with each roll produced sequentially. Exh. 13 at 1 col. 1, 1 and photo 2 caption.

and to generate at least one report of said total and said transactions

"At the end of the day, the Shade Room terminal prints a production report by roll of denim number, including all information recorded on the labels." Exh. 13 at 3 3.

the unique sequential indicia and the sequential transactions being reconcilable with one another

Id. Printing "by roll of denim number" inherently involves reconciliation. So does the roll selection process described at 2.

a dot matrix printer

Standard Register Series 150 printer. Dot matrix formation of label characters is apparent in photo 2, which shows variable height characters which cannot be printed on an impact printer. Exh. 13 at 2 photo 2.

operable under control of the data processor to generate a written record of the indicia associated with sequential transactions

The printer printed bar code labels containing the unique roll number. Exh. 13 at 1 (photo 2 caption) and 2 (photo 2).

the written record including optically-detectable bar codes having a series of contrasting spaced bands

the bar codes being printed only in coincidence with each said transaction

and at least part of the written record bearing portion to be attached to said articles

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

Bar code labels are shown in photo 2. *Id.*

Bar code labels are printed on demand as transactions occur. "If all is correct, a seven-digit [sic—segment] pressure sensitive label is generated. The label uses bar code . . ." Exh. 13 at 1 col. 2.

"The final three segments [of the bar code label] are placed on the fabric itself and at either end of its poly-wrapped package." Exh. 13 at col. 2 2 and at 2 photo 3.

"A computerized conveyor system moves the roll to numbered bin locations. Warehousemen use Norand portable scanning equipment to record package number and storage location for each roll." Exh. 13 at col. 2 to p. 2

"Inventory-taking is faster, easier, and more accurate Accuracy is a tremendous advantage — built-in double checking systems ensure that customers get the material they ordered the system will pay for itself rapidly by . . . eliminating errors . . . and improve inventory control." Exh. 13 at 4.

The essential language of claims 1 and 14 compare with Krause as set forth below.

Claim Element

Krause et al.

a data input device for manual operation by an attendant

"Printed circuit boards received from the customer engineer are first logged into the system *using a manually operated terminal.*" Exh. 30 at p. 144 co. 1 1.

the input means having switch means

"The solution is a *keyboard terminal* incorporating a bar code data system." *Id.*

operable to encode information relating to sequential transactions

"Unique information about the board, such as part number, data code, etc. is entered." *Id.*

each of the transactions having articles associated therewith

Each transaction has a circuit board associated with it. *Id.*

said information including transaction identity and descriptions of each article

"Each transaction is identified by a unique number selected from a work-order form." Also, "part number, date code, etc." is entered to describe the board. *Id.* at 1-2.

a data processor including memory operable to record said information

"The computer updates its data base to reflect the PC board's movements . . ." *Id.* p. 144 col. 2

and means to maintain an inventory total

Id. An updated data base would contain a total of all PC boards.

said data processor having means to associate sequential transactions with unique sequential indicia

"And a bar symbol encoding a control number is stamped on a tag which accompanies the PC board through the repair cycle (Fig. 3) . . . The operator scans

the PC board's bar code tag and the computer checks that the control number has actually been issued to the factory floor." *Id.* p. 144 col. 1 1, 3.

and to generate at last one report of said total and said transactions

"Managers can locate any board and its work-in-process by pressing a key on their terminal designated: SHOWIT. This signals the computer to list all boards and their control numbers." *Id.* p. 144 col. 2. This listing is a report.

the unique sequential indicia and the sequential transactions being reconcilable with one another

"When a specific control number is selected, the computer displays the current status of that PC board in the repair cycle." *Id.* Thus, the control number is reconcilable against the PC board and information relating to the board.

a dot matrix printer

For printing, "... low-cost dot-matrix printers might be selected depending on user requirements." *Id.* p. 140 col. 2 5.

operable under control of the data processor to generate a written record of the indicia associated with sequential transactions

A printer connected to a data processor which controls the printer is described. *Id.* p. 140 (Photo 1 and caption). On demand printing is discussed *Id.* col. 2

the written record including optically-detectable bar codes having a series of contrasting spaced bands

The tag has a bar code symbol. *Id.* The Patent Owner contends that a single symbol is enough. *See Infra* § III.C.2.

the bar codes being printed only in coincidence with each said transaction

"In other cases, a specific bar-code may be required to be available on demand at the user's facility ('demand printing'). *Id.* As the board enters the controlled inventory, "a bar symbol encoding a control number is stamped on a tag which accompanies the PC board through the repair cycle." *Id.* p. 144 col. 1 1.

and at least part of the written record bearing a portion to be attached to said articles

The tag with a bar code "accompanies the PC board through the repair cycle. (Fig. 3)." *Id.* p. 144 col. 1 1.

at least one optical scanner connected to the data processor and operable detect said bar codes on all articles passing a predetermined station

"When the operator selects a transaction, . . . [t]he operator scans the PC to board's bar code tag . . ." *Id.* 3.

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

"... the computer checks that the control number has actually been issued to the factory floor." *Id.* "Being always able to identify [the location of] an individual PC board speeds the processing of hardware needed for customer-crisis situations."

Again, as regards the combination of references cited and discussed in the previous office action as to purpose and rationale, the only significant limitations left untreated by the above arguments would appear to be the detachable tags which are shown by Countmaster (Exh. 6) or Thermopatch (Exh. 9), attribute keys taught by Lister (Exh. 11) and addi-

tional optical scanners shown by Lister. The above limitations are directed to implementation in the dry cleaning environment.

Palmer, cited by patentee, discloses optical scanner subject matter cumulative to Lister.

Patentee's traverse is not considered persuasive since the specific claim language is not argued vis-a-vis the prior art and the patentee tends to re-interpret the claim language to a more narrow construction and argue this construction.

In addition, under the guise of considering the claims "consistent with the specification", the patentee reads the specification into the claims as a basis for argument.

In responding to Noel on page 13 of the "Statement of the Patent Owner" patentee states:

"A transaction in accordance with the patent Specification involves the receipt of one or more diverse articles into a controlled inventory, these transactions proceeding after customers (or providers) present their particular articles and later get them back."

These limitations on the term "transaction" are not in claims 1 and 14. On page 14 patentee states:

"The invention relates to the protection of transactions in a controlled inventory, each transaction having one or several diverse articles, and more particularly to assist in the detection of articles or transactions slipping laterally into or out of a stream of articles and transactions. Noel teaches none of this."

Claims 1 and 14 recite nothing about "diverse articles" which are "slipping laterally in or out". etc.

In responding to the examiners rejection of the dependent claims patentee states:

"The examiner states in the official action that *"Both parties essentially address the issue as 'stand or fall' with regard to claim 1 and 14."* This accurately characterizes the Request, the Patent Owner's Statement responsive thereto and the Reply of the Requester."

Patentee then argues the dependent claims as follows:

"Claims 2-4 are directed to solving the problem that as successive transactions are presented by customers, to much time may be required to print a bar code with sufficient reso-

lution. According to claim 2, the printing commences immediately, i.e., as data is being entered, which places the print delay where it is not noticed." —

However, on-line printing is as old as ticker tape.

With regard to claims 5-7 and 15, patentee argues Krause:

"Claims 5-7 very clearly concern transactions having articles, in the sense of the dictionary definition of the term "transaction", consistently with the specification and unlike anything remotely suggested by Krause."

The argument is conclusionary and relies on the specification being read into the claim language. No specific claimed structure is clearly argued.

Claims 8 and 9 are argued as follows:

"According to claims 8 and 9, there is a preferred or secure input device that has more capability than the other input devices so that reports are restricted and inventory records cannot be unaccountably voided after a ticket is printed."

However, a manager's key or card for voiding mistakes entered into point-of-sale terminals is notoriously old as applicant appears to be arguing. If this is data security, such techniques are also notoriously old, i.e. hierarchial access codes, etc.

With regard to claims 10-13 patentee argues:

"Claims 10-13 recite keyboard attributes that are useful with the system defined in independent claim 1. Although Lister discloses certain of these attributes, it is only in conjunction with a pre-printed bar code system."

The above statement appears to clearly indicate patentee employed Lister's keyboard solution in the recited system.

With regard to Countmaster, Thermopatch and Lister being "lined out" on the PTO 1449, the patentee should have received an updated PTO 1449 listing Thermopatch and Lister. Countmaster is considered to be prior art. These type of tags were discussed in lines 64, col. 1 of the Markman patent through col. 2 line 14. In view of this, a declaration must be filed by patentee to dismiss Countmaster as a reference based on priority date.

The declarations filed under 37 CFR § 1.132 are not persuasive since they are not commensurate with the scope of the claims. The declarations are directed to the sale and development of a system which is an improvement over the Lister retail dry cleaner customer/vendor transaction and inventory control.

The claims of the issue, as the record shows that the issue has been drawn, have had their scope extrapolated by both parties to inventory control which is much broader in scope.

In addition, the declarations tend to be subjective, since they have been made by the patentee and his agent.

In the interest of simplifying the issue, the examiner will not incorporate the Requester's rejections in this action.

It should be noted, however, that an appellate forum might decide to review and perhaps include any of these rejections on the prior art thereof.

This action is made FINAL.

Any inquiry concerning this communication should be directed to Harold Pitts at telephone number (703) 308-0717.

Pitts/tj
July 26, 1994

HAROLD PITTS
PRIMARY EXAMINER
GROUP 2500

JANICE A. HOWELL
DIRECTOR
GROUP 2500

AUG 23 1995

CLERK

No. 95-26

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,
v.
WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

REPLY BRIEF OF PETITIONERS

Of Counsel:

LEWIS F. GOULD, JR.
STEPHAN P. GRIBOK
Eckert Seamans Cherin
& Mellott
1700 Market Square
Suite 3232
Philadelphia, PA 19103
(215) 575-6000

WILLIAM B. MALLIN
Counsel of Record
TIMOTHY P. RYAN
TIMOTHY S. COON
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
(412) 566-6000

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

TABLE OF CONTENTS

	Page
TABLE OF CONTENTS	i
TABLE OF AUTHORITIES	ii
A. The Decision Below Announced a General Rule That Juries May Never Interpret Patents	1
B. The Decision Below Is Wrong on the Merits. .	3
C. A Pending Reexamination Proceeding Is Irrelevant.	8
CONCLUSION	10

(ii)

TABLE OF AUTHORITIES

Cases	Page
<i>Alan Tracy, Inc. v. Trans Globe Imports</i> , 1995 U.S. App. LEXIS 14253 (Fed. Cir. June 2, 1995)	2
<i>Ex parte Anderson</i> , 21 U.S.P.Q. 2d 1241 (B.P.A.I., 1991)	8
<i>Bell Communications Research, Inc. v. Vitalink Communications Corp.</i> , 55 F.3d 615 (Fed. Cir. 1995)	2
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall) 812 (1870) . .	7, 8
<i>Brooks v. Steele</i> , 14 R.P.C. 43 (1896)	4
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	7
<i>Elf Atochem North America, Inc. v. Libby-Owens Ford, Inc.</i> , 1995 WL 467522 (D. Del., Aug. 4, 1995) . . .	9
<i>Ethicon, Inc. v. Quigg</i> , 849 F.2d 1142 (Fed. Cir. 1988)	9
<i>GPAC, Inc. v. D.W.W. Enterprises, Inc.</i> , 144 F.R.D. 60 (D.N.J. 1992)	9
<i>Graco, Inc. v. Binks Manufacturing Co.</i> , 1995 U.S. App. LEXIS 16520 (Fed. Cir. June 30, 1995)	2
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989) .	5

(iii)

Page

<i>Gussin v. Nintendo of America, Inc.</i> , 1995 U.S. App. LEXIS 20666 (Fed. Cir. Aug. 3, 1995)	2
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	7
<i>Laitram Corp. v. NEC Corp.</i> , 1995 U.S. App. LEXIS 20649 (Fed. Cir. Aug. 4, 1995)	2
<i>Liardet v. Johnson</i> , K.B. (1778)	5, 6
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1881)	6
<i>Lucas Aerospace, Ltd. v. Unison Industrial, L.P.</i> , 1995 U.S. Dist. LEXIS 8414 (D. Del. June 2, 1995)	9
<i>National Presto Industries, Inc. v. Black & Decker (U.S.), Inc.</i> , 1995 U.S. App. LEXIS 15568 (Fed. Cir. June 20, 1995)	2
<i>Neilson v. Hartford</i> , Webster Pat. Cas. 295 (1841) . .	4, 5
<i>Popeil Pasta Products Inc. v. Creative Technologies Corp.</i> , 1995 U.S. App. LEXIS 12929 (Fed. Cir. May 26, 1995)	2
<i>Regent Lighting Corp. v. FL Industries, Inc.</i> , 1995 U.S. App. LEXIS 13955 (Fed. Cir. June 2, 1995)	2

	Page
<i>Salt Lake Brine Shrimp, Inc. v. Sanders Brine Shrimp Co.</i> , 1995 U.S. App. LEXIS 14255 (Fed. Cir. June 7, 1995)	2
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	5
<i>United States Surgical Corp. v. Ethicon, Inc.</i> , No. 94-2081 (Fed. Cir. Feb. 14, 1995) <i>petition for cert. filed</i> , June 20, 1995	2, 3
<i>Washburn v. Gould</i> , 29 Fed. Cas. 312 (C.C.D. Mass. 1844)	4
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854) . .	7
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1859)	6

Statutes

35 U.S.C. § 112	5
35 U.S.C. § 282(3)	5
35 U.S.C. § 303(b)	9
35 U.S.C. § 306	8
35 U.S.C. § 307	8
37 C.F.R. § 1.11(d)	9

Other Sources:

Adams & Averly, <i>The Patent Specification: The Role of Liardet v. Johnson</i> , 7 J. Leg. Hist. 156 (1986)	6
T. Brett, <i>Commentaries on the Present Laws of England</i> (2d ed. 1891)	4
E. W. Hulme, <i>On the History of Patent Law in the 17th and 18th Century</i> , 18 LAW QUARTERLY REVIEW 280 (1902)	5, 6
I J. Oldham, <i>THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY</i> (1992)	6

REPLY BRIEF OF PETITIONERS

This Reply Brief is submitted pursuant to Supreme Court Rule 15.6 to reply to new contentions advanced by Respondents' Brief in Opposition. Respondents do not dispute that the question presented in the Petition for *Certiorari* is sufficiently recurring and important to warrant this Court's review. Instead, respondents argue that this case "does not necessarily present that question," Opp. 4-5, and that the Federal Circuit, in any event, decided the question correctly. Opp. 6-15. Respondents also briefly suggest that review is inappropriate because the specific patent at issue has a "future" that is allegedly "uncertain." Opp. 15-16.

A. The Decision Below Announced a General Rule That Juries May Never Interpret Patents.

Respondents make the curious assertion that this case "does not necessarily present" the constitutional issue decided by the majority. Opp. 4. Obviously, the constitutional jury trial issue was squarely presented and expressly decided by the majority below. Indeed, the Federal Circuit *en banc* selected *sua sponte* this case as the appropriate vehicle to decide the jury trial issue which now controls every patent case in the Nation. It is hard to imagine a better vehicle for this Court's review of that issue.

Respondents repeatedly and mistakenly suggest that the decision below addressed nothing more than whether there was a genuine factual dispute with respect to the specific patent at issue.¹ That suggestion is inconsistent with the *en*

¹E.g., Opp. i (attempting to limit question presented to a "case where there was no reasonable dispute about the meaning of claim language"); Opp. 3 ("The documentary record revealed the one susceptible meaning of the claim"); Opp. 4 ("there was no genuine dispute over the meaning of the patent.").

banc decision below which states repeatedly that courts must interpret patents as a matter of law in every infringement action for damages, *e.g.* 5a, 30a, 36a. It is inconsistent with an expanding body of subsequent Federal Circuit precedent which routinely cites the decision below for the legal proposition that patent interpretation is exclusively a legal question to be decided by judges.² It is inconsistent with the views of other petitioners who seek review in this Court on the ground that their cases present the same Seventh Amendment question as does this case.³ It is inconsistent with the views of other respondents who argue not that the decision

²See, *e.g.*, *Laitram Corp. v. NEC Corp.*, 1995 U.S. App. LEXIS 20649, *8 (Fed. Cir. Aug. 4, 1995) (claim construction is a matter of law reviewed on appeal *de novo*) (citing *Markman*); *Graco, Inc. v. Binks Mfg. Co.*, 1995 U.S. App. LEXIS 16520, *13 (Fed. Cir. June 30, 1995) ("Claim construction is a matter of law exclusively for the court.") (citing *Markman*). Accord, *e.g.*, *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995) (following *Markman*); *Gussin v. Nintendo*, 1995 U.S. App. LEXIS 20666, *7 (Fed. Cir. Aug. 3, 1995) (same); *National Presto Indus., Inc. v. Black & Decker, Inc.*, 1995 U.S. App. LEXIS 15568, *6 (Fed. Cir. June 20, 1995) (same); *Salt Lake Brine Shrimp, Inc. v. Sanders Brine Shrimp Co.*, 1995 U.S. App. LEXIS 14255, *4 (Fed. Cir. June 7, 1995) (same); *Regent Lighting Corp. v. FL Indus., Inc.*, 1995 U.S. App. LEXIS 13955, *1 (Fed. Cir. June 2, 1995) (same); *Alan Tracy, Inc. v. Trans Globe Imports*, 1995 U.S. App. LEXIS 14253, *7 (Fed. Cir. June 2, 1995) (same); *Popeil Pasta Prods. Inc. v. Creative Technologies Corp.*, 1995 U.S. App. LEXIS 12929, *8 (Fed. Cir. May 26, 1995) (same).

³See, *e.g.*, Petition for a Writ of *Certiorari*, *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081, at 13 ("*Markman's* deep and direct effect on the conduct of most patent trials makes it perhaps the single most important patent case decided by the CAFC in its history.").

below is insignificant or factbound, but who concede precisely the opposite.⁴ And, ultimately, it is inconsistent with respondents' own concession that the Federal Circuit held that "claim construction is a question of law for the court even when extrinsic evidence might be necessary to reveal the meaning of the claim." Opp. 3. That legal question is now the threshold issue in every infringement case.

Further, respondents' speculation about the existence of a genuine dispute, *i.e.*, the presence of substantial evidence supporting the jury's implied interpretation, is both wrong and beside the point, because neither the majority nor the district judge jettisoned the jury verdict on the basis of the substantial evidence rule. Instead, those courts decided only the threshold issue -- whether interpretive questions are for the judge or jury. 5a., 30a., 101a. After that threshold decision, the majority on appeal interpreted the patent *de novo* as a matter of law by considering the evidence. 41a.-43a. The majority did not hold or suggest that the jury interpretation was not supported by substantial evidence.⁵

B. The Decision Below Is Wrong on the Merits.

Respondents' position that the Seventh Amendment permits courts to interpret patents as a matter of law in every infringement case is not supported by the historical record or this Court's precedent.

⁴See, *e.g.*, Brief in Opposition, *Ethicon*, at 11.

⁵Of course, if this Court reverses the Federal Circuit on the Seventh Amendment question, it need not decide any sufficiency of evidence issue, but may remand for the trial court or the Federal Circuit to make that determination in the first instance. That issue is reached only when the threshold issue is resolved in favor of jury trial, contrary to the majority opinion. See Judge Newman's dissent at 159a.

1. Respondents totally ignore the historical record set forth in Judge Newman's dissent below, 115a.-135a., choosing to treat the confirmatory materials referenced in the Petition as the only relevant authority on the Seventh Amendment issues. Against this array of evidence, respondents cite dictum from a single decision, *Brooks v. Steele*, 14 R.P.C. 43, 73 (1896), that a question concerning a patent specification "has to be determined by the judge and not by a jury." Opp. 7-8.⁶ Even if the constitutional inquiry were directed to 1896, the *Brooks* dictum is unconvincing on its face: the court cited no authority for its allegedly "familiar" assertion about juries, and indeed noted that the assertion was "often disregarded" in actual practice. *Id.*

But *Brooks* was not decided until 1896, over a century after the Seventh Amendment was adopted and over five decades after the decisions in *Neilson v. Hartford*, Webster Pat. Cas. 295 (1841), and *Washburn v. Gould*, 29 Fed. Cas. 312 (C.C.D. Mass. 1844) (Storey, J.). At best, an 1896 decision could have only slight relevance to the historical inquiry mandated by the Seventh Amendment, especially as compared to earlier authority. But in the patent context, such a late decision is almost useless because, as respondents' own secondary authority explains, patent practice in England was substantially altered by the Patents Act of 1883. See T. Brett, *Commentaries on the Present Laws of England* 288, 289 n.1, 302 (2d ed. 1891).

Respondents' attempts to distinguish all of the more relevant cases are also unconvincing. Respondents contend

⁶Respondents' quotation from *Brooks* is dictum because *Brooks* involved a bench trial before an equity court; the case presented no question about the proper role of juries in infringement actions tried before juries.

primarily that *Liardet v. Johnson* K.B. (1778), *Turner v. Winter*, 1 T.R. 602 (K.B. 1787), and *Neilson v. Hartford*, Webster Patent Cas. 295 (1841), involved validity determinations based on the alleged insufficiency of the patent specification. Opp. 8-11. But respondents do not seriously dispute that those determinations (like infringement determinations) require the patent to be interpreted and that juries making those determinations performed that specific function in England in 1791. Pet. 13-15.

Respondents suggest that such jury determinations have "no modern correlate" because the PTO assesses the sufficiency of a specification under 35 U.S.C. § 112 in the application process. Opp. 9. An infringement defendant today, however, may assert the identical defense at issue in *Liardet*, *Turner* and *Neilson* -- that a patent is invalid because of inadequate specification. 35 U.S.C. § 282(3) (recognizing invalidity defense "for failure to comply with any requirement of section 112"). In any event, respondents fail to explain why a clear historical practice of juries interpreting patents in the validity context is not sufficiently "analogous" for Seventh Amendment purposes, *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989), to require jury interpretation in the closely related infringement context which is governed by the identical interpretation.

Respondents' further attack on *Liardet* -- that Lord Mansfield's "instruction to the jury" was "dictum", Opp. 8 -- is equally unconvincing. Respondents err in asserting that the defendant in *Liardet* "did not raise a challenge to the sufficiency of the specification." Opp. 8. Respondents rely exclusively on a footnote from a single secondary source, which in turn relies upon a pamphlet published by plaintiff after the first trial in that case. See Hulme, *On the History*

of Patent Law in the 17th and 18th Centuries, 18 LAW QUARTERLY REVIEW 280, 285 n.2 (1902). But there was also a second trial in *Liardet*, in which Lord Mansfield himself confirmed that "[d]efendant's counsel attacked the [s]pecification for uncertainty," and in which he "left to the jury . . . all objections made to exactness, certainty and propriety of the Specification." See I J. Oldham, THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY, 755-56 (1992).⁷

2. Respondents argue that even where extrinsic evidence is properly considered and is genuinely conflicting, that evidence "does not change the character of claim construction as one of a pure legal issue for the judge." Opp. 12.⁸ In citing four cases where this Court allegedly "availed itself on appeal" of conflicting extrinsic evidence in interpreting a patent as a matter of law, Opp. 13, respondents misread each case. In three of the cases, this Court interpreted the relevant patent as a matter of law where its meaning was clear from the text of the patent alone. See *Loom Co. v. Higgins*, 105 U.S. 580, 586, 598 (1881); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1859);

⁷Respondents also suggest that *Liardet* is insignificant because it was not contemporaneously published. Opp. 8. That contention is especially odd, since respondents' own secondary sources discuss *Liardet* as a leading case of its time. See e.g., *Hulme, supra*, at 283-88; Adams & Averly, *The Patent Specification: The Role of Liardet v. Johnson*, 7 J. Leg. Hist. 156 (1986).

⁸Respondents acknowledge that four of the decisions cited by the majority below held only that courts may interpret patents as a matter of law "where the documentary record is capable of revealing the meaning of the patent." Opp. 11 and n. 10.

and *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848). In the fourth case, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), this Court did not interpret any patent term at all, but merely cited "uncontradicted" evidence to establish the "mode of operation" of the patent at issue. *Id.* at 342. Respondents trumpet a one-sentence dictum from *Winans v. Denmead*, Opp. 10, that patent interpretation is a "question of law" to be determined by the "letters-patent" and the "specification of claim annexed." 56 U.S. (15 How.) at 338. That dictum, however, simply does not address whether patent interpretation is legal or factual where genuinely conflicting extrinsic evidence is also at issue.

Respondents also cite similar language from a hornbook quoted in *Coupe v. Royer*, 155 U.S. 565 (1895). Opp. 11. Like *Winans v. Denmead*, however, *Coupe* involved no disputed claim construction issue. Moreover, to the extent that language from *Coupe* is relevant, respondents ignore that *Coupe* explicitly reaffirmed the controlling analytical framework of *Bischoff v. Wethered*, 76 U.S. (9 Wall) 812 (1870). As *Coupe* itself reiterated:

A case may be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seem to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of the evidence. But in all such cases the question still would be treated as a question of fact for the jury, and not a question of law for the court.

155 U.S. at 578-79, quoting *Bischoff*, 76 U.S. (9 Wall.) at 814. Respondents' perfunctory distinction of *Bischoff* as a case in which the interpretive question bore on a validity determination as opposed to an infringement determination, Opp. 14, is the same one asserted unconvincingly by the majority below. Pet. 18 n.14.

C. A Pending Reexamination Proceeding Is Irrelevant.

Citing a pending reexamination proceeding, respondents imply that this case is inappropriate for review because the patent may have an "uncertain future." Respondents' efforts to distract the Court on this irrelevant point should be rejected. The preliminary action of the examiner is not the decision of the PTO, but merely an early step in a long process which includes judicial review. 35 U.S.C. § 306. The claims of the Markman patent are now valid and will remain valid unless and until a "certificate of unpatentability" issues. 35 U.S.C. § 307. Such a certificate cannot issue until *after* the reexamination becomes final *after* judicial review.⁹ *Id.* This live and important case should not be denied review on the basis of respondents' speculation about a decision in the distant future.¹⁰

Infringement litigation and administrative reexamination routinely proceed on separate tracks, *e.g.*, *Ex parte Anderson*, 21 U.S.P.Q. 2d 1241, 1245 (B.P.A.I., 1991), and the PTO may not refuse to reexamine because infringement

⁹Mr. Markman will pursue judicial review if necessary.

¹⁰As the patent has already been upheld twice by the PTO in two previous proceedings, Mr. Markman anticipates that the current reexamination proceeding will ultimately be resolved in his favor resulting in the strengthening of his patent.

litigation is pending, *e.g.*, *Ethicon, Inc. v. Quigg*, 849 F.2d 1142 (Fed. Cir. 1988). Courts adjudicating infringement often refuse to grant a stay while reexamination is pending, particularly if the litigation is in a "late stage." *See e.g.*, *GPAC, Inc. v. D.W.W. Enterprises, Inc.*, 144 F.R.D. 60, 63-4 (D.N.J. 1992). It is inconceivable that both administrative and judicial review could be completed in time to affect this Court's consideration of this case. In the meantime, the patent remains alive and may be sued on.¹¹

Citation of the pending reexamination is purely a diversionary maneuver, designed to obscure the reality that following *Markman*, district courts throughout the Nation are now evaluating credibility and weighing evidence in interpreting patents as a matter of law, thus multiplying constitutional error. *See, e.g.*, *Elf Atochem North America, Inc. v. Libby-Owens Ford, Inc.*, 1995 WL 467522 (D. Del., Aug. 4, 1995); *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 1995 U.S. Dist. LEXIS 8414 (D. Del. June 4, 1995).

¹¹Moreover, respondents never informed the Federal Circuit of the reexamination proceeding. While respondents allege that their discovery of that proceeding was made "recently," Opp. 16, they fail to acknowledge that notice of the pendency of the reexamination proceeding was publicly announced in the *Official Gazette* on October 19, 1993, and the PTO reexamination determination is a matter of public record. 35 U.S.C. § 303(b). *See also*, 37 C.F.R. § 1.11(d) (copies of the record in a reexamination proceeding are publicly available).

CONCLUSION

The Petition for a Writ of *Certiorari* should be granted.

Dated: August 23, 1995

Respectfully submitted,

Of Counsel

Lewis F. Gould, Jr.
Stephan P. Gribok
Eckert Seamans Cherin
& Mellott
1700 Market Street
Suite 3232
Philadelphia, PA 19103

William B. Mallin
Counsel of Record
Timothy P. Ryan
Timothy S. Coon
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

2
No. 95-26

Supreme Court, U. S.

FILED

AUG 2 1995

CLERK

IN THE
Supreme Court of the United States

October Term, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

**On Petition for a Writ Of Certiorari
to the United States Court Of Appeals
For The Federal Circuit**

**BRIEF OF AMICUS CURIAE
ASSOCIATION OF TRIAL LAWYERS OF AMERICA
IN SUPPORT OF THE PETITIONER**

PAMELA A. LIAPAKIS, ESQ.	JEFFREY ROBERT WHITE, ESQ.*
1050 31st St., N.W.	JOHN E. CURTIN, ESQ.
Washington, DC 20007	1050 31st. St., N.W.
(202) 965-3500	Washington, DC 20007
<i>President, The Association</i>	(202) 965-3500
<i>of Trial Lawyers of America</i>	<i>Attorneys for Amicus Curiae</i>
	<i>*Counsel of Record</i>

BEST AVAILABLE COPY

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
IDENTITY AND INTEREST OF AMICUS CURIAE.....	1
REASONS FOR GRANTING THE WRIT	2
I. The Use Of A Complexity Exception Deprives Inventors Of Their Seventh Amendment Derived Jury Verdict.	2
II. The Federal Circuit Is Not Empowered to Create a Complexity Exception As a Standard of Appellate Review.	5
CONCLUSION	7

TABLE OF AUTHORITIES

Cases

<i>Blonder-Tongue Labs v. University Foundation</i> , 402 U.S. 313 (1971)	7
<i>Granfinaciera v. Nordberg</i> , 492 U.S. 33 (1989).....	3
<i>In re Lockwood</i> , 50 F.3d 966 (Fed. Cir. 1995), <i>cert.</i> <i>granted sub nom., American Airlines v. Lockwood</i> , 115 S. Ct. 2274 (1995).....	2
<i>Parklane Hosiery Co. v. Shore</i> , 439 U.S. 322 (1979)	3
<i>Ross v. Bernhardt</i> , 396 U.S. 531 (1970).....	3

Other Authorities

<i>Addendum To Hearings Before the Subcommittee on</i> <i>Improvements in Judicial Machinery</i> , Serial No. 96-24 (1979)	6
<i>Eleventh Annual Judicial Conference of the United States</i> <i>Court of Appeals for the Federal Circuit</i> , 153 F.R.D. 177 (1993)(Panel Discussion: "To What Extent Must Juries Be Used in Patent Cases?")	2

IN THE Supreme Court of the United States

October Term, 1995

No. 95-26

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Petition for a Writ Of Certiorari
to the United States Court Of Appeals
For The Federal Circuit

BRIEF OF AMICUS CURIAE
ASSOCIATION OF TRIAL LAWYERS OF AMERICA
IN SUPPORT OF THE PETITIONER

IDENTITY AND INTEREST OF AMICUS CURIAE

The Association of Trial Lawyers of America ["ATLA"] is a voluntary national bar association of approximately 50,000 attorneys who are engaged primarily in protecting the rights of individual citizens, including inventors. ATLA is committed to safeguarding the constitutionally guaranteed right to trial by jury. Letters of consent of the parties have been filed with the Court.

REASONS FOR GRANTING THE WRIT

I. THE USE OF A COMPLEXITY EXCEPTION DEPRIVES INVENTORS OF THEIR SEVENTH AMENDMENT DERIVED JURY VERDICT.

In deciding that "in a case tried to a jury, [a] court has the power *and obligation* to construe as a matter of law the meaning of language used in [a patent] claim," App. 30a (emphasis added), the Federal Circuit has created an exception to recognized appellate and trial level standards used to review the decisions of juries in patent infringement suits.

Such an exception, according to the Federal Circuit, is required in order to arrive at "true and consistent" interpretations of the scope of patent claims. App. 28a. In other quarters, this has been called a "complexity exception." *Eleventh Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, 153 F.R.D. 177, 236-52 (1993)(Panel Discussion: "To What Extent Must Juries Be Used in Patent Cases?").

Left unsaid by the Federal Circuit is the fact that the exception is also required in order to justify the court's ousting of Markman's Seventh Amendment derived jury verdict. Without such an exception, as Petitioners point out, the Federal Circuit has conceded that a patentee has a Seventh Amendment right to a jury trial in patent infringement suits. Pet. at 10.

The policy underlying the exception the Federal Circuit now attempts to impose on a nation of inventors was foretold in *In re Lockwood*, 50 F.3d 966 (Fed. Cir. 1995), *cert. granted sub nom., American Airlines v. Lockwood*, 115 S. Ct. 2274 (1995). The dissent in *Lockwood*, part of the majority in *Markman* below, stated "that the denomination of an issue as

one of law represents a policy decision that a judge is more appropriate than a jury to make the decision." 50 F.3d at 990 (Nies, J., dissenting, joined by Judges Archer and Plager).¹ Here, by stating that a court has an "obligation to construe as a matter of law the meaning of language used in a patent claim" in a jury trial, App. 30a, when such a meaning may require a judge to resolve factual disputes, all of which is subject to de novo appellate review, App. 20a, the Federal Circuit has made the policy decision that factual disputes are too complex for any jury.

This determination violates the Seventh Amendment. This Court has stated, in the context of a jury trial, that such an exception can exist only if Congress creates it, "by entrusting the resolution of certain disputes," in this case, patent infringement and validity, "to an administrative agency or to a specialized court of equity whose functioning is incompatible with the use of a jury." *Granfinanciera v. Nordberg*, 492 U.S. 33, 42 n.4 (1989)(bankruptcy case). Cf., *Ross v. Bernhardt*, 396 U.S. 531 (1970)(White, J.)(right to trial by jury extend to stockholder derivative suit). Congress has not taken this step with respect to patent infringement suits; the Federal Circuit cannot enact such an exception on its own.

Amicus suggests that these principles apply regardless of whether the exception is applied at the trial court level or, as in this case, at the appellate level.

¹A complexity exception has been urged by business interests. An industry panel composed primarily of representatives of large U.S. corporations has called for "public debate over the appropriateness of the use of juries to resolve questions of patent validity or infringement" and, more specifically, "the extent to which a complexity exception can and should be applied to deny a demand for a jury trial." Advisory Commission on Patent Law Reform. A Report to the Secretary of Commerce 107-10 (Aug. 1992).

Even if it were true that the testimony put forth by Petitioner Markman involved complex issues and could therefore be deemed onerous, the Seventh Amendment does not permit the ousting of Markman's jury verdict on that basis. This Court has said emphatically that the sometimes "onerous nature of the protection" afforded by the Seventh Amendment is "no license for contracting the right secured by the Amendment." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 346 (1979) (Rehnquist, J. dissenting).

This case points to an almost desperate desire on the part of the majority below to impose its policy goals of enacting its own type of complexity exception where none is needed. The technology embodied in Markman's patent, i.e. the dry cleaning industry and the word "inventory," are hardly complex.

The use of such an exception has a most acute effect on the individual who retains ownership of a patent² and seeks to enforce patent rights in a district court. It impermissibly deprives the owner of a jury trial or verdict by delaying or foreclosing entirely a final resolution of his or her rights. As was pointed out by Judge Mayer, concurring in the judgment, the upshot of the court's holding relegates Markman's trial to "a charade, for notwithstanding any trial level activity [the court] will do pretty much what it wants under its de novo retrial." App. 68a. Awaiting such a retrial, the individual inventor may languish in bankruptcy, poor health, or be forced to forego the right to an appeal altogether.

²Twenty percent of all utility patents issued by the United States Patent Office since 1963, which amounts to 481,459 patents, are presently owned by individual inventors. *All Technologies Report, January 1963-June 1995*, U.S. Patent and Trademark Office, Office of Information Products Development/TAF Program Part A1 at 1-2.

Amicus urges this Court to grant review in this case to protect an inventor's right to a Seventh Amendment derived jury verdict.

II. THE FEDERAL CIRCUIT IS NOT EMPOWERED TO CREATE A COMPLEXITY EXCEPTION AS A STANDARD OF APPELLATE REVIEW.

The majority below first states that it is bound to accord findings of fact by a jury "substantial deference" on appellate review. App. 20a. Nevertheless, the majority holds that in this case such findings must be decided by a judge *and* are a matter of law. "[T]he court has the power *and obligation* to construe as a matter of law the meaning of language used in the patent claim," App. 30a, subject to its de novo review. App. 20a.

By so doing, the court holds that when in its opinion complex factual issues arise, it can ignore established appellate standards of review of jury-decided disputes by evoking a complexity exception. This not only violates the right to a Seventh Amendment derived jury verdict, but is contrary to Congressional intent.

By subjecting disputed factual issues underlying a determination of the scope of a patent to de novo review, the Federal Circuit fulfills the fears of those who objected to its very creation.

In 1975, the Hruska Commission recommended against [a specialized patent] court and, in the course of so doing catalogued the various arguments advanced against its creation, to wit: . . . (2) judges of a specialized court, given their continued response and great expertise in a single field of law, might impose their own views of policy even where the scope of

review under the applicable law is supposed to be more limited.

Statement of Donald R. Dunner, *Addendum To Hearings Before the Subcommittee on Improvements in Judicial Machinery* 55, Serial No. 96-24 (1979)(Testimony on the Federal Courts Improvement Act).

Sixteen years later, the Federal Circuit now attempts to resolve disputed issues of fact through the use of their de novo scope of review.

During the same Congressional hearings sixteen years ago, Donald R. Dunner, an esteemed member of the patent bar, was asked to comment on the possibility that:

[The] presumed expertise of [a] single court of appeals would encourage attempts to retry cases at the appellate level and encourage the court to substitute its judgment for that of the trial court, thereby changing the standards and level of review.

Id. at 58. He replied:

To the extent the Court of Appeals for the Federal Circuit is reviewing questions of fact from a lower court, that review will be subject to the same restrictions as is review by all Federal appellate courts of district court findings of fact. . . . If the point here is intended to suggest that judges of a specialist court who are exposed more than other judges to a given field of law will pervert the law without regard to what it should be, the foundation for this notion is at best questionable and, in any event, whatever the court does is subject to Supreme Court control to keep it in toe.

Id.

Amicus suggests that just such "control" is now needed. Clearly it was not Congress' intent to empower the Federal Circuit to resolve factual issues, complex or otherwise, in bench trials.

This Court questioned the rationale underlying such a complexity exception standard of appellate review when it stated that:

Assuming a patent case so difficult as to provoke a frank admission of judicial uncertainty, one might ask what reason there is to expect that a second district judge or court of appeals would be able to decide the case more accurately.

Blonder-Tongue Labs v. University Foundation, 402 U.S. 313, 331-32 (1971). Amicus suggests that the above remarks are applicable to jury trials as well.

CONCLUSION

For these reasons, Amicus urges the Court to grant the Petition for a Writ of Certiorari in this case.

Respectfully submitted,

JEFFREY ROBERT WHITE, ESQ.*

JOHN E. CURTIN, ESQ.

1050 31st. St., N.W.

Washington, DC 20007

(202) 965-3500

Attorneys for Amicus Curiae

The Association of Trial Lawyers of America

August 1, 1995

AUG 03 1995

IN THE
Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

—v.—

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**MOTION FOR LEAVE TO FILE
BRIEF AMICUS CURIAE and
AMICUS CURIAE BRIEF OF THE AMERICAN
BOARD OF TRIAL ADVOCATES IN SUPPORT
OF PETITION FOR A WRIT OF CERTIORARI**

Robert G. Vial
Counsel of Record
Daphne A. Burns
Counsel for Amicus Curiae
American Board of Trial
Advocates
1717 Main Street; Suite 4400
Dallas, Texas 75201
(214) 712-4400

BEST AVAILABLE COPY

No. 95-26

IN THE
Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
and ALTHON INSTRUMENTS, INC.,

Respondents.

On Petition For A Writ of Certiorari To The
United States Court of Appeals For The Federal Circuit

**MOTION FOR LEAVE TO FILE
BRIEF OF *AMICUS CURIAE*
AMERICAN BOARD OF TRIAL ADVOCATES
IN SUPPORT OF PETITIONERS**

Amicus Curiae American Board of Trial Advocates ("ABOTA") moves for leave to file the accompanying brief in support of the petition for a writ of certiorari. Petitioners have consented to ABOTA's filing of a brief *amicus curiae*, but respondents have refused consent.

ABOTA is a national organization of trial lawyers composed equally of defense and plaintiffs counsel. Its primary purpose is to preserve the constitutional right to trial

by jury. It is dedicated to promoting the fair and efficient administration of justice. It has no interest in any of the parties to this action.

ABOTA is very concerned about the consequences of the Federal Circuit's decision. By reclassifying fact as "law," the Federal Circuit has taken important fact issues out of the hands of juries in actions at law for money damages for patent infringement. It has also stripped the trial court's fact determinations of the deference they deserve on appeal, and substituted *de novo* review in place of that deference. The reasons that this Court should review this decision are discussed in the accompanying brief.

As a national organization of trial lawyers, ABOTA brings an important perspective to this case. ABOTA believes that its views could aid this Court in deciding whether to grant the petition for a writ of certiorari. It therefore requests permission to file the accompanying brief.

Respectfully submitted,

/s/ Robert G. Vial
Robert G. Vial, President,
Counsel of Record
Daphne A. Burns
Counsel for Amicus Curiae
American Board of Trial Advocates
1717 Main Street, Suite 4400
Dallas, Texas 75201
(214) 712-4400

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	ii
Interest of <i>Amicus Curiae</i>	1
Summary of Argument	2
ARGUMENT	3
I. The Federal Circuit Should Not Be Allowed to Subvert Seventh Amendment Rights By Reclassifying Fact As "Law"	3
II. The Federal Circuit Should Not Be Allowed to Skew The Relationship Between Trial And Appeal By Making Itself A <i>De Novo</i> Finder Of Fact	11
III. <i>Markman</i> Would Create An Impractical, Unworkable System For Jury Trials And Appeals	15
CONCLUSION	18

TABLE OF AUTHORITIES

	<u>Page</u>
CASES	
<i>American Cyanamid Co. v. United States Surgical Corp.</i> , 30 USPQ2d 1561 (D. Conn. 1993)	5
<i>Anderson v. City of Bessemer, N.C.</i> , 470 U.S. 564 (1985)	9, 12, 13, 14
<i>Autogiro Co. of Amer. v. United States</i> , 384 F.2d 391 (Ct. Cl. 1978)	10
<i>Brooktree Corp. v. Advanced Micro Devices, Inc.</i> , 977 F.2d 1555 (Fed. Cir. 1992)	4, 5
<i>Cunningham & Co. v. Consolidated Realty Mgt., Inc.</i> , 803 F.2d 840 (5th Cir. 1986)	9
<i>Curriden v. Middleton</i> , 232 U.S. 633 (1914)	10
<i>Delta-X Corp. v. Baker Hughes Production Tools, Inc.</i> , 984 F.2d 410 (Fed. Cir. 1993)	4, 5
<i>Dennison Mfg. Co. v. Panduit Corp.</i> , 475 U.S. 809 (1986) (<i>per curiam</i>)	11

<i>Eaton Corp. v. Auburn Gear, Inc.</i> , 8 USPQ 1373 (N.D. Ind. 1988)	15
<i>Fonar Corp. v. Johnson & Johnson</i> , 821 F.2d 627 (Fed. Cir. 1987), <i>cert. denied</i> , 484 U.S. 1027 (1988)	7
<i>Gallick v. Baltimore & Ohio R. Co.</i> , 372 U.S. 108 (1963)	13
<i>Graver Tank & Mfg. Co. v. Linde Air Products Co.</i> , 336 U.S. 271 (1949)	12
<i>Inwood Laboratories, Inc. v. Ives Laboratories, Inc.</i> , 456 U.S. 844 (1982)	12, 13
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989)	3, 4
<i>Lemelson v. General Mills, Inc.</i> , 968 F.2d 1201 (Fed. Cir. 1992), <i>cert. denied</i> , 113 S. Ct. 976 (1993)	4
<i>Levy v. Gadsby</i> , 7 U.S. (3 Cranch) 180 (1805)	8
<i>Liposome Co., v. Vestar, Inc.</i> , 1994 WL 738952 (D. Del. 1994)	6
<i>Loctite Corp. v. Ultraseal Ltd.</i> , 781 F.2d 861 (Fed. Cir. 1985)	3

<i>Lucas Aerospace, Ltd. v. Unison Indus., L.P.</i> , F. Supp. ___, 1995 WL 362397, *12 n.7 (D. Del. 1995)	8, 16
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) (<i>en banc</i>)	passim
<i>McGill, Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir.), <i>cert. denied</i> , 469 U.S. 1037 (1984).	4
<i>Optical Coating Laboratory, Inc. v. Applied Vision, Ltd.</i> , 1994 WL 361752, *4 (N.D. Cal. 1994).	6
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	4
<i>Perini America, Inc. v. Paper Converting Machine Co.</i> , 832 F.2d 581 (Fed. Cir. 1987)	4
<i>Quantum Corp. v. Tandon Corp.</i> , 940 F.2d 642 (Fed. Cir. 1991)	15
<i>RasterOps v. Radius, Inc.</i> , 861 F. Supp. 1479 (N.D. Cal. 1994).	6
<i>Smithkline Diagnostics Inc. v. Helena Lab. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988)	4
<i>Snellman v. Ricoh Co.</i> , 862 F.2d 283 (Fed. Cir. 1988), <i>cert. denied</i> , 491 U.S. 910 (1989)	4

<i>Tennant v. Peoria & Pekin Union R. Co.</i> , 321 U.S. 29 (1944)	13
<i>Tol-O-Matic, Inc. v. Proma Produkt-und Marketing Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed. Cir. 1991)	4
<i>United States Naval Institute v. Charter Communications, Inc.</i> , 875 F.2d 1044 (2d Cir. 1989)	9
<i>United States v. National Ass'n of Real Estate Bds.</i> , 339 U.S. 485 (1950)	12
<i>United States v. Yellow Cab Co.</i> , 338 U.S. 338 (1949)	12
<i>Zenith Radio Corp. v. Hazeltine Research, Inc.</i> , 395 U.S. 100 (1969).	12, 14

CONSTITUTIONAL PROVISIONS

U.S. Const., Seventh Amendment	3, 11
--	-------

RULES

Rule 50(a)(1), Fed. R. Civ. P.	13
Rule 52(a), Fed. R. Civ. P.	8, 9, 13

TREATISES

A. Hamilton, <i>The Federalist</i> , No. 83 (J. Cooke, ed.) (1961)	10
Guide To Jury Instructions In Patent Cases (American Intellectual Property Law Ass'n, 1990)	14
J. Guinther, <i>The Jury in America</i> , in <i>The American Civil Jury</i> (M. Arnold, ed.) (1986)	10
Vol. 4 Williston on Contracts (1961)	9

No. 95-26

IN THE
Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
and ALTHON ENTERPRISES, INC.,

Respondents.

On Petition For A Writ of Certiorari To The
United States Court of Appeals For The Federal Circuit

**AMICUS CURIAE BRIEF OF THE
AMERICAN BOARD OF TRIAL ADVOCATES
IN SUPPORT OF PETITION
FOR A WRIT OF CERTIORARI**

Interest of Amicus Curiae

The American Board of Trial Advocates (ABOTA) is a national organization whose members include 4,200 trial lawyers. ABOTA's primary purpose is to preserve the Constitutional right to a jury trial. It is dedicated to promoting the fair and efficient administration of justice.

ABOTA has no interest in any of the parties or in which side ultimately wins this lawsuit. Its only interest is in the important issues that this case raises, concerning: (a) the right to trial by jury, and (b) the respective roles of trial and appellate courts.

Summary of Argument

Unless reviewed by this Court, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), would signal a major departure from fundamental principles of American jurisprudence. First, it ousts juries from their constitutionally protected role as finder of fact in actions at law for money damages for patent infringement. Second, it assigns the court of appeals a new and unprecedented role as *de novo* fact finder, with free rein to substitute its own findings in place of those made in the trial court.

In both respects, *Markman* upsets the institutional balance that is the bedrock of our legal system. It is a drastic departure from basic principles. It warrants this Court's review.

To oust juries from their fact finding role, *Markman* uses the simplest of expedients: It "redesignat[es] fact as 'law.'" *Id.*, 52 F.3d at 999 (Newman, J., dissenting).

Markman's reclassification of fact as "law" has sweeping ramifications. Judge Mayer of the Federal Circuit stated that *Markman* "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment." *Markman*, 52 F.3d at 989 (Mayer, J., concurring in the result). He also described the decision as a "sea change in the course of patent law that is nothing short of bizarre." *Id.* As Judge Newman stated in dissent, the decision "moves the Federal Circuit firmly out of the juridical mainstream," and "raises a constitutional issue of grave consequence." *Id.*, 52 F.3d at 999, 1026 (Newman, J., dissenting).

Because of the Federal Circuit's unique jurisdiction, this decision will govern all patent cases, everywhere in the

country. *Markman* also has unfortunate implications outside the patent arena. It reflects a belief, shared by all too many, that juries should not be entrusted with important or complex issues. This view runs afoul of the framers' decision embodied in the Seventh Amendment to provide a constitutional right to trial by jury.

This Court should grant certiorari to preserve the Seventh Amendment right to trial by jury and to maintain the appropriate balance between trials and appeals.

ARGUMENT

I. The Federal Circuit Should Not Be Allowed To Subvert Seventh Amendment Rights By Reclassifying Fact As "Law"

The language in patent claims is not written for judges or lawyers. It often is technical, scientific language, and it is written for persons trained in the relevant technology or "art." The aim of claim construction is to ascertain how persons skilled in that field would understand the claim language.¹

Prior to *Markman*, courts could construe claim language as a matter of law if the underlying facts were not genuinely in dispute.² But where conflicting evidence raised a genuine fact issue, then claim construction presented issues for the trier of fact.³ In such cases, the fact finder's

¹ *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867 (Fed. Cir. 1985).

² *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989).

determinations received appropriate deference once the case reached the appellate court.⁴

Markman changes all that. By reclassifying fact as law, it takes all claim interpretation issues away from the jury. It does so even where conflicting evidence, including expert testimony, presents a genuine factual dispute on how persons skilled in the relevant technology would understand the language appearing in the claims.

By way of example, the following issues of claim interpretation -- all treated under prior cases as presenting

³ See, e.g., *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1201, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Johnston*, 885 F.2d at 1579; *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

⁴ See, e.g., *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1568-69 (Fed. Cir. 1992) (appeal from jury verdict); *Smithkline Diagnostics Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (appeal from bench trial).

issues of fact -- would now become issues of law under *Markman*:

- how an electrical engineer skilled in semiconductor chip technology would understand "distributed capacitances [in the MOS transistor] being charged during the state of non-conductivity in the first transistor."⁵
- how persons skilled in the packaging of medical products would understand "a storage stable sterile synthetic surgical element of a polymer subject to hydrolytic degradation to non-toxic, tissue-compatible absorbable components."⁶
- the meaning of "first electrical comparator connected to the load measuring means measuring the polished rod load relative to a preset load point" to an engineer skilled in designing fluid pumps.⁷
- how people skilled in technology for converting video signals for display would understand "non-interlaced raster frame buffer

⁵ *Brooktree*, 977 F.2d at 1572-73.

⁶ *American Cyanamid Co. v. United States Surgical Corp.*, 30 USPQ2d 1561, 1563 (D. Conn. 1993).

⁷ *Delta-X*, 984 F.2d at 414-15.

... for storing the video signal at a second scan rate differing from the first scan rate."⁸

- how persons skilled in the art of optical lens design would understand "selectively operating the sputter cathode device to deposit a layer of the selected material on the substrate; and selectively operating the ion source device in sequence with the sputter cathode device for substantially completing the selected reaction during a single pass of the carrier."⁹
- the meaning of "human leukocyte interferon as a homogeneous protein species" to persons skilled in genetic research.¹⁰
- the meaning, to those skilled in the processes for dehydrating and preserving liposomes, of the phrase "mixing a hydrophylic compound with the colloidal dispersion of liposomes in an aqueous medium."¹¹

This Court should ask itself whether it would be in a position to rule on the above issues as a matter of law.

⁸ *RasterOps v. Radius, Inc.*, 861 F. Supp. 1479, 1483 (N.D. Cal. 1994).

⁹ *Optical Coating Laboratory, Inc. v. Applied Vision, Ltd.*, 1994 WL 361752, *4 (N.D. Cal. 1994).

¹⁰ *Hoffman-LaRoche Inc. v. Burroughs Wellcome Co.*, 10 USPQ2d 1602, 1605 (D.Md. 1989).

¹¹ *Liposome Co., v. Vestar, Inc.*, 1994 WL 738952 (D. Del. 1994).

knowing that experts have offered diametrically opposed testimony on how persons skilled in the relevant technology would understand the disputed language. Unless this Court could decide such issues as a matter of law, there is something seriously wrong with the *Markman* decision.

What is wrong, plainly and simply, is that such questions are not issues of law in any realistic sense. They are not issues in which judges have training or expertise. They involve real world facts, concerning the state of mind of persons skilled a particular technology. They have importance only to particular litigants -- just as the construction of a deed (which demarcates the boundaries of real property) has importance only to particular litigants. They do not involve broad legal principles of general applicability.

The *process* by which such issues are decided is not the *process* by which courts decide issues of law. The meaning of claim language to a person skilled in a particular technology, when seriously in dispute, cannot be discovered by reading briefs or hearing oral argument. It must be determined by evaluating evidence, including the testimony of experts.

Markman itself recognizes that extrinsic evidence -- including expert testimony -- is often needed to ascertain how persons skilled in the particular technology would understand disputed claim language. See, *Markman*, 52 F.3d at 979, quoting *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988) ("Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.").

When the testimony of experts conflicts -- and it often does -- then someone needs to decide which aspects of the testimony to accept, which to reject, and what weight the

testimony deserves. This requires application of the tools that traditionally are used to assess the credibility of witnesses. It requires fact-finding.

Markman pretends that is not the case. It insists that the decision to "us[e] certain extrinsic evidence . . . and reject[] other evidence" does "not [entail] crediting certain evidence over other evidence or making factual evidentiary findings." *Markman*, 52 F.3d at 981. That assertion denies reality. It is an exercise in "sophistry and fiction." *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, ___ F. Supp. ___, 1995 WL 362397, *12 n.7 (D. Del. 1995) (criticizing *Markman*).

The rationales cited in *Markman* to support the reclassification of fact as "law" cannot withstand scrutiny. The court summarized the basis for its holding as follows:

The reason that the courts construe patent claims as a matter of law and should not give such task to the jury as a factual matter is straightforward: It has long been and continues to be a fundamental principle of American jurisprudence that "the construction of a written evidence is exclusively with the court." *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805) (Marshall, C.J.).

But the principle that *Markman* describes as "fundamental" is flatly at odds with Rule 52(a), Fed. R. Civ. P., which recognizes that construction of a written document may present issues of fact.¹² It is also at odds with this Court's

¹² Rule 52(a) states in pertinent part that "[f]indings of fact . . . based on . . . documentary evidence, shall not

holding in *Anderson v. City of Bessemer, N.C.*, 470 U.S. 564 (1985), that appellate courts must defer to the trial court's findings of fact, including fact findings that are based on "documentary evidence." *Id.*, 470 U.S. at 574. Under Rule 52(a) and under *Anderson*, it is simply wrong to say that construction of a written document is invariably an issue of law.

In fact, construction of written documents often presents issues of fact. Courts have long recognized this principle in contract cases, when they apply the hornbook rule that "[w]here the meaning of a writing is uncertain . . . the question of its meaning should be left to the jury." Vol. 4 Williston on Contracts, § 616, at p. 652 (1961).¹³ Until *Markman*, courts followed the same principle in construing disputed language in patent claims.¹⁴

Markman rejects the analogy to contract cases. *Id.*, 52 F.3d at 985. But it never offers a meaningful distinction between contracts and patents.

First, *Markman* tries to distinguish contract cases by stating that interpretation of a contract depends on the parties' "intent," whereas the intent of the PTO or the patentee is irrelevant in construing patent claims. *Id.* This misses the point. Certainly, different issues arise in interpreting contracts

be set aside unless clearly erroneous"

¹³ See also, *United States Naval Institute v. Charter Communications, Inc.*, 875 F.2d 1044, 1048 (2d Cir. 1989); *Cunningham & Co. v. Consolidated Realty Mgt., Inc.*, 803 F.2d 840, 842-43 (5th Cir. 1986).

¹⁴ See e.g., cases cited in fn. 3, *supra*.

and patents -- but where those issues are genuinely in dispute, then fact issues arise for a jury to resolve.

Second, *Markman* distinguishes contract cases from patent cases by stating that ambiguity in contracts may present fact issues, but "ideally there should be no 'ambiguity' in claim language. . . ." *Id.*, 52 F.3d at 986. Again, this misses the point. Contracts, like patent claims, also should "ideally" be unambiguous. But in both contracts and patents, this ideal is not always achieved. Indeed, "a clear and unambiguous [patent] claim [is] a rare occurrence." *Autogiro Co. of Amer. v. United States*, 384 F.2d 391, 396 (Ct. Cl. 1978). When experts offer diametrically opposed testimony on what "ideally" unambiguous claim language would mean to persons skilled in the art, then interpretation of that language is a fact issue for the jury.

To be sure, complex issues may arise in determining how persons skilled in a particular technology would understand technical language. But "mere complication of the facts" does not turn fact into law or justify taking the issue away from the jury. *Curriden v. Middleton*, 232 U.S. 633, 636 (1914). This Court has never adopted a "complexity" exception to the right to trial by jury. Nor could it adopt such an exception consistent with the framers' decision to enact the Seventh Amendment, notwithstanding Alexander Hamilton's assertion that juries should not be entrusted with complex issues. See, J. Guinther, *The Jury in America*, in *The American Civil Jury* 45, 55 (M. Arnold, ed.) (1986); A. Hamilton, *The Federalist*, No. 83, pp. 569-570 (J. Cooke, ed.) (1961).

At bottom, the Federal Circuit seems to be motivated less by precedent and more by a policy preference for having judges -- and ultimately, the specialist, patent law judges on the Federal Circuit -- decide the meaning of patent claims.

See, *Markman*, 52 F.3d at 979. Regardless of whether this policy is wise or unwise -- *amicus* believes it is unwise in the extreme -- it is at odds with the Seventh Amendment. As Judge Mayer stated:

The quest to free patent litigation from the "unpredictability" of jury verdicts, and generalist judges, results from insular dogmatism inspired by unwarranted elitism; it is unconstitutional.

Markman, 52 F.3d at 989 (Mayer, J.). This Court should not permit the Federal Circuit to subvert the constitutional right to jury trials by the "ruse" (*Markman*, 52 F.3d at 993 [Mayer, J.]) of reclassifying fact as "law."

II. The Federal Circuit Should Not Be Allowed To Skew The Relationship Between Trial And Appeal By Making Itself A De Novo Finder Of Fact

Markman not only invades the province of juries, but also obliterates the deference due to fact-based determinations made on the evidence at trial. It distorts the entire relationship between trials and appeals.

Instead of deferring to the trial court's findings, the Federal Circuit gives itself the power and responsibility for deciding facts *de novo*. It does so without deference to anything that happened in the trial court, and without regard to whether the initial fact-finder was a judge or a jury. See *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810-11 (1986) (*per curiam*).

This flies in the face of repeated admonitions from this Court that appellate courts "must constantly have in mind that their function is not to decide factual issues *de novo*." *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969).¹⁵ It "usurps a major part of the functions of both trial judge and jury in patent cases, obliterating the traditional, defined differences between the roles of judge and jury, and trial and appellate courts." *Markman*, 52 F.3d at 992 (Mayer, J.).

Appellate courts may not reverse the trial court's factual determinations merely because they "would have decided the case differently." *Anderson*, 470 U.S. at 573. Yet that is precisely what the Federal Circuit now intends to do.

The finder of fact at trial, whether it is a judge or a jury, has advantages that appellate courts do not possess. The finder of fact sees and hears the live witnesses. It perceives nuances that cannot be captured in a cold record. It may see demonstrations that cannot be duplicated in that record. It lives with the evidence day in and day out. It enjoys an intimacy with the trial proceedings that an appellate court cannot match. The advantages that trial courts have in such matters are especially pronounced in patent litigation, "where the evidence is largely the testimony of experts enlightened by scientific demonstrations." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 274 (1949).

¹⁵ Accord: *Anderson*, 470 U.S. at 573; *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982); *United States v. National Ass'n of Real Estate Bds.*, 339 U.S. 485, 495-96 (1950); *United States v. Yellow Cab Co.*, 338 U.S. 338, 342 (1949).

Our system wisely recognizes the trial court's unique advantages in finding facts. In jury trials, it requires the court of appeals to defer to the jury's fact findings so long as they are supported by substantial evidence that reasonable jurors could accept.¹⁶ In bench trials, it requires appellate courts to defer to the trial judge's findings unless they are "clearly erroneous."¹⁷ In both instances, the guiding principle on appeal is deference to determinations that are based on the evidence at trial.

Markman destroys that deference. As Judge Mayer stated, *Markman* reduces trials to "a charade, for notwithstanding any trial level activity, [the Federal Circuit] will do pretty much what it wants under its *de novo* retrial." *Markman*, 52 F.3d at 993 (Mayer, J.). By making the Federal Circuit the *de novo* finder of fact, *Markman* turns the "trial judge and jury [into] ciphers upon appellate review." *Id.*, 52 F.3d at 1008 (Newman, J.).

As an appellate court, the Federal Circuit has two legitimate roles when an appeal raises issues concerning disputed claim construction. The first role involves evaluating the instructions under which the jury construed the claims, to make sure that the instructions correctly summarized neutral

¹⁶ See, *Tennant v. Peoria & Pekin Union R. Co.*, 321 U.S. 29, 35 (1944); *Gallick v. Baltimore & Ohio R. Co.*, 372 U.S. 108, 114-15 (1963). See also, Rule 50(a)(1), Fed. R. Civ. P.

¹⁷ See, *Inwood Laboratories*, 456 U.S. 844, 853; *Anderson*, 470 U.S. at 564. See also, Rule 52(a), Fed. R. Civ. P.

legal principles so that the jury had accurate guidance in applying the law to the facts presented.¹⁸

The second role is to determine whether the findings at trial, when challenged on appeal, are supported by substantial evidence (in jury trials) or are clearly erroneous (in bench trials). This provides an adequate safeguard against the danger of irrational or clearly erroneous results, while at the same time recognizing that the fact finder is better situated for deciding fact issues than the court of appeals.

The Federal Circuit fulfills its appropriate role when it determines whether fact findings are supported by substantial evidence or are clearly erroneous. It seriously oversteps that role when it substitutes its own views in place of supportable, rational determinations made by the finder of fact based on the evidence at trial. *Anderson*, 470 U.S. at 573. That result, as Judge Mayer stated, would transform the trial from "the main event" . . . [into] "a tryout on the road." *Markman*, 52 F.3d at 992, quoting *Anderson*, 470 U.S. at 575.

The Federal Circuit's stated intention to review fact determinations *de novo* is a direct affront to this Court's decisions in *Zenith Radio Corp. v. Hazeltine Research*, 395 U.S. 100, *Anderson*, 470 U.S. 564, and other cases emphasizing the deference that is due to trial courts' fact determinations. It is a serious departure from the proper role of an appellate court.

¹⁸ See e.g., Guide To Jury Instructions In Patent Cases (American Intellectual Property Law Ass'n, 1990), p. 9.

III. *Markman* Would Create An Impractical, Unworkable System For Jury Trials And Appeals

Markman is not only wrong. As Judge Newman has stated, it is "unworkable," *id.*, 52 F.3d at 999 -- both at the trial level and on appeal.

In trials of patent infringement cases where a jury has been demanded, *Markman* creates a procedural nightmare. Under *Markman*, claim construction in jury trials could be handled in one of two ways: The first way would be for the trial judge to determine claim construction before the jury trial begins. This would require a separate "*Markman* hearing," which could last days or even weeks.

This would unduly burden the parties and the courts. Bifurcation of patent infringement cases into separate phases, e.g., for liability and damages, already is "routine practice." *Eaton Corp. v. Auburn Gear, Inc.*, 8 USPQ 1373, 1374 (N.D. Ind. 1988).¹⁹ Adding a separate *Markman* hearing would make *trifurcation* of patent cases the norm. What is more, much of the evidence in such a hearing would duplicate evidence that would need to be introduced in later phases on validity or infringement. The result would be increased burdens on the parties and on the courts.

Moreover, the alternative to pretrial *Markman* hearings is just as uninviting. That alternative would be for

¹⁹ The Federal Circuit has strongly recommended bifurcation where the attorney-client privilege is asserted in cases charging willful infringement, as is often the case. See, *Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 643-44 (Fed. Cir. 1991).

the district judge and the jury simultaneously to hear all the evidence, including expert testimony, with the trial court to adopt one side's claim construction and reject the other side's in "framing its charge to the jury. . . ." *Markman*, 52 F.3d at 981.

If trial courts were to follow this path, litigants would have to tailor their evidence to address two conflicting theories of claim construction, knowing that at the close of the evidence the trial judge will reject one side's construction and adopt the other's. Of course, the party whose claim construction is rejected would suffer almost insurmountable prejudice. That prejudice could not be cured by an instruction directing the jury that the trial judge's agreement with the testimony of one side's experts on claim construction does not signify that the trial judge agrees with testimony by that expert on other issues, such as validity or infringement.

Even leaving aside the issue of prejudice, having the trial court decide claim construction at the close of the evidence as a matter of law would pose serious procedural problems. As the district court stated in *Lucas Aerospace*, 1995 W.L. at *1 n.3:

. . . *Markman* creates a practical problem in courtroom administration that the Court confessedly does not know how to solve: How does the Court construe claims as a matter of law at the close of evidence without disrupting the jury? . . . To construe claims before giving the case to the jury requires immediate access to the trial transcript . . . , rapid briefing by the parties, and hopefully an opinion by the court. . . . [I]f the jury were sent home during this period, there is a very real chance that many of

the facts important to resolving the infringement issues will have been forgotten.

Markman would be no less problematic on appeal. As discussed in Point II, *supra*, "[t]he appeal is not designed for *de novo* finding of the facts." *Markman*, 52 F.3d at 1025 (Newman, J.). Reading appellate briefs and listening to thirty minutes of oral argument are poor substitutes for the trial court's intimacy with the facts of any particular case. *Id.* at 999, 1021 (Newman, J.). It is far from clear how the court of appeals will decide which expert's testimony to accept and which expert's testimony to reject, when it never sees live witnesses and cannot evaluate their credibility. That is a task for which the court of appeals is not well-suited. It is one where deference to the trial court is appropriate -- and is mandated by this Court's prior decisions.

CONCLUSION

For the reasons set forth above, this Court should grant the petition for a writ of certiorari.

Respectfully submitted,

Robert G. Vial, President,
Counsel of Record
Daphne A. Burns
Counsel for Amicus Curiae
American Board of Trial Advocates
1717 Main Street, Suite 4400
Dallas, Texas 75201
(214) 712-4400

August 3, 1995

No. 95-26

Supreme Court, U. S.
FILED

AUG 07 1994

OFFICE OF THE CLERK

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF LITTON SYSTEMS, INC.,
AS AMICUS CURIAE IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI**

FREDERICK A. LORIG
BRIGHT & LORIG
633 West 5th Street
Los Angeles, CA 90274
(213) 627-7774

JOHN E. PRESTON
VICTORIA T. MCGEE
LITTON INDUSTRIES
21240 Burbank Blvd.
Woodland Hills, CA 93167

LAURENCE H. TRIBE
Counsel of Record
JONATHAN S. MASSEY
KENNETH J. CHESEBRO
1575 Massachusetts Avenue
Hauser Hall 420
Cambridge, MA 02138
(617) 495-4621

Counsel for Amicus Curiae

August 7, 1995

BEST AVAILABLE COPY

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
INTEREST OF <i>AMICUS CURIAE</i>	1
INTRODUCTION AND SUMMARY OF ARGUMENT ...	1
REASONS FOR GRANTING THE WRIT	4
I. THE DECISION BELOW CONFLATES THE DISTINCTION BETWEEN LAW AND FACT AND THREATENS THE ROLE OF THE JURY IN NON-PATENT AS WELL AS PATENT LITIGATION ...	6
II. THE SEVENTH AMENDMENT CANNOT BE CIRCUMVENTED BY RESORTING TO A SUPPOSED ANALOGY BETWEEN PATENTS AND STATUTES	16
CONCLUSION	20

TABLE OF AUTHORITIES

Cases

<i>Allen Organ Co. v. Kimball Int'l, Inc.</i> , 839 F.2d 1556 (Fed. Cir.), <i>cert. denied</i> , 488 U.S. 850 (1988)	13
<i>American Airlines, Inc. v. Lockwood</i> , No. 94-1660 (petition for certiorari granted June 5, 1995)	4
<i>Arachnid Inc. v. Medalist Mktg. Corp.</i> , 972 F.2d 1300 (Fed. Cir. 1992)	7
<i>Baltimore & Carolina Line, Inc. v. Redman</i> , 295 U.S. 654 (1935)	12
<i>Barrows v. Jackson</i> , 346 U.S. 249 (1953)	17
<i>Beacon Theatres, Inc. v. Westover</i> , 359 U.S. 500 (1959)	2, 10, 12
<i>Bell Communications Research, Inc. v. Vitalink Communica- tions Corp.</i> , 55 F.3d 615 (Fed. Cir. 1995)	3
<i>Bi-Metallic Inv. Co. v. State Bd. of Equalization</i> , 239 U.S. 441 (1915)	17
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	15
<i>Blonder-Tongue Lab., Inc. v. University of Illinois Found.</i> , 402 U.S. 313 (1971)	18
<i>Blunt v. Patten</i> , F. Cas. No. 1579 (C.C.N.Y. 1828)	19
<i>Bouchet v. National Urban League, Inc.</i> , 730 F.2d 799 (D.C. Cir. 1984)	13
<i>Bouie v. City of Columbia</i> , 378 U.S. 347 (1964)	6
<i>Brisk v. Miami Beach</i> , 726 F. Supp. 1305 (S.D. Fla. 1989)	19
<i>Brown v. Piper</i> , 91 U.S. 37 (1875)	15
<i>Brownlee v. Yellow Freight System, Inc.</i> , 921 F.2d 745 (8th Cir. 1990)	13
<i>Calnetics Corp. v. Volkswagen of America, Inc.</i> , 532 F.2d 674 (9th Cir.) (<i>per curiam</i>), <i>cert. denied</i> , 429 U.S. 940 (1976)	13
<i>Cardinal Chemical Co. v. Morton Intern., Inc.</i> , 113 S. Ct. 1967 (1993)	18
<i>Chandris, Inc. v. Latsis</i> , 115 S. Ct. 2172 (1995)	19
<i>Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry</i> , 494 U.S. 558 (1990)	5, 9
<i>Colgrove v. Battin</i> , 413 U.S. 149 (1973)	12
<i>Colonial Ford, Inc. v. Ford Motor Co.</i> , 592 F.2d 1126 (10th Cir.), <i>cert. denied</i> , 444 U.S. 837 (1979)	19
<i>Connally v. General Constr. Co.</i> , 269 U.S. 385 (1939)	20
<i>Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works</i> , 709 F.2d 403 (5th Cir. 1983)	12
<i>Control Components, Inc. v. Valtek, Inc.</i> , 609 F.2d 763 (5th Cir.), <i>cert. denied</i> , 449 U.S. 1022 (1980)	12
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	15
<i>Cox v. Keystone Carbon Co.</i> , 861 F.2d 390 (3d Cir. 1988) . . .	13
<i>Curtis v. Loether</i> , 415 U.S. 189 (1974)	9-10, 18
<i>Dairy Queen, Inc. v. Wood</i> , 369 U.S. 469 (1962)	2, 10, 12
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	5
<i>Edmonson v. Leesville Concrete Co.</i> , 500 U.S. 614 (1991) . . .	4
<i>Gasoline Prods. Co. v. Champlin Ref. Co.</i> , 283 U.S. 494 (1931)	11
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	16
<i>Graco, Inc. v. Binks Mfg. Co.</i> , No. 93-1494, 1995 U.S. App. LEXIS 16520 (Fed. Cir. June 30, 1995)	3

<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	10
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	5, 9, 14
<i>H.H. Robertson Co. v. United Steel Deck, Inc.</i> , 820 F.2d 384 (Fed. Cir. 1987)	6
<i>Hall Lab., Inc. v. Economics Lab., Inc.</i> , 169 F.2d 65 (8th Cir. 1948)	12
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	15
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	15
<i>Hurin v. Electric Vacuum Cleaner Co.</i> , 298 F. 76 (6th Cir. 1924)	12
<i>In re Lewis</i> , 845 F.2d 624 (6th Cir. 1988)	12
<i>James v. Gerber Prods. Co.</i> , 587 F.2d 324 (6th Cir. 1978)	19
<i>Jamesbury Corp. v. Litton Industrial Prods., Inc.</i> , 839 F.2d 1544 (Fed. Cir.), <i>cert. denied</i> , 488 U.S. 828 (1988)	1
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989) . . .	7
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	17
<i>Laitram Corp. v. NEC Corp.</i> , No. 94-1368, 1995 U.S. App. LEXIS 20649 (Fed. Cir. Aug. 4, 1995)	3
<i>Lemelson v. General Mills Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992), <i>cert. denied</i> , 113 S. Ct. 976 (1993)	6, 16
<i>Lindsey v. American Cast Iron Pipe Co.</i> , 810 F.2d 1094 (11th Cir. 1987)	13
<i>Litton Systems, Inc. v. Honeywell, Inc.</i> , Nos. 95-1242, 95-1311 (Fed. Cir.) (pending)	1
<i>Litton Systems, Inc. v. Whirlpool Corp.</i> , 728 F.2d 1423 (Fed. Cir. 1984)	1
<i>Lockhart v. McCree</i> , 476 U.S. 162 (1986)	18

<i>Lytle v. Household Mfg., Inc.</i> , 494 U.S. 545 (1990) . . .	10, 18
<i>Marks v. United States</i> , 430 U.S. 188 (1977)	20
<i>McGill, Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir. 1984)	6
<i>McKnight v. General Motors Corp.</i> , 908 F.2d 104 (7th Cir. 1990), <i>cert. denied</i> , 499 U.S. 919 (1991) . .	12
<i>Medcalf v. Kansas</i> , 626 F. Supp. 1179 (D. Kan. 1986)	19
<i>Miller v. Fairchild Industries, Inc.</i> , 885 F.2d 498 (9th Cir. 1989), <i>cert. denied</i> , 494 U.S. 1056 (1990)	13
<i>Mistretta v. United States</i> , 488 U.S. 361 (1988)	17
<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986) . . .	6
<i>Morgan v. Labiak</i> , 368 F.2d 338 (10th Cir. 1966)	19
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985) . . .	7
<i>Parkland Hosiery Co. v. Shore</i> , 439 U.S. 322 (1979)	4
<i>Parsons v. Bedford</i> , 28 U.S. (3 Pet.) 433 (1830)	2, 11
<i>Perdoni Brothers, Inc. v. Concrete Systems, Inc.</i> , 35 F.3d 1 (1st Cir. 1994)	13
<i>Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	16
<i>Pirkle v. Ogontz Controls Co.</i> , No. 95-45	4
<i>Reed v. Proprietors of Locks & Canals on Merrimac River</i> , 49 U.S. (8 How.) 274 (1850)	16-17
<i>Rexnord, Inc. v. Modern Handling Systems, Inc.</i> , 379 F. Supp. 1190 (D. Del. 1974)	19
<i>Roberts v. Sears, Roebuck & Co.</i> , 723 F.2d 1324 (7th Cir. 1983)	12
<i>Roscello v. Southwest Airlines Co.</i> , 726 F.2d 217 (5th Cir. 1984)	13

<i>Schillner v. H. Vaughan Clarke & Co.</i> , 134 F.2d 875 (2d Cir. 1943)	19
<i>Scott v. Neely</i> , 140 U.S. 106 (1891)	10
<i>Shelley v. Kraemer</i> , 334 U.S. 1 (1948)	17
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1852)	14, 18
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1903)	15
<i>SmithKline Diagnostics, Inc. v. Helena Lab. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988)	7
<i>Song v. Ives Laboratories, Inc.</i> , 957 F.2d 1041 (2d Cir. 1992)	13
<i>Stier v. Smith</i> , 473 F.2d 1205 (5th Cir. 1973)	19
<i>Structural Rubber Prods. Co. v. Park Rubber Co.</i> , 749 F.2d 707 (Fed. Cir. 1984)	7
<i>Sugarman v. Dougall</i> , 413 U.S. 634 (1973)	10
<i>Terry v. Chauffeurs, Teamsters & Helpers, Local 391</i> , 863 F.2d 334 (4th Cir. 1988), <i>aff'd</i> , 494 U.S. 558 (1990)	13
<i>Tidwell v. Fort Howard Corp.</i> , 989 F.2d 406 (10th Cir. 1993)	13
<i>Tights, Inc. v. Acme-McCrary Corp.</i> , 541 F.2d 1047 (4th Cir.), <i>cert. denied</i> , 429 U.S. 980 (1976)	12
<i>Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed. Cir. 1991)	2, 6
<i>Triplett v. Lowell</i> , 297 U.S. 638 (1936)	18
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	2, 14
<i>United States v. Gaudin</i> , No. 94-514, 63 U.S.L.W. 4611 (June 19, 1995)	19
<i>United States v. Telectronics, Inc.</i> , 857 F.2d 778 (Fed. Cir. 1988), <i>cert. denied</i> , 490 U.S. 1046 (1989)	7

<i>United States v. Wonson</i> , 28 F. Cas. 745 (1812) (Story, Circuit Justice)	4
<i>United States Surgical Corp. v. Ethicon, Inc.</i> , No. 94-2081 . . .	4
<i>Wade v. Orange County Sheriff's Office</i> , 844 F.2d 951 (2d Cir. 1988)	13
<i>Walker v. New Mexico Railroad Co.</i> , 165 U.S. 593 (1897) . .	11
<i>Williams v. City of Valdosta</i> , 689 F.2d 964 (11th Cir. 1982)	13
<i>Wilson v. Barnum</i> , 49 U.S. (8 How.) 258 (1850)	15
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	15
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1858)	15

Statutory Provisions

15 U.S.C. § 1221(a)	19
35 U.S.C. § 112	8, 14

Miscellaneous

43 Am. Jur.2d <i>Interference</i> (1968 & 1994 supp.)	17
Advisory Committee Notes to Fed. R. Evid. 201(a)	18
Annot., <i>Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties</i> , 6 A.L.R.4th 195 (1994)	17
Morris Arnold, <i>The Civil Jury in Historical Perspective</i> , in <i>THE AMERICAN CIVIL JURY</i> (1987)	4
Justice Clark, <i>The American Jury: A Justification</i> , 1 VALPARAISO L. REV. 1 (1966)	4
Arthur L. Corbin, <i>CORBIN ON CONTRACTS</i> (1960)	6
Henderson, <i>The Background of the Seventh Amendment</i> , 80 HARV. L. REV. 289 (1966)	4

Judge Patrick Higginbotham, <i>Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power</i> , 56 TEX. L. REV. 47 (1977)	5
Martin B. Louis, <i>Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion</i> , 64 N.C. L. REV. 993 (1986)	11
Restatement (Second) of Contracts (1981)	6
Restatement (Second) of Torts (1979)	17
William C. Robinson, THE LAW OF PATENTS FOR USEFUL INVENTIONS (1890)	16
A.H. Walker, TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA (4th ed. 1904)	16
Samuel Williston, A TREATISE ON THE LAW OF CONTRACTS (3d ed. 1961)	16
Charles Wolfram, <i>The Constitutional History of the Seventh Amendment</i> , 57 MINN. L. REV. 639 (1973) . . .	4
Charles Alan Wright & Arthur R. Miller, FEDERAL PRACTICE & PROCEDURE (1973 & 1995 supp.)	9

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ *amicus curiae* Litton Systems, Inc. ("Litton"), hereby submits this brief in support of the petition for writ of certiorari filed by petitioners Herbert Markman and Positek, Inc. Although Litton has no interest in the outcome of the case at bar, it has a strong and abiding interest in the question presented: the constitutionally guaranteed role of the jury in patent disputes.

This question has wide ramifications and enormous practical importance for many parties. For example, Litton is a technology-based company whose business activities depend heavily on innovation and intellectual property. Accordingly, Litton is sometimes involved in patent litigation.² In availing itself of the protections of the patent system, Litton is entitled to the jury-trial rights granted by the Constitution.

INTRODUCTION AND SUMMARY OF ARGUMENT

In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit has held that "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." Pet. App. 5a.³ Yet as the Federal Circuit stressed, interpreting a patent often requires weighing conflicting "expert and inventor testimony" bearing both on "how those skilled in the art would interpret the claims," 31a (citation omitted), 33a, and on "the state of the prior art at the time of the invention." 33a. The court of appeals admitted that it was "using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language." 36a. The court explained, for example, that the testimony of the inventor himself as to the

¹ Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

² See, e.g., *Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending); *Jamesbury Corp. v. Liton Industrial Prods., Inc.*, 839 F.2d 1544 (Fed. Cir.), cert. denied, 488 U.S. 828 (1988); *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

³ Citations to the Appendix to the Petition for Certiorari are styled "___a."

meaning of his patent was entitled to "little or no probative weight in determining the scope of a claim." 47a-48a. Indeed, the Federal Circuit has previously observed that the interpretation of a patent's scope often requires a factfinder to "give consideration and weight to several underlying factual questions, including . . . the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991).

In the decision below, however, the Federal Circuit designated as issues of "law" matters that are quintessentially *factual* disputes — here, disputes about the scope and meaning, within the legally relevant community, of words of art used to define a patented invention at the time of the patent filing. The result of this holding is that factual issues bearing on patent infringement, previously triable to a jury as of right, will now be decided by a trial judge and then re-decided *de novo* by the Federal Circuit.

But this case is not merely about the role of juries in deciding the scope of patent claims, or even their role in resolving factual disputes regarding "obviousness" and other issues bearing on patent validity. The court of appeals has held that factual issues subsumed or "mixed" in an overall legal question are to be withdrawn from the jury and decided by the court, or, if decided by the jury, may be freely re-examined by a reviewing court. This holding is wholly at odds with the Seventh Amendment. The central lesson of *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 470 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 511 (1959), is that an otherwise applicable right to jury trial cannot be lost simply because issues for the jury are intertwined with issues for the court. See also *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872) ("mixed question[s] of law and fact" relating to patent's scope "must be submitted to the jury"). The Federal Circuit's decision also ignores entirely the second part of the Seventh Amendment, the Re-Examination Clause, which provides that "no fact tried by jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." See *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.).

Accordingly, the significance of the Federal Circuit's decision extends far beyond patent claim construction and even patent law. The decision goes to the fundamental distinction between law and fact and the role of that distinction in the operation of the Seventh Amendment generally. Under the decision below, courts may displace juries and arrogate to themselves the power to resolve factual issues whenever those issues are mixed with or immersed in legal questions. That decision raises square conflicts with the decisions of other courts of appeals and poses grave dangers to the Seventh Amendment, both in patent cases and in many (and perhaps most) other kinds of federal civil litigation.

There could be no better vehicle than this case for deciding the Seventh Amendment question presented. The Federal Circuit has made clear that the case under review is meant to be that court's definitive resolution of the constitutional issue. Eighteen months after the case was argued before a panel of the Federal Circuit — and before any decision had issued — the court took the unusual step of ordering, *sua sponte*, that the case be considered *en banc*. The court formulated four questions relating to the respective roles of judge and jury on which it requested additional briefing from the parties and from *amici*. The Federal Circuit then announced what it believed to be a grand reconciliation of supposedly "inconsistent statements" in its prior decisions "as to whether and to what extent claim construction is a legal or factual issue, or a mixed issue." 21a; see also 30a ("We settle inconsistencies in our precedent . . ."). The particular details of the case under review need not detain this Court.⁴ The constitutional question is cleanly presented, and no procedural obstacles would prevent this Court from deciding it.

⁴ It is immaterial whether the Federal Circuit was required to decide the far-reaching constitutional question in order to dispose of the instant case, or whether it might simply have held that there was no genuine dispute at all on this record. See 81a-82a (Rader, J., concurring in the judgment). The Federal Circuit has announced its conclusive resolution of the Seventh Amendment issue and has adhered to it in its subsequent decisions. See *Lairtram Corp. v. NEC Corp.*, No. 94-1368, 1995 U.S. App. LEXIS 20649, *8 (Fed. Cir. Aug. 4, 1995); *Graco, Inc. v. Binks Mfg. Co.*, No. 93-1494, 1995 U.S. App. LEXIS, *13 (Fed. Cir. June 30, 1995); *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615 (Fed. Cir. 1995). It would be ironic if the breadth of the Federal Circuit's holding could serve to insulate it from this Court's review.

The scope of the constitutionally protected functions of the jury is a question that arises in almost every patent infringement case and, of course, in a vast array of civil litigation outside the patent area. This Court has already granted certiorari to review the question whether the Seventh Amendment requires a jury trial in a declaratory judgment action to have a patent declared invalid. *American Airlines, Inc. v. Lockwood*, No. 94-1660 (petition for certiorari granted June 5, 1995). The practical importance of the issue is further underscored by the fact that additional petitions for certiorari related to the instant case have been filed with this Court: *Pirkle v. Ogontz Controls Co.*, No. 95-45, and *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081.

The need for certiorari is plain.

REASONS FOR GRANTING THE WRIT

This Court has long recognized the pivotal importance of the Seventh Amendment in our constitutional scheme,⁵ a significance illustrated by its central role in the creation of the entire Bill of Rights.⁶ The jury is, in the words of legal historian and Judge Morris Arnold, "the single most important institution in the history of Anglo-American law."⁷ Accordingly, "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a

⁵ E.g., *Edmonson v. Leesville Concrete Co.*, 500 U.S. 614, 624 (1991); *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 338-44 (1979) (Rehnquist, now C.J., dissenting); *United States v. Wonson*, 28 F. Cas. 745, 750 (1812) (Story, Circuit Justice); Justice Clark, *The American Jury: A Justification*, 1 VALPARAISO L. REV. 1, 1-7 (1966).

⁶ See Charles Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 657 (1973) ("the entire issue of a Bill of Rights was precipitated at the Philadelphia Convention by an objection that the document under consideration lacked a specific guarantee of jury trial in civil cases"); Henderson, *The Background of the Seventh Amendment*, 80 HARV. L. REV. 289, 295 (1966) ("The almost complete lack of any Bill of Rights was a principal part of the Anti-Federalist attacks on the Constitution and the lack of provision for civil juries was a prominent part of this argument").

⁷ *The Civil Jury in Historical Perspective*, in THE AMERICAN CIVIL JURY 9-10 (1987).

place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).

Yet the Federal Circuit's decision would jeopardize this constitutional guarantee in a broad category of cases. Judge Newman observed that "[t]his holding not only raises a constitutional issue of grave consequence, but the court creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust." 84a (dissenting opinion). She filed a lengthy opinion exhaustively documenting the logical, historical, and constitutional flaws in the Federal Circuit's decision. See 84a-158a. Judge Mayer, writing separately, predicted that the decision would lead to "turbulence and cynicism in patent litigation." 57a (opinion concurring in the judgment). He warned that the holding "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment of the Constitution of the United States" and "marks a sea change in the course of patent law that is *nothing short of bizarre*." *Id.* (emphasis added).

Indeed, the Federal Circuit's efforts to ensure that it will have the ultimate authority to rule *de novo* on legally linked factual issues, such as issues of claim interpretation, runs afoul of weighty historical tradition: the Seventh Amendment was aimed in significant part at precisely such assertions of judicial power.⁸

More fundamentally, the decision below raises grave implications for the relationship between judge and jury in every area of federal litigation.

⁸ See Judge Patrick Higginbotham, *Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power*, 56 TEX. L. REV. 47, 48-50, 52 (1977) (arguing that the Seventh Amendment originated out of a need for a check on the otherwise unaccountable power of appellate courts and that American courts have a "peculiar need for the democratizing influence of the jury," because an independent judiciary carries with it an "attendant risk of autocratic behavior"); see also *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 82 (1989) (White, J., dissenting); *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 580 (1990) (Brennan, J., concurring in part and concurring in the judgment).

I. THE DECISION BELOW CONFLATES THE DISTINCTION BETWEEN LAW AND FACT AND THREATENS THE ROLE OF THE JURY IN NON-PATENT AS WELL AS PATENT LITIGATION

1. Insofar as the governing substantive law makes a patent's construction turn in part on how a person schooled in the pertinent art would understand a particular term at the time of the invention, the law inescapably compels the resolution of a matter of *fact*.⁹ If there is any genuine dispute as to that matter, its resolution involves the weighing of evidence and the evaluation of credibility. Indeed, although the resulting factual finding goes to the "interpretation" of disputed terms of a document, that interpretation merely informs — it does not inevitably determine — the "construction" of the document's operative legal effect.¹⁰ The latter inquiry remains with the court, but it must be undertaken in accord with the jury's legally relevant, and sometimes decisive, findings of fact. Accordingly, the Federal Circuit has frequently recognized that "interpretation of a

⁹ E.g., *Tol-O-Matic*, 945 F.2d at 1550 (how much support is implied by term "provide for lateral support" in piston assembly); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987) (whether "bottomless trench" design for electrical wiring covered assemblies in which only key portion of the trench was bottomless); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656-57 (Fed. Cir. 1986) (whether term "electrode" included entire length of silver wire, or just tip); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (whether "recovered liquid hydrocarbon absorbent": (1) "means an undefined absorbent that is capable of recovering" liquid hydrocarbon; or (2) "means that the recovered liquid hydrocarbon is being used as an absorbent").

It would deny due process to change the rules of patent construction retroactively so that the actual meaning and scope of technical terms would not depend on the factual issue of how they are understood by one schooled in the relevant art. *Bouie v. City of Columbia*, 378 U.S. 347, 354-55 (1964).

¹⁰ See 3 Arthur L. Corbin, CORBIN ON CONTRACTS § 534 (1960) ("By 'interpretation of language' we determine what ideas that language induces in other persons. By 'construction of the contract,' as that term will be used here, we determine its legal operation — its effect upon the action of courts and administrative officials."); RESTATEMENT (SECOND) OF CONTRACTS § 200 and Comment c (1981) (describing the distinction between "construction" and "interpretation" as reflecting the difference between the "meaning" of a term and its "legal effect"); see also 86a-92a (Newman, J., dissenting).

claim may depend upon evidentiary material about which there is a factual dispute, requiring resolution of factual issues as a basis for interpretation of the claim." *United States v. Teletronics, Inc.*, 857 F.2d 778, 781 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989).¹¹

Even in the decision below, the Federal Circuit observed that the focus of the inquiry was a question of historical fact: "what one of ordinary skill in the art *at the time of the invention* would have understood the term to mean." 48a (emphasis added). The kind of evidence cited by the court is the very kind that, if the subject of a genuine dispute, is normally regarded as peculiarly within the jury's domain: (a) expert testimony, "including evidence of how those skilled in the art would interpret the claims," 31a (citation omitted); (b) the language used in the patent's specification, which is a written description of the invention that is filed with the claim and that must enable one of ordinary skill in the art to make and use the invention, 31a-32a; (c) the history of the patent's prosecution in the Patent and Trademark Office, 32a-33a; and (d) other sorts of extrinsic evidence, such as sales literature and testimony of the inventor,

¹¹ See also *Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992) (although claim construction is issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); *Lemelson v. General Mills Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993) (the "underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement"); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989) ("A disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation. However, without such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court . . .") (citation omitted); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (claim "interpretation may depend . . . on evidentiary material which requires resolution of factual issues, such as what occurred during the prosecution history"); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985) (when the meaning of a claim term is disputed a "factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction."); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 721-22 n.14 (Fed. Cir. 1984) ("claim construction, dependent on resolution of a factual dispute, does present a jury question").

which "may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history." 33a.

To be sure, when a patent is clear, and when the evidence regarding its proper interpretation and construction does not give rise to a genuine factual dispute, the judge may rule on the construction of the claim as a matter of law. And, of course, in the optimal case there should be no ambiguity in claim language.¹² But when these ideals are not met, and when there are disputed factual questions bearing on a federal suit seeking damages for patent infringement, a jury must be called upon to resolve those factual questions — just as in any other area of the law when the underlying right to jury trial is not in doubt.

2. The Federal Circuit rejected that conclusion, as well as the Seventh Amendment principles that compel it. The court asserted that both "the interpretation and construction of patent claims" are "matter[s] of law exclusively for the court." 5a. The Federal Circuit thus held that, by classifying the *ultimate* question of patent claim construction as a "legal issue," it could ensure that any subsidiary factual questions of *interpretation* would be decided by a judge rather than a jury.

This reasoning, however, is both demonstrably fallacious and inherently uncontainable. Even if the construction of a patent's scope is, in the end, a legal issue, it simply does not follow that a judge rather than the jury should decide every issue of disputed fact that arises during the course of claim *interpretation* — or that a judge rather than the jury should have the last word in determining a genuine dispute over what a term or other element of the patent claim in fact *means* in the relevant community. After all, the ultimately legal questions of "negligence" in a tort case or the "reasonableness" of a restraint of trade in an antitrust case do not

¹² The patent statute mandates that specifications "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same" and requires that the specification "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112.

authorize a judge to strip the jury of the power to decide subsidiary issues of fact.

The Federal Circuit's decision ignores a critical difference between (a) the traditional, and wholly Seventh-Amendment-compatible inquiry into what kinds of *lawsuits*, or *legal proceedings*, fall outside the historic category of "suits at common law" to such a degree that no jury trial right attaches, and (b) the entirely novel, and only superficially similar, Seventh-Amendment-incompatible inquiry into what kinds of *factual disputes*, embedded within lawsuits undeniably falling *inside* the historic jury-trial category,¹³ nonetheless appear so "legal" in character that they may be carved out of the jury-trial right that otherwise indisputably applies.

The first inquiry is a familiar one that focuses on the nature of the litigation, including both the cause of action involved and the remedy sought. See *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990); *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989). But the second inquiry is incoherent from start to finish, inasmuch as *every* factual issue that arises in any trial *must* of necessity arise because it has some relevance to — that is, some logical bearing upon — a question of law that in turn governs, or at least contributes to, the resolution of the ultimate dispute.

Even under the first, conventional kind of Seventh Amendment inquiry, this Court has made clear that the right to jury trial on factual issues cannot be lost simply because those issues are submerged in legal or equitable questions to be resolved by a court. Thus, after lower courts had held that the presence of an equitable issue could eliminate the need to try a lawsuit before a jury,¹⁴ this Court intervened to clarify that, when claims for damages are joined with a request for equitable relief, the right to jury trial, "including all issues common to both claims, remains intact." *Curtis v.*

¹³ Judge Newman, in dissent below, ably showed that patent infringement actions were tried before a jury at common law, 118a-129a, a conclusion that the majority did not dispute. 44a.

¹⁴ E.g., 9 Charles Alan Wright & Arthur R. Miller, *FEDERAL PRACTICE & PROCEDURE* § 2302.1 (1973 & 1995 supp.).

Loether, 415 U.S. 189, 196 n.11 (1974) (discussing *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959)).¹⁵

Just as lower courts, pre-*Beacon Theatres*, had erroneously held that a "dash of equity" could extinguish the right to jury trial, so the Federal Circuit has incorrectly held that the presence of a legal question, suitably mixed with the facts in dispute, could do the same. This error is even more egregious than that which led this Court to issue its course correction in *Beacon Theatres*, for "it would hardly take extraordinary ingenuity for a lawyer to find" questions of law mixed with questions of fact "at every turn in the road." *Sugarman v. Dougall*, 413 U.S. 634, 657 (1973) (Rehnquist, now C.J., dissenting) (discussing "insular and discrete" minorities). Thus, the Federal Circuit committed a truly fundamental error by failing to recognize that, whatever might be true of the line between "law" and "equity," legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right whenever the controversy in which the dispute arises is jury-triable under the Seventh Amendment — regardless of how the facts fit into, or "mix" with, the legal matrix of the overall controversy.

3. Because the Federal Circuit's error was so basic, the constitutional issue presented by this case cannot be restricted to claim construction,¹⁶ or even to patent litigation. The Federal Circuit's novel and philosophically misguided approach to the

¹⁵ This Court decisively rejected any suggestion that "the right to jury trial may be lost" as to issues that might be characterized as "incidental" to matters decided by the court. *Dairy Queen*, 369 U.S. at 470. "[N]or can [the right to jury trial] be impaired by any blending" of jury and non-jury issues. *Scott v. Neely*, 140 U.S. 106, 110 (1891). Noting "the flexible procedures of the Federal Rules [of Civil Procedure]," *Beacon Theatres*, 359 U.S. at 511, this Court instructed the lower federal courts *first* to impanel a jury to resolve the issues within its domain, and *then* to decide the remaining questions consistent with the jury's verdict. *E.g.*, *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 550-51 (1990).

¹⁶ In *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), for example, this Court explained that "the ultimate question" of whether a patent is valid as "nonobvious" is "one of law," even though there are underlying "factual inquiries" to be made by a jury.

law/fact distinction has profound implications for non-patent cases as well. Under the Federal Circuit's view, courts could always withdraw a subsidiary factual issue from the jury on the ground that the fact was simply a constituent element of a broader legal question. As one scholar has commented, transforming issues of "fact" into "law" is "drastic in that it amounts to a direct judicial assault on the prerogatives of fact finders."¹⁷ The "classification of ultimate facts as questions of law amounts to a manipulation of the law-fact doctrine to take questions from the jury or to subject the trial level's resolution of questions to free appellate review."¹⁸

By holding that the submersion of a factual issue in an ultimately legal question gives a court the authority to decide the factual issue itself, without submitting it to a jury, the Federal Circuit would utterly eviscerate the first clause of the Seventh Amendment. Yet this Court has made clear that the Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico Railroad Co.*, 165 U.S. 593, 596 (1897); *see also Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 498 (1931).

In addition, the Federal Circuit's approach would separately violate the second clause of the Seventh Amendment in cases where a jury has already decided disputed factual issues, such as the meaning that the relevant community would assign to an ambiguous patent claim term. The Federal Circuit held that such a determination would amount to a ruling on "a matter of law," to be re-examined freely by a district court and "reviewed *de novo* on appeal." 30a. But the Re-Examination Clause, which this Court has long understood to be a "substantial and independent clause" that is in fact "more important" than the preceding portion of the Amendment, *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.), "not only preserves th[e jury trial] right but discloses a

¹⁷ Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 1018 (1986).

¹⁸ *Id.* at 1028.

studied purpose to protect it from *indirect impairment* through possible enlargements of the power of reexamination existing under the common law." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935) (emphasis added); see also *Colgrove v. Battin*, 413 U.S. 149, 155 n.6 (1973).

Accordingly, the Federal Circuit's decision flouts *both* clauses of the Seventh Amendment.

4. Not surprisingly, the decision below is also in square conflict with cases in other courts of appeals. The ruling conflicts with pre-Federal Circuit decisions of the regional courts of appeals holding that the "proper meaning" of a disputed patent term is "a factual issue to be determined by the jury."¹⁹ Moreover, the Federal Circuit's decision cannot be reconciled with many cases in the other courts of appeals properly applying this Court's decisions in *Dairy Queen* and *Beacon Theatres* and recognizing that the immersion of subsidiary facts in a legal question does not give a court the power to usurp the role of the jury.²⁰

¹⁹ *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980); see also *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047, 1060 (4th Cir.) (in context of obviousness, "if an issue presents a mixed question of fact and law, it may be submitted if the jury is instructed as to the legal standard to be applied"), *cert. denied*, 429 U.S. 980 (1976); *Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works*, 709 F.2d 403, 406 (5th Cir. 1983) ("We perceive no meaning to be assigned to these words [in the patent] as a matter of law. Rather, the interpretation of the phrase . . . was properly a jury determination"); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("In case of a controversy as to the construction of a patent claim, it may usually be true . . . that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved."); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1338 (7th Cir. 1983) ("a factual dispute as to the meaning of a term of art used in the patent claim, the resolution of which required resort to expert testimony, properly would have been submitted to the jury"); *Hall Lab., Inc. v. Economics Lab., Inc.*, 169 F.2d 65, 66-67 (8th Cir. 1948) ("[T]he construction of patent claims where extrinsic evidence is required to determine the meaning of technical terms also involves questions of fact.").

²⁰ "[T]he legal claim . . . must be tried first before a jury and the equitable claim resolved subsequently in light of the jury's determination of the legal claim." *In re Lewis*, 845 F.2d 624, 629 (6th Cir. 1988). "[I]n a dual bench-jury trial the jury's verdict binds the judge with respect to any factual issues common to the jury-and judge-tried claims." *McKnight v. General Motors Corp.*, 908 F.2d 104,

The Federal Circuit's exclusive jurisdiction over patent appeals from district courts means, under the decision below, that the Federal Circuit will demand judicial trials of factual issues, as well as *de novo* judicial re-examination of facts found by juries, wherever the facts (or factual issues) bear directly on legal questions like claim construction, obviousness, or other aspects of patent validity — *even within circuits having controlling precedent to the contrary*, forcing district courts within these circuits into the Catch-22 of either violating the circuit law on which they are bound on all such procedural matters, or flouting the directive of the Federal Circuit under *Markman*. Yet the Federal Circuit itself has recognized that the same procedures should apply in patent cases as in other civil actions. See, e.g., *Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1563 (Fed. Cir.), *cert. denied*, 488 U.S. 850 (1988). The decision below not only violates that rule but puts district courts throughout the Nation in a wholly untenable position.

5. Although the constitutional dimensions of the right to jury trial are not matters falling within the special expertise of the Federal Circuit, this hardly gives that court license to ignore them. There is no special Seventh Amendment rule for patent cases. Indeed, the Federal Circuit's decision is in square conflict with decisions of this Court, which have long recognized that underlying factual disputes regarding the construction of a patent claim are to

113 (7th Cir. 1990), *cert. denied*, 499 U.S. 919 (1991); see also *Bouchet v. National Urban League, Inc.*, 730 F.2d 799, 803-04 (D.C. Cir. 1984) (Scalia, J.); *Perdoni Brothers, Inc. v. Concrete Systems, Inc.*, 35 F.3d 1, 5 (1st Cir. 1994); *Song v. Ives Laboratories, Inc.*, 957 F.2d 1041, 1048 (2d Cir. 1992); *Wade v. Orange County Sheriff's Office*, 844 F.2d 951, 954 (2d Cir. 1988); *Cox v. Keystone Carbon Co.*, 861 F.2d 390, 394 (3d Cir. 1988); *Terry v. Chauffeurs, Teamsters & Helpers, Local 391*, 863 F.2d 334, 336, 338 (4th Cir. 1988), *aff'd*, 494 U.S. 558 (1990); *Roscello v. Southwest Airlines Co.*, 726 F.2d 217, 221 (5th Cir. 1984); *Brownlee v. Yellow Freight System, Inc.*, 921 F.2d 745, 749 (8th Cir. 1990); *Miller v. Fairchild Industries, Inc.*, 885 F.2d 498, 507 (9th Cir. 1989), *cert. denied*, 494 U.S. 1056 (1990); *Calnetics Corp. v. Volkswagen of America, Inc.*, 532 F.2d 674, 690 & n.26 (9th Cir.) (*per curiam*), *cert. denied*, 429 U.S. 940 (1976); *Tidwell v. Fort Howard Corp.*, 989 F.2d 406, 412 (10th Cir. 1993); *Lindsey v. American Cast Iron Pipe Co.*, 810 F.2d 1094, 1098 (11th Cir. 1987); *Williams v. City of Valdosta*, 689 F.2d 964, 976 (11th Cir. 1982).

be resolved by a jury where it is the trier of fact. *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), for example, involved an appeal from a jury trial regarding a patent for an improvement in regulating the draft of stoves. The trial court determined that the patent covered "a combination of such of the described parts as were combined and arranged for producing a particular effect, viz., to regulate the heat of the stove." *Id.* at 225. But this legal construction of the patent claim still left some factual dispute as to the meaning of the patent's terms: what parts were necessary to regulate the heat of a stove? Accordingly, the trial court left to the jury the initial question of precisely which parts were covered by the claim as construed by the court. The defendants objected, "desir[ing] the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination." *Id.* But this Court rejected that challenge: "How could the Judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* at 226. This Court concluded that the trial court properly "left nothing but matter[s] of fact to the jury." *Id.* at 225.²¹

Similarly, in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), this Court held that a prior patent and related expert testimony on the issue of "diversity or identity" were improperly withheld from the jury, and described the issue as a "mixed question of law and fact" that "must be submitted to the jury, if there is so much

²¹ The Federal Circuit maintained (at 54a) that *Silsby* is no longer good law, in the wake of 35 U.S.C. § 112, which requires patentees to set out specifications of their claims. See note 12, *supra*. But the statute represented less of a change than the court thought, since even the first Patent Act, in 1790, required that letters patent "describ[e] the said invention or discovery, clearly, truly, and fully." See 74a-75a (Mayer, J., concurring in the judgment); 131a-135a (Newman, J., dissenting). Moreover, the majority's logic is a *non sequitur*. Even if the adoption of Section 112 reduced the incidence of genuine factual disputes of the kind that arose in *Silsby*, it would not alter the fact that, when such disputes occur, they must be resolved by the jury. See *Granfinanciera*, 492 U.S. at 51 (even Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury").

resemblance as raises the question at all." *Id.* at 455. "[T]he ultimate response to the question must come from the jury." *Id.* (emphasis added). In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the trial court "construed" the claim in a general manner and left it for the jury to fill in the specifics. This Court affirmed the trial court's refusal to define the patent claim in its entirety, explaining that "where the whole substance of the invention may be copied in a different form, it is the duty of the courts and juries to look through the form for the substance of the invention — for that which entitled the inventor to his patent, and which the patent was designed to secure." *Id.* at 343 (emphasis added).²²

Only when interpretation of the patent claims presents no factual question has this Court construed them as a matter of law.²³ A noted commentator explained that, "[w]hen the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into

²² See also *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895) (holding that there was legal error in the trial judge's description of the invention to the jury and remanding for a new trial to the jury, but declining to give a peremptory instruction to the jury, on the ground that all of the differences are "the subject of legitimate consideration by the jury"); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814 (1870) (the meaning of disputed terms of art is "a question of fact for the jury"); *Wilson v. Barnum*, 49 U.S. (8 How.) 258, 261-62 (1850) (because disputes as to claim interpretation presented a question of fact, the Court had no jurisdiction to review an interlocutory appeal).

²³ See, e.g., *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1903) ("it is apparent from the face of the instrument that extrinsic evidence is not needed"); *Heald v. Rice*, 104 U.S. 737, 749 (1881) ("if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art . . . then the question of identity is one of pure construction, and not of evidence"); *Brown v. Piper*, 91 U.S. 37, 41, 44 (1875) (although evidence had been taken at trial, "[w]e think the patent was void on its face, and that the court might have stopped short at that instrument"); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858) (there was only one construction of the patent "which the language of this specification will admit"); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848) ("without the aid of experts and machinists, [we have] no difficulty in ascertaining, from the language used here, the meaning of the patent).

and becomes an element in the interpretation of the Claim."²⁴

II. THE SEVENTH AMENDMENT CANNOT BE CIRCUMVENTED BY RESORTING TO A SUPPOSED ANALOGY BETWEEN PATENTS AND STATUTES

The principal basis of the Federal Circuit's decision was an ill-considered analogy between patents and statutes. 51a-52a. The court's reasoning was fatally flawed.

1. The courts have long viewed patents as analogous not to statutes, but to contracts²⁵ or privately written deeds to property.²⁶ Any factual disputes bearing on ambiguities in these written instruments are resolved by the jury, not the court.²⁷

²⁴ 3 William C. Robinson, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 1037 (1890) (emphasis added) (hereafter "ROBINSON ON PATENTS"); see also A.H. Walker, TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 536 (4th ed. 1904) ("Where the question of infringement depends on the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left for the jury; and the dependent question of infringement should also be left for the jury to decide.").

²⁵ See, e.g., *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (noting, in discussing construction of a patent, that "[t]he understanding of a party to a contract has always been regarded as of some importance in its interpretation"); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993) ("While there may be underlying fact questions involved, the ultimate conclusion about the meaning and scope of a claim is, like contract interpretation, a question of law") (emphasis added); 1 ROBINSON ON PATENTS at §§ 15, 20 (explaining the longstanding analogy between patents and contracts, which originated in England in 1800 and was adopted in this country in 1831).

²⁶ See, e.g., *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

²⁷ See, e.g., Samuel Williston, A TREATISE ON THE LAW OF CONTRACTS § 616, at 649, 652 (3d ed. 1961) ("The general rule is that interpretation of a writing is for the court. . . . Where, however, the meaning of a writing is uncertain or ambiguous, and parol evidence is introduced in aid of its interpretation, the question of its meaning should be left to the jury"); see also *Reed v. Proprietors*

In many respects, a patent resembles a contract between the inventor and the government. In return for full disclosure of the invention, the government grants the patentee a restricted monopoly for a period of time. The sort of extrinsic evidence used in interpreting contracts is the same kind of evidence used in interpreting patent claims: custom and usage of the trade and course of dealing between the parties (akin to prior art), level of skill in the art, and events in the Patent and Trademark Office.

Alternatively, a patent may be thought of as a form of deed which sets out the metes and bounds of the property the inventor owns for the term and puts the world on notice to avoid trespass or to enable one to purchase all or part of the property right it represents.

2. The analogy between patents and statutes, in contrast, is a wholly inapt one. Patents are not "baby statutes," 80a n.8 (Mayer, J., concurring in the judgment), and the Patent and Trademark Office is not some "sort of junior-varsity Congress." *Mistretta v. United States*, 488 U.S. 361, 427 (1988) (Scalia, J., dissenting). For example, although a legislature is open and accountable to all, see, e.g., *Bi-Metallic Inv. Co. v. State Bd. of Equalization*, 239 U.S. 441, 445-46 (1915), the patent process is essentially private. "As patents are procured ex parte, the public is not bound by them" *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877).

The Federal Circuit observed that patents are usually "enforceable against the public." 51a. But, of course, so are property rights and private contracts.²⁸ Moreover, the enforceability

of *Locks & Canals on Merrimac River*, 49 U.S. (8 How.) 274, 289 (1850) (allowing jury to interpret vague or ambiguous deed, where "it necessarily becomes a fact for the jury to decide, whether the land in controversy is included therein").

²⁸ For example, almost all States recognize that third parties may not tortiously interfere in a private contractual relationship. See RESTATEMENT (SECOND) OF TORTS § 766 (1979); 43 Am. Jur.2d *Interference* §§ 12, 23, 29, 30, 31, 40, 57 (1968 & 1994 supp.); Annot., *Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties*, 6 A.L.R.4th 195 (1994). In addition, the Federal Circuit's attempt to distinguish contract enforcement as an essentially "private" activity is unsustainable in light of the last half-century of state action doctrine. See, e.g., *Barrows v. Jackson*, 346 U.S. 249,

of patent claim interpretations against third parties is dictated by rules of claim and issue preclusion, not by the nature of a patent.²⁹

3. The process of interpreting a patent's scope, when the issue is what the relevant community at the time of the patent's issuance would understand a particular term to mean, involves weighing evidence and evaluating credibility bearing on "what ideas [the patent's] language induces in other persons." 88a (Newman, J., dissenting) (internal quotation marks omitted). This interpretive inquiry most closely resembles the process of finding ordinary adjudicative facts, not of deciding legal questions, construing statutes, or even resolving matters of so-called "legislative fact." See *Lockhart v. McCree*, 476 U.S. 162, 168 n.3 (1986); Advisory Committee Notes to Fed. R. Evid. 201(a).

Indeed, how a particular term was understood in the relevant community at a given point in time is *precisely* the kind of adjudicative fact that, when legally relevant, is routinely submitted to a jury for resolution by empirical inquiry, *even in the statutory context*. It is simply incoherent to treat that question as though it involved a resolution, either *a priori* or as a matter of legal principle, of the effect that *ought* to be given to a particular written instrument. Thus, the Federal Circuit's argument would be flawed at its core even if patents *were* closely analogous to statutes.

Consider, for example, a federal statute analogous to the patent at issue in *Silsby v. Foote* — that is, a federal statute that created a civil cause of action for persons injured by defects in parts of stoves shipped in interstate commerce if those parts are "necessary to regulate the heat of the stove." A defendant in such a case would be entitled to have a jury consider the defense that the particular element of the stove that had injured the plaintiff was *not* one that was "necessary to regulate the heat of the stove," so long as there was a genuine factual dispute over the matter. See *Lytle*, 494 U.S. at 550; *Curtis v. Loether*, 415 U.S. at 196 n.11.

254 (1953); *Shelley v. Kraemer*, 334 U.S. 1, 19-20 (1948).

²⁹ Under *Triplett v. Lowell*, 297 U.S. 638 (1936), patent validity could be relitigated in successive actions. It was only this Court's decision in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971), that altered the rule of mutuality of estoppel. See *Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967, 1977 (1993).

The example is not merely hypothetical. This Court recently held, unanimously, that the securities laws require a jury to determine whether a given statement was "material" within the meaning of relevant statutes, on the ground that this is "a 'mixed question of law and fact' [that] has typically been resolved by juries." *United States v. Gaudin*, No. 94-514, 63 U.S.L.W. 4611 (June 19, 1995).³⁰ This Court has also held that "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995). Other federal statutes operate in similar fashion.³¹

With respect to patents as with respect to some (but not all) statutes, the pre-existing substantive law, ultimately under the control of Congress, makes the interpretation of the terms of art employed in the instrument turn on what those schooled in the relevant fields would take those terms to mean at a given time. To the degree that the construction of a statute is instead deemed, as a matter of law, to be independent of the probable or actual understanding of those governed by it, this separation of legal construction from factual interpretation must, not only as a matter

³⁰ See also *Schillner v. H. Vaughan Clarke & Co.*, 134 F.2d 875, 878 (2d Cir. 1943); *Stier v. Smith*, 473 F.2d 1205, 1208 n.9 (5th Cir. 1973); *James v. Gerber Prods. Co.*, 587 F.2d 324, 327 (6th Cir. 1978).

³¹ A federal statute requires juries to determine whether an entity "acts for" an automobile manufacturer or is "under [its] control" — and thus is subject to liability under 15 U.S.C. § 1221(a) in suits by dealers. See, e.g., *Colonial Ford, Inc. v. Ford Motor Co.*, 592 F.2d 1126, 1129 & n.3 (10th Cir.), *cert. denied*, 444 U.S. 837 (1979). Copyright law vests the jury with authority to determine "substantial and material similarity" and other mixed questions of fact and law in infringement actions. See, e.g., *Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190, 1196 (D. Del. 1974); *Blunt v. Patten*, F. Cas. No. 1579 (C.C.N.Y. 1828). Suits under the civil rights statutes involve a host of factual determinations submerged within legal questions as well. See, e.g., *Brisk v. Miami Beach*, 726 F. Supp. 1305, 1306 n.3 & 1309 (S.D. Fla. 1989) (application of qualified immunity in Fourth Amendment § 1983 case is a mixed question of law and fact that should be submitted to a jury); *Medcalf v. Kansas*, 626 F. Supp. 1179, 1188 (D. Kan. 1986) (whether failures of training and supervision amounted to gross negligence was a question of fact to be decided by jury in § 1983 case); *Morgan v. Labiak*, 368 F.2d 338, 340 (10th Cir. 1966) (reasonableness of force used by police officer is a question of fact for the jury).

of common sense but indeed as a matter of fundamental fairness and due process, be derived from a pre-existing substantive rule of construction that is clear enough to give fair warning to all those who might be held legally accountable for assuming the contrary. See *Marks v. United States*, 430 U.S. 188, 191 (1977); *Connally v. General Constr. Co.*, 269 U.S. 385, 391 (1939). Accordingly, the frequent irrelevance of adjudicative factfinding in statutory construction is a function not of anything magical about statutes that those instruments might have in common with patents, but rather of pre-existing rules of construction informing the world that statutes will not always be taken to mean what their addressees suppose — rules that have no counterpart in patent construction and rules that no federal court would have constitutional authority to promulgate. Even if a patent could properly be analogized to a statute, therefore, interpretation of a patent's meaning and scope in the course of a damage suit for patent infringement would necessarily remain a matter for a jury to decide.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

FREDERICK A. LORIG
BRIGHT & LORIG
633 West 5th Street
Los Angeles, CA 90274
(213) 627-7774

JOHN E. PRESTON
VICTORIA T. McGee
Litton Industries
21240 Burbank Blvd.
Woodland Hills, CA 93167

LAURENCE H. TRIBE
Counsel of Record
JONATHAN S. MASSEY
KENNETH J. CHESEBRO
1575 Massachusetts Avenue
Hauser Hall 420
Cambridge, MA 02138
(617) 495-4621

Counsel for Amicus Curiae

August 7, 1995

(7)
No. 95-26

Supreme Court, U.S.
FILED

NOV 9 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

JOINT APPENDIX - VOLUME I

WILLIAM B. MALLIN*
LEWIS F. GOULD, JR.
TIMOTHY P. RYAN
STEPHAN P. GRIBOK
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
Telephone: (412) 566-6000
Attorneys for Petitioners

FRANK H. GRIFFIN, III*
PETER A. VOGT
POLLY M. SHAFFER
GOLLATZ, GRIFFIN & EWING
Two Penn Center Plaza
Sixteenth Floor
Philadelphia, PA 19102
Telephone: (215) 563-9400
Attorneys for Respondents

*Counsel of Record

PETITION FOR CERTIORARI FILED JULY 3, 1995
CERTIORARI GRANTED SEPTEMBER 27, 1995

BEST AVAILABLE COPY

296 PO

TABLE OF CONTENTS

Page

VOLUME I

Docket Entries	1
District Court for the Eastern District of Pennsylvania, No. 91-CV-940	1
United States Court of Appeals for the Federal Circuit, No. 92-1049	5
Trial Transcript	8
Jury Question/Verdict	282
Defendant Westview Instruments, Inc.'s Supplemental Requested Interrogatories to the Jury	284
Defendant Westview Instruments, Inc.'s Supplemental Requested Instruction	286
Motion of Defendant Westview Instruments, Inc. for Directed Verdict Pursuant to Rule 50 of the Federal Rules of Civil Procedure	290
Order Dated September 20, 1991, Entered September 23, 1991, Not Vacating Order of September 17, 1991 Denying Defendants' Motion for Summary Judgment	292

VOLUME II

United States Patent No. Re. 33,054	293
Respondent Westview Instruments, Inc.'s Advertising Brochure for Datascan	302
Respondent Westview Instruments, Inc.'s Advertising Brochure for Datamark	304
Respondent Westview Instruments, Inc.'s Equipment Price List for Datamark and Datascan dated December 1989	306
Respondent Westview Instruments, Inc.'s Equipment Price List for Datamark and Datascan dated July 1, 1985	307
Excerpt of File Wrapper of United States Patent Re. No. 33,054	308

The following opinions, orders, judgments and memorandum have been omitted in printing this Joint Appendix because they appear on the following pages in the Appendix to the printed Petition for Writ of Certiorari:

Opinions of United States Court of Appeals for the Federal Circuit, filed April 5, 1995	1a
Judgment, United States Court of Appeals for the Federal Circuit, filed April 5, 1995	160a

Order, Ordering, <i>sua sponte</i> , that the Appeal be heard <i>en banc</i> , filed November 5, 1993	162a
Order Providing for Additional Briefing and Other Matters for Rehearing <i>en banc</i> , filed January 7, 1994	164a
Judgment of United States District Court for the Eastern District of Pennsylvania in Favor of Defendants and Against Plaintiffs, filed October 1, 1991	168a
Order of United States District Court for the Eastern District of Pennsylvania in Favor of Defendants and Against Plaintiffs, filed September 30, 1991	169a
Memorandum of United States District Court for the Eastern District of Pennsylvania Granting Motion for Directed Verdict, filed September 30, 1991	170a

CIVIL ACTION DOCKET
CLERK OF COURT

U.S. DISTRICT COURT FOR THE
EASTERN DISTRICT OF PENNSYLVANIA

JUDGE
HON. MARVIN KATZ

FILE DATE	CASE-ID
12/10/91	91-CV-940

PLAINTIFF/ATTORNEY
HERBERT MARKMAN, ET AL
MALLIN, WILLIAM B.

DEFENDANT/ATTORNEY
WESTVIEW INSTRUMENTS, INC., ET AL
GRIFFIN, III, FRANK H.

DATE	*** PROGRESS IN CASE ***
2/12/91	Complaint. filing fee \$ 120 receipt #335061 (kv)
3/22/91	Answer to complaint and crossclaim by DEFENDANT ALTHON ENTERPRISES against WESTVIEW INSTRUMENTS (td)

5/1/91 Answer to Complaint and Counterclaim by
DEFENDANT WESTVIEW
INSTRUMENTS, INC. (jmp) [Entry date
05/02/91]

6/7/91 Answer by HERBERT MARKMAN,
POSITEK, INC. to counterclaim of deft
Westview Instruments, Inc. (td)

8/29/91 MOTION BY DEFENDANT WESTVIEW
INSTRUMENTS, INC. FOR SUMMARY
JUDGMENT, MEMORANDUM,
CERTIFICATE OF SERVICE. (td) [Entry
date 08/30/91]

9/3/91 Amended answer to complaint by
DEFENDANT WESTVIEW
INSTRUMENTS, INC. with counterclaim
against plffs'. (td) [Entry date 09/05/91]

9/18/91 ORDER THAT THE [36-1] MOTION FOR
SUMMARY JUDGMENT IS DENIED
(SIGNED BY JUDGE MARVIN KATZ)
09/18/91 ENTERED AND COPIES
MAILED. (td)

9/20/91 Request for Interrogatories to jury by
PLAINTIFF HERBERT MARKMAN,
PLAINTIFF POSITEK, INC. (td)

9/20/91 Requested Jury instructions by PLAINTIFF
HERBERT MARKMAN, PLAINTIFF
POSITEK, INC. (td)

9/20/91 ORDER THAT THIS COURT'S ORDER
DATED 9/17/91 DENYING WESTVIEW'S
MOTION FOR SUMMARY JUDGMENT BE
AND HEREBY IS NOT VACATED.
THERE IS A GENUINE ISSUE OF
MATERIAL FACT AS TO WHETHER
DEFT'S PRODUCT STORES IN MEMORY
INDIVIDUAL ARTICLES, ETC. (SIGNED
BY JUDGE MARVIN KATZ) 09/23/91
ENTERED AND COPIES MAILED. (td)
[Entry date 09/23/91]

9/23/91 Supplemental Pretrial Memorandum of deft
Westview Instruments, Inc. (td) [Entry date
09/24/91]

9/27/91 Minute entry: Trial resumes 9/26/91. Ruling:
Infringement issue to be given to the jury
first. Deft's motion for directed verdict -
DEFERRED. (td) [Entry date 09/30/91]

9/30/91 MOTION BY DEFENDANT WESTVIEW
INSTRUMENTS, INC. FOR DIRECTED
VERDICT PURSUANT TO RULE 50 OF
THE F.R.C.P., MEMORANDUM. (td)

9/30/91 Memorandum of law by DEFENDANT
WESTVIEW INSTRUMENTS, INC.

concerning construction of claim language.
(td)

9/30/91 Questions to jurors and answers thereof. (td)
[Entry date 10/01/91]

9/30/91 MEMORANDUM AND ORDER THAT
THE MOTION FOR A DIRECTED
VERDICT IS GRANTED (SIGNED BY
JUDGE MARVIN KATZ) 10/01/91
ENTERED AND COPIES MAILED. (td)
[Entry date 10/01/91]

10/1/91 ORDER THAT JUDGMENT IS ENTERED
IN FAVOR OF DEFTS AND AGAINST
PLFFS (SIGNED BY JUDGE MARVIN
KATZ) 10/02/91 ENTERED AND COPIES
MAILED. (td) [Entry date 10/02/91]

10/25/91 Notice of appeal to the USCA FOR THE
FEDERAL CIRCUIT by PLAINTIFF
HERBERT MARKMAN, PLAINTIFF
POSITEK, INC., Fee Status: \$105.00, Copies
to JUDGE MARVIN KATZ , Clerk USCA,
Appeals Clerk, and PETER A. DUNN,
PETER A. VOGT, FRANK H. GRIFFIN,
JOHN C. DORFMAN, TERRY D. JACK C.
GOLDSTEIN, PATRICK J. HAGAN,
TIMOTHY P. RYAN, WILLIAM B.
MALLIN, LEWIS F. GOULD JR. (dt) [Entry
date 10/29/91]
[Edit date 10/29/91]

10/25/91 Copy of Clerk's notice to USCA For the
FEDERAL CIRCUIT re: [100-1] appeal (dt)
[Entry date 10/29/91]
[Edit date 10/29/91]

11/6/91 Notice of Docketing ROA from the USCA for
the Federal Circuit Re: [100-1] appeal.
USCA FEDERAL CIRCUIT NUMBER: 92-
1049. 11/04/91 (td) [Entry date 11/07/91]
[Edit date 11/07/91]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
DOCKET FOR APPEAL 92-1049
AS OF 10/04/95

October 25, 1991 Notice of appeal filed by plaintiffs in the district court. (lp)

Jan. 3, 1992 BRIEF FOR THE APPELLANT, filed. (MS-1/3/92) (cr)

Feb. 18, 1992 BREIF [sic] FOR THE APPELLEE, filed. (MS-2/18/92) (cr)

Mar. 9, 1992 REPLY BRIEF FOR THE APPELLANT, filed. (MS-3/9/92) (cr)

Mar. 16, 1992 JOINT APPENDIX (Vols-I-II 12 copies each filed. (MS-3/16/92) (cr)

May 7, 1992 ARGUED. (Nies, CJ, Rich and Archer, JJ). (tth)

January 7, 1994 ORDER: Additional briefing by parties & amici may be filed as follows: Briefs for appellants on rehearing in banc due February 1, 1994; briefs for appellees due March 14, 1994. Court is particularly interested in briefing on ... see order for language... Amicus briefs on rehearing in banc may be filed in

accordance with Rule 29. Oral argument will be scheduled after briefs have been filed. Briefs shall be filed in 30 copies. [by Clerk] (df)

Feb. 14, 1994 BRIEF FOR APPELLANTS, (Harbert Markin [sic] and Positek, Inc.) filed. (MS-2/14/94) (cr)

Mar. 14, 1994 SUPPLEMENTAL BRIEF FOR APPELLEES, (Westview Instruments Inc.) filed. (MS-3/14/94) (cr)

May 4, 1994 Submitted after ORAL ARGUMENT
92-1049 by William B. Mallin and Frank H.
(df) Griffin, III
[IN BANC]
(ARCHER, RICH, NIES, NEWMAN, MAYER, MICHEL, PLAGER, LOURIE, CLEVINGER, RADER & SCHALL)

April 5, 1995 AFFIRMED. (ARCHER, CHIEF JUDGE) "JUDGMENT ENTERED" (pjt) OPINION FOR THE COURT FILED BY CHIEF JUDGE ARCHER, IN WHICH CIRCUIT JUDGES RICH, NIES, MICHEL, PLAGER, LOURIE, CLEVINGER and SCHALL JOIN. CONCURRING OPINIONS FILED BY CIRCUIT JUDGES MAYER and RADER

DISSENTING OPINION FILED BY
CIRCUIT JUDGE NEWMAN. (pjt)
52 F3d 967

April 26, 1995

ISSUED AS A MANDATE TO THE
US DCT ED/PA. (1p)

PETITION FOR WRIT OF
CERTIORARI FILED 07/03/95.
SUPREME COURT No. 95-0026.
U.S.L.W.: 94-3068 (EOD 08/18/95
BY JA) 92-1049

* * *

Trial Testimony of September 25, 1991 -- Volume I

* * *

[40]JOHN MIKULA, PLAINTIFF'S WITNESS, SWORN
DIRECT EXAMINATION

BY MR. MALLIN:

Q Would you state your name, please?

A My name is John Mikula.

Q Where do you live?

A I live at 1520 Lexington krive [sic] in Dresher,
Pennsylvania.

Q What is your profession?

A I'm a computer consultant.

Q What is your educational background?

[41] A I received a Bachelor's degree in electrical
engineering from the University of Pennsylvania in 1965. I
graduated with honors, belonged to civil engineer honor
societies. I received a Master's degree in electrical
engineering from the University of Pennsylvania in 1967 and

a Master's degree from Penn State University in engineering science.

Q For the record, what is electrical engineering? What is the study of electrical engineering?

A Electrical engineering has evolved over time and whereas when I was in school it was the study of vacuum tubes and electronics using transistors, today it's more a study of computer architecture.

Q Would you tell the jury a brief resume of your work experience after you graduated?

A After I graduated, I first worked for Eastman Kodak in Rochester, New York on classified Government projects but having to do with data reduction, mathematical analyses and general data processing type areas. After that I worked for a company called Kentron Hawaii, Limited in Honolulu and we tracked missile test flights in the middle of the Pacific. My job was data reduction, doing mathematical analyses and defining performance of computer programs, working with programmers to define data processing systems. After that I worked with American Electronics Laboratories in Colmer(ph), Pennsylvania doing defense related work and having to do with computer programming, things like tracking aircraft for the American Military, direction finding systems based on airplanes looking for enemy receivers and thing [sic] like that.

During that time while I was with American Electronic Laboratories, microprocessors were just coming into

existence and at that time as a young engineer, I was very excited about microprocessors were a way of shrinking down big, expensive computer systems into a tiny chip. It was a brand new field. The expansiveness of the field was apparent and I wanted very much to get into that. Working as I was on defense contracts which tend to trail the state of the art in developments of new computers, new hardware, I went with a small company and the sole goal of that company was to develop systems based on microprocessors. They were system developers. Developers were people who had products they needed and wanted to sell so we were a general system developer. We did the electronics. I personally did the programming of the microprocessors to make it meet with whatever system needs a customer had.

After that in approximately 1981, I joined the company I'm with now which is called Matrix Graphics and the purpose of that company had to do with using bar codes another new technology just coming into popularity at that time and we were involved for the entire duration in the printing of bar codes using different kinds of printers and [43] for the last several years in projects using the scanning of bar codes to make bar codes do useful work for people.

Q I think by now people know what a bar code is or bar codes are but I think you ought to explain it.

A The simplest explanation is the thing you see in a grocery store on every package of Wheaties is a band of black and white lines and this is a way of encoding information that can easily be entered into a computer. The whole purpose of a bar code is to encode information so it can be entered

into a computer without the need for key strokes by a person which tends to be slow and erroneous.

Q During your work over these recent years, have you been on the cutting edge of technology, computer technology and bar code technology?

A Yes, we have.

Q Do you keep track of trade and technical literature in the computer area of technology and bar code area of technology?

A Yes.

MR. MALLIN: May it please the Court, I offer this witness as an expert on computer equipment, computer matters and bar code technology.

THE COURT: My practice is that the other side may if it wishes examine on qualifications now or reserve until cross whichever you prefer.

[44] MR. GRIFFIN: I'll examine him on qualifications now if I may, Your Honor.

THE COURT: Sure.

VOIR DIRE EXAMINATION

BY MR. GRIFFIN:

Q Mr. Mikula, what trade literature do you keep track of in your business?

A There are two primary bar code magazines that are published. I read those faithfully and a number of computer related magazines, some familiar ones like Byte and PC World and some more specialized ones.

Q You've been involved with Matrix Graphics since 1981?

A Yes.

Q What education have you had since 1981, formal education?

A I have not had formal education since 1981.

Q When was your last formal education?

A That would have been -- I have to think back. I received the second Master's degree from Penn State University back in approximately 1975. After that I did attend classes at Temple in Ambler which were business-related classes.

Q Your MBA from Temple was with an emphasis on finance and accounting, is that correct [sic]?

A I didn't receive an MBA from Temple. I was in the MBA program but did not --

Q Your Masters from Penn State in engineering science, when [45] was that, sir?

A That was in 1974.

Q And your courses there dealt primarily with statistics and what else?

A The statistics and analysis. The statistics courses involved the application of computer programs to statistics. There were some specialized computer programs at the time having to do with dedicated kinds of statistical analysis.

Q That was basically computers which we now look at as minis and mainframes?

A Minis.

Q It was not personal computers?

A That's correct.

Q Sir, you were involved, were you not, at least your company was, in providing firm wearboard to Mr. Markman so that he could try to create his initial or I think it's his second working model of his claimed invention?

MR. MALLIN: Your Honor, I think this goes beyond voir dire on qualifications.

THE COURT: I'll allow it as a matter of the order of proof.

A I don't know where it fit into his development cycle but, yes, we did provide a board to Mr. Markman.

Q What specific training have you had in, and I mean formal education, in the area of bar codes?

A I've had no formal education in bar codes, formal being [46] attending a university.

Q What formal education have you had in dealing with personal computers and the programming of them?

A I've had no formal university training.

MR. GRIFFIN: Your Honor, I would object on the grounds that the proffer as an expert has been too broad and that his area of expertise is substantially limited by his training and if it is to be offered as an expert in computer science, he hasn't been qualified.

THE COURT: I'll allow the witness to testify. Of course, the weight of his testimony is a matter exclusively for the jury to determine.

DIRECT EXAMINATION (Cont'd.)

BY MR. MALLIN:

Q Mr. Mikula, were you retained to make a study in connection with this litigation of Westview's inventory control system, the "Datamark" and "Datascan" and how they work together?

A Yes, I was.

Q Looking at Plaintiff's Exhibit 2, the number is "2-0", what is that?

A That is a "Datamark" inventory control system.

Q Looking at Plaintiff's Exhibit 3, which is intended to cover these two items, what is Plaintiff's Exhibit 3?

A That is a "Datascan" together with a "Datamark" and a [47] "Datamark" and a "Datascan" comprise an inventory control system.

Q Did you study Plaintiff's Exhibit 2 and Plaintiff's Exhibit 3?

A Yes, I did.

Q What other material did you look at and review in connection with your study of the way Westview's inventory control system works and what it's comprised of?

A In addition to actually working with the hardware, I had an operator's manual for the "Datamark" unit. I had program listings for both units, the "Datamark" and the "Datascan" and these program listings were dated 1985 and 1987.

In addition, I had various pieces of sales and promotional literature from Westview of which this is one example but there are also quite a few other pieces including price lists that listed the current array of systems and the capabilities thereof and I also examined the deposition of Mr. Jenkins,

who's the president of Westview, and some invoices printed by Westview for the sale of "Datamark" units.

Q I show you Plaintiff's Exhibit 4 and ask you what that is.

A This is an operator's manual for the "Datamark" dated October 1, 1985.

Q Did you use that in your study?

A Yes, I did.

[48]Q I show you Plaintiff's Exhibit 5 and ask you what that is.

A This is an operator's manual for the "Datamark" dated February 28, 1988.

Q Did you use Plaintiff's Exhibit 5 in your study?

A Yes, I did.

Q I show you Plaintiff's Exhibit 6 and ask you what that is.

A This is a price list for "Datamark" and "Datascan" equipment dated July 1st, 1985.

Q Did you use that in your study?

A Yes, I did.

Q I'll show you Plaintiff's Exhibit 7 and ask you what that is.

A This is an equipment price list for the "Datamark" and the "Datascan" and the date is December '89.

Q Did you use that in your study?

A Yes, I did.

Q I show you Plaintiff's Exhibit 8 of which there's a blow-up on the easel. What is that?

A This is a sales or promotional brochure produced by Westview Instruments [sic] for the "Datascan".

Q I'll show you Plaintiff's Exhibit 9 and ask you what that is.

Q[sic] This is also a promotional brochure produced by Westview Instruments for the "Datamark" with references to the "Datascan"[sic]

Q Did you use that in connection with your study?

[49]A Yes, I did.

Q I show you Plaintiff's Exhibit 10 and ask you what that is.

A This is a program listing dated 1985 produced by Westview Instruments.

Q Did you use that in your study?

A Yes, I did.

Q I show you Plaintiff's Exhibit 11 and ask you what that is.

A This is a set of program listings dated 1987 produced by Westview Instruments.

MR. MALLIN: May it please the Court, I offer in evidence Plaintiff's Exhibits 1 through 11 inclusive.

THE COURT: My practice is if there's no audible objection, they're automatically admitted.

MR. MALLIN: Thank you.

BY MR. MALLIN:

Q After October 29th, 1985, which is the date the original patent was issued, was there one or more than one model of "Datamark"?

A More than one model.

Q What models were there?

A Referring to the two price lists in 1985, the models were identified as System I, System II and System III. In the later price list, they were identified as the "Datamark" [50] System III, the "Datamark" Plus and the "Datamark" XI.

Q Would you show me which price list covers the XI and the Plus?

A The 1989 price list.

Q Plaintiff's Exhibit 9. Do "Datamark" XI and the "Datamark" Plus involve the printing of bar code coincidental with the transaction?

A Yes, they do.

Q Does that show on the price list of this Plaintiff's Exhibit --

A There is an allusion on here to the printing of bar codes. It does say, "automatically prints and ticket message and bar code".

Q Which model is Plaintiff's Exhibit 2 here in court?

A That is the "Datamark" System III.

Q Does the "Datamark" System III print bar code coincidental with the transaction?

A Yes, it does.

Q Before we go on and look at some of the equipment in detail, would you tell the jury just in a general way how Westview's Inventory control system comprised of the "Datamark" and the "Datascan" working together whichever

model without the details of any little differences between models, tell us how it works?

A We can talk on the System III because it's in front of us [51] and I can point to it. (Indicating)

The "Datamark" unit, the bigger one, consists of a keypad, a display and a printer that's on the left side of a unit. When a customer brings a transaction, a group of clothing in to a drycleaning store, a ticket is inserted into the printer and the keypad is used to print the ticket and an example of a ticket can be seen on here. Essentially what the ticket includes is the sequential invoice number. Invoice is the terminology for the ticket number used by ours and Westview. The ticket also contains a listing of the individual articles of clothing that were brought in as part of that bundle and description includes the type of clothing, pattern and the price charged for cleaning that item. It also includes a total for that ticket. At the bottom of the ticket is a bar code. The bar code contains the same number that's at the top of the ticket.

The invoice number is unique. It's automatically assigned by the "Datamark" when the transaction starts.

The other piece of equipment, the "Datascan", actually consists of two pieces. The smaller unit is a data processor connected to a bar code one or scanner and this is used primarily for taking inventory in the drycleaning store. The scanner is run over the individual ticket and a list is put together inside the "Datascan" of what invoices are found.

The printer that's behind the "Datascan" is used to produce [52] reports generated by the "Datascan".

MR. MALLIN: Your Honor, may I have the witness step down to the "Datamark"?

THE COURT: You don't need my permission, Counsel. Just make yourself comfortable in the courtroom.

(Witness stepped down to the exhibit.)

BY MR. MALLIN:

Q Now, would you first for the jury without getting into every detail print a ticket out as though a customer came in with drycleaning? Show the jury that.

A The procedure is really very simple. You start a transaction by inserting a ticket into the printer mechanism which is in here. It first asks you for a strip tag number. That can either be the number on the strip tag that was mentioned that's attached to clothing or it can be a customer Number. There's various ways to use that. I'll just use the number 1234. I press "Enter" that the number is correct and you've heard printing occur and we'll go into exactly what's printed when.

The display says "Begin mark" and that means start accepting various articles of clothing for the transaction. The keypad consists of a set of keys that are labeled "pants", "sweater", "dress" so these are prelabeled item keys. You can see they're color coded keys to identify the color of the

garment. There are a set of keys that are the pattern of the [53] garment, numeric keys and some special keys.

To begin marking, I press the key labeled "Dress" and the display shows the word "Dress" and the pre-set price in this system. If I want to indicate a color for the dress, "green", I press "green" and the word appears and if it's "plaid", I press "plaid" and "PL" appears here indicating "plaid". If that's correct, I press the "Enter" key and two things will happen. Asterisks will appear on here which is a signal to the operator that the "Enter" key has been pressed and it's been accepted as part of the ticket and printing will occur (demonstrating) so at that point on the ticket it has been printed on the lines that you can see on there which would say "Dress green plaid" and that price.

If I enter a second item, let's say it's a sweater, orange, check, again I see all those details plus a pre-set price for cleaning a sweater. I press "Enter" and a second item has been printed on the ticket. If I've completed all the items that have come in, I press the total listing key labeled "Dryclean" (demonstrating) and the printing that's occurred applies the sales tax giving me the total of that transaction which also appears on the screen \$10.02, a friendly message and a bar code. The bar code, as I mentioned, is the same contents as the ticket number or the invoice number. These are the unique numbers used to identify these tickets.

Q I'd like to put an exhibit sticker on that ticket which [54] you've printed Plaintiff's Exhibit 25.

Looking at Plaintiff's Exhibit 25 we see lines down at the bottom. What is that?

A Those lines are bar codes. It's a series of wide and narrow bars which a scanner with its associated reader and code implement can translate into a set of numbers for a computer.

Q The ticket that you put in there, Plaintiff's Exhibit 5, before you put it in the printer here, did it have any bar codes on it?

A No, it did not.

MR. MALLIN: I'm not sure whether you can see it but this is the exhibit.

(Exhibit was shown to the jury by Mr. Mallin.)

MR. MALLIN: May it please the Court, I offer Plaintiff's Exhibit 25.

BY MR. MALLIN:

Q Look at the "Datamark" and will you tell the jury what its basic components are?

A The basic components are the visible components. First, the keypad which as you've seen are dedicated to the function of drycleaning, the items key, color keys, numeric keys and the totalizing key.

The second component is the display to prompt the operator to show certain information, etc.

[55] A third component is the printer which is in this part of the "Datamark" and this is what we call a dot matrix printer which pertains to the way characters or bars or anything is formed with this printer.

Inside the "Datamark" is a printed circuit board and that printed circuit board contains a microprocessor which I mentioned before is really a shrunk down computer. It's the basic unit inside that contains the intelligence of the printed circuit board. It also contains a chip that has a program memory and this is a set of sequence of instructions that the microprocessor follows to carry out all the functions.

Q Approximately -- Is a chip large or small?

A Roughly it depends which chip, an inch by two inches for the big ones.

Q By looking at the outside of Plaintiff's Exhibit 2, the "Datamark", can you tell what it would print without knowing what chip is in it?

A No, I can't.

Q Now the first time I asked you just briefly print out a ticket so we can see what a printed out ticket was, now I'd like you to go into the process and explain in more detail what the mechanism is going on in this computer "Datamark".

A I'd like to print two tickets since we're presenting a number of different things that are technically important.

[56] The first thing was the functional striking of the keys and the ticket. The second thing is the relationship of the printing with relation to how certain things are performed at the keypad. If you can see that one better, we can reference the ticket on the first chart. Again I place the ticket and no printing has occurred. You heard a sound which is the ticket being clamped into the printer. I get the message again to enter the strip tag number. I'll just enter some different number. Press "Enter" and at this point the first line of the ticket has been printed. The first line of the ticket includes the date, the last date set into the machine, the unique sequential invoice or ticket number and the tag number that I enter. You heard the printing occur. That occurred just after the tag number is entered and "Enter" is pressed.

As I do an individual item, I'll do the green plaid dress again, again, [sic] now at this time it's in working memory. I can change the color of that to a blue dress.

Going back to the green one, at the time I pressed "Enter" again, again you'll hear the printer go and it will print the one item of the item. (Demonstrated)

When I get -- I'll put the second item in, sweater, orange, check, press "Enter" there's a second line printed. When I'm satisfied that the transaction is fully entered and I press the total key, all the printing on the [57] bottom of the ticket will occur. In other words, the tax will be calculated and printed, the total will be printed on the ticket. These are

indicators that this can be used to localize things by store and by operator number and there's a long process which is the printing of the bar code so at this point all the individual items have been entered. It totally listed -- It knows everything it's ever going to know.

Q What knows everything?

A I speak in terms of the processor, it being the data processor inside along with its associated memory. The memory is where details are stored and used later.

Q Those transcriptions are in the memory of the data processor at this point?

A Yes, they are and I can demonstrate that. At this point -- I'll make this clear by making one more entry. Let's add a sweater that's blue and mixed to our ticket. There is a working area of memory if you will that is the entry that I'm currently making and trying as an operator to get right. Once I press "Enter", this becomes part of the ticket memory. The memory of the system at this point has all the detail that is on the ticket and I can demonstrate that because one of the things that I can do is to review what's in memory but I'm at the point where I'm about to print out the total. As an operator, I want to review everything that was in that ticket so I press "Clear" key a number of times. It first [58] tells me the first item was dress, green plaid. Second item was the orange sweater and the third item was the blue sweater. Since those are in memory, I can go back and I can delete one of those items so at this point right before I'm about to print out the totals, all the details of the ticket are in

memory. When I press the total key (demonstrating), the information at the bottom including the bar code, which was the long repetitive motion you heard, is printed. Once the ticket is ejected, the thing that is maintained in memory are the unique invoice number, the date of the transaction and the total.

Q On the second ticket you've printed out, I've attached Plaintiff's Exhibit 26.

MR. MALLIN: May it please the Court, I offer Plaintiff's Exhibit 26 in evidence.

THE WITNESS: There is one other feature I'd like to mention of the "Datamark" itself before we get into how the whole system works together and I showed you, for example, how when you strike a key, I strike the pants key, the word "pants" comes up here. Also on the bottom there's a message of "Have a nice day" or whatever is chosen.

One of the functions of this keypad is to be able to go through when a person initially purchases a "Datamark" put into that system the meaning of those keys. This is called an alpha/numeric keypad. Alpha/numeric are individual keys that are alphabet and other keys that are numeric. The [59] numeric ones are always numeric. There's a chart in the operator's manual that gives you the corresponding keys to the alphabetical keys.

Q Are these steps and occurrences that you've just described for the "Datamark", are they reflected in the Westview "Datamark" operating manual?

A Yes, they are.

Q Now I would like to direct your attention to the "Datascan" and would you explain to the jury how the "Datascan" works?

A The "Datascan" is actually comprised of the portable unit as well as the general purpose printer. The "Datascan" itself includes another microprocessor with its own program stored in an ecom. It includes a display and a scanner for reading bar notes and on the front of the scan are a number of other bar codes. They have labels on them: Enter, Yes, No and individual numbers so these bar codes are really for the purpose of -- They are functionally identical to keypads to individual keys so scanning this "Enter" key, "Enter" bar is the same on here as if I had the "Enter" key.

The "Datascan" also as I mentioned, has its own display just like you can see but it's the way of guiding an operator through operating a "Datamark"ing system.

THE COURT: Excuse me, sir. You're going to have to keep your voice up because it's becoming increasingly difficult for me to hear you, perhaps for the stenographer so I'd apprec[60]iate it if both you and the attorney would just speak up a little bit particularly when your backs are turned toward her, it's difficult.

THE WITNESS: Certainly.

The "Datascan" is used in conjunction with the "Datamark". Its method of operation is that it's tied to the

"Datamark" with the cable and the list of invoices is transferred from here to here. Now let me --

BY MR. MALLIN:

Q From here to here. For the record, you'd better say --

A From the "Datamark" to the "Datascan" and to make that a little more clear, in the "Datamark" when we have printed the ticket at the beginning of a transaction, I mentioned that the memory of the "Datamark" retains a list of the date, the invoice number, the unique invoice number and the amount of that invoice. Those are retained in the memory of the "Datamark". Those are taken out of the "Datamark" memory when a person comes to pick up their order and there are different ways of getting it out. For example, in the "Datamark" the invoice number is entered from the keypad. In any event, those are taken out as they're picked up so the "Datamark" at any time includes a list of the invoices that should be in -- still be in the drycleaning establishment and we can do a number of reports from the "Datamark". One report is an invoice listing and that would give us a list of the current invoices. We can see an example of that invoice listing here [61] where it's labeled "Invoice Listing" and again ticket number. It includes the date, the invoice numbers and the amounts of the invoices along with the total for all of the invoices.

So the important point is in memory is a list of the invoices that should still be in the store.

By attaching the "Datamark" to the "Datascan" by the cable as I've shown, we transfer that list of invoices, the invoice numbers, dates and totals are transferred to the memory of the "Datascan" so again at this point the "Datascan" has its list of what should be in the store.

Now at this point the "Datascan" can be used in two ways. It can be used if you will to take invoices or tickets back out of inventory if additional things are picked up by the customer to keep this memory updated with what's in the store but its more important use is to take inventory.

The way that's used is an operator will attach it or hold it as this operator has, go through the store and scan the bar codes that are on all the tickets attached to all the transactions, the orders from people. So what we're doing is the "Datascan" has its knowledge of what should be there, we're going there and scanning everything we actually find in the store and from that the "Datascan" would produce a report. It can produce a report of all the invoices that it is expected to find and did find. It can produce a report of extra invoices and a list of missing invoices and this same [62] exhibit shows what the report looks like from a "Datascan". It's called inventory, the date of which the report was generated, a list of the listed invoices. These are the correct invoices the "Datascan" expected to find and we did, extra invoices, spurious additions, tickets that should not be there. It also gives the dollar list for those invoices. It gives a total of all the invoices that were actually found both the good ones and the extra ones, the dollar total, then there's a list of the missing invoices. It gives the invoice numbers and the amounts of those invoices as well as the

total of the missing invoices so this is the way in which the "Datascan" is used to reconcile inventory. It should -- It does know what should be there and by comparing what should be there to what's actually found to be there, it can tell you the extras and the missings.

MR. MALLIN: The record should show he was referring to the reverse side of the blow-up of Plaintiff's Exhibit 8.

BY MR. MALLIN:

Q In the two you've looked at from Westview, did it indicate that the Westview system had the ability to detect extra, missing transactions?

A Yes, it did.

Q In the industry, what does a preprinted bar code mean?

A Preprinted bar code means that -- In the system like this, for example, you would buy your invoice ticket from some[63]one who has the ability to print the bar codes for you. You would not have the ability to print them yourself. The bar codes would have sequentially numbered bar codes on each invoice or each ticket to identify them one from another.

Q Does "Datamark" and "Datascan" inventory control system use preprinted bar code tickets?

A No, it does not.

Q Is there any advantage to printing the ticket coincidental to the transaction as opposed to using preprinted bar codes?

A Well, there are two real advantages. One, the process of buying preprinted tickets is expensive. For the demonstration here where we're not using preprinted tickets, we can go to a stationery store and buy very inexpensive multipart tickets. To buy them from a printer preprinted is many times more expensive than the nonpreprinted.

The second item is the security aspects of preprinted versus printed on-the-spot tickets. If you buy your preprinted ticket, you're storing them somewhere hoping you won't lose them or having them disappear in different ways. You don't have the control that you have here. Here the important -- That bar code does not exist anywhere until clothing is really received into inventory.

Q Can a "Datamark" unit work with more than one "Datamark" unit?

A "Datascan" unit.

[64]Q Can a "Datascan" unit work with more than one "Datamark" unit?

A Yes, it can.

Q And how many?

A In the sales literature, it states that a single "Datascan" unit can handle up to 10 "Datamark" units.

Q Can you conveniently point out any place where that's stated by Westview?

A It's on the equipment price list dated 1985 and the description of the "Datascan" bar code reader it says it tracks 8,000 invoices from up to 10 "Datamark" systems.

THE COURT: Again, sir, it's -- For me at least I wasn't able to hear so you really have to keep your voice up. She can't take it down. It's not important whether I hear. It's important whether she does.

MR. MALLIN: I very much want the Judge to hear so keep your voice up.

THE WITNESS: On the 1985 price list the statement is that the "Datascan" bar code reader tracks 8,000 invoices from up to 10 "Datamark" system three lists.

BY MR. MALLIN:

Q Now I would like to direct your attention to the two Westview computer printouts that you referred to earlier, Plaintiff's Exhibit 10 and Plaintiff's Exhibit 11. Would you explain what those are?

[65]A I'll use as Exhibit 10 as an example and this is a listing produced in the course of development work on the program that controls the "Datamark".

In this particular instance, this one has a printed copyright statement 1985 by Westview Instruments. Without going into

all the details of just how microprocessor programs are developed, the programmer produces what's called source code. This is a code that's made by a programmer and it includes individual statements of what the unit is supposed to do. On this listing the source code would be roughly from here to here and it appears to be English and it's readable by a programmer. This source code is routinely development system through a set of programs and the output of that process is what's called machine code. Machine code is the information that's on the left side of the listing and that's the actual coding that goes into the ecom, the chip associated with the microprocessor that actually contains the programmer. The microprocessor can decode this information and do its individual steps.

Q Is it fair to call that a computer printout?

A Yes.

Q Does the computer printout that you have in your hand, Plaintiff's Exhibit 10, does it show the printing bar code coincidental with the transaction?

A Yes, it does.

[66]Q Let's go to Plaintiff's Exhibit 11. This is also a Westview printout and so we don't have to repeat, I take it what you said about the other would apply to here except for the date.

A That's correct. It says copyright 1987. Format is identical. Some of the information is different.

Q Does Plaintiff's Exhibit 11 -- Is that the right one you have in your hand?

A Yes.

Q -- show the printing the bar code and the tickets coincidental with the transaction?

A Yes, it does.

MR. MALLIN: You may take your seat again. That's all I have, Your Honor.

CROSS EXAMINATION

BY MR. GRIFFIN:

Q Mr. Mikula, you've told us how the "Datamark" system works. I want to direct your attention to back to after you had gone ahead and run up the total and your Plaintiff's Exhibit 25 had been printed out. If you didn't have this piece of paper, is there any way that this "Datamark" can tell you what comprises -- what actual articles of clothing comprised this order?

A No, you cannot tell from the "Datamark".

Q The "Datamark" doesn't have enough memory to take care [67] of that, is that correct?

A I can't answer the question on whether it has enough memory. I do know it does not retain the individual items.

Q That's right. As soon as you print it out, that's lost from its memory.

A It's no longer accessible by the "Datamark". Certain pointers are destroyed when the ticket is ejected and you can no longer get that information. It's eventually totally lost from memory.

Q So what this system tracks and --

Let me back up one for you, sir. You said that the "Datascan" can be used in conjunction with the "Datamark", correct?

A That's correct.

Q The "Datascan" gets its information from the "Datamark".

A That's correct.

Q And the "Datascan" can't have any more information than it gets from the "Datamark".

A That is true from one or more "Datamarks".

Q That's right and if the "Datamark" can't tell what individual items of clothing are associated with the invoice number, the "Datascan" can't know that either, is that correct?

A That's correct.

Q Once this ticket is created, this "Datamark"/"Datascan" unit loses all ability to in any automated fashion tell us [68] what articles of clothing are associated with this ticket?

A Yes, with the term "any automated fashion".

Q That's right. I could sit there and read the ticket but let's say the ticket was lost and someone came in and said: I had invoice No. 1234, is there any way this system could tell the drycleaner that that happened to be a green dress and an orange sweater?

A No, there is not.

Q So this system cannot track individual items of clothing through the drycleaning process.

A The tracking occurs on an invoice basis not individual items of clothing.

Q And the reports are on an invoice basis?

A That's correct.

Q It totals up the dollars but it doesn't total up the items of clothing associated with the invoice?

A Associated with a specific invoice, that's correct.

Q Now, sir, when you were asked to take a look at the "Datamark" unit, were you asked to take a look at any other units that list a laundry listing like "Datamark"?

A Not real equipment, no.

Q Are you familiar, sir, with the "Liberty Lister"?

A Yes, I am.

Q Does the "Liberty Lister" generate any reports that are different than the reports that you can get from the "Datascan"/[69]"Datamark" system?

A You have to understand that I did not work with the "Liberty Lister". I'm going from memory from some sales brochures. I do not believe so.

Q So the same reports you can get from the "Liberty Lister" system you can get from the "Datamark" system?

A I would like to examine the "Liberty Lister" system before I say that.

Q That's your recollection?

A There's no --

Q The "Liberty Lister" had a preprinted bar code and the "Datamark" unit has a bar code which is printed out by the system, is that correct? That's the only difference.

MR. MALLIN: Your Honor, I object. We're not only beyond the scope, we're also into the defense. The law is quite clear during the case in chief on infringement, we

shouldn't get into the defenses. We get the defenses first and then the rebuttal.

THE COURT: Overruled. As a matter of the order of proof, it's more efficient to do it this way.

BY MR. GRIFFIN:

Q Sir, are you familiar with a company named Intermek(ph)?

A Yes, I am.

Q What is Intermek?

A Intermek is a manufacturer of bar code printer and [70] scanning equipment.

Q Does Intermek also provide consulting services to companies?

A Yes, they do.

Q And does Intermek design systems for companies?

A Yes, they do.

Q Are you familiar with any of the systems designed by Intermek?

A I have read some brochures on Intermek systems.

Q Do you know when Intermek first started designing systems with bar codes?

A No, I don't know that date.

Q It was before 1980, wasn't it?

A Yes, it was.

* * *

[71] BY MR. GRIFFIN:

Q Mr. Mikula, you told us before lunch actually when I was questioning you on your qualifications that your company had done some work with Mr. Markman in conjunction with the second working model of this invention, is that correct?

A I said we had done some work. I didn't know which model.

Q When did you do that work, sir?

A That work was done in late 1983.

Q When did your business relationship with Mr. Markman start?

A It was really October 1983.

Q Does it continue to today?

A It does continue to today. The nature of it is that we provided a board for him that was part of his system up to a certain time frame with the understanding that eventually our board would be replaced by programs running in his own computer and that has happened. We're no [72] longer an active part of his system. The only ongoing relationship is occasional repair work to some old boards.

Q Sir, you testified I believe that one of the publications that you receive and monitor is Byte magazine?

A That's correct. I do read Byte magazine.

Q Would you characterize Byte as a popular magazine or a trade publication?

A A popular magazine.

Q Are you familiar, sir, with the article in the May 1981 Byte magazine entitled, "Print your own bar codes"?

A I have read that article, yes.

Q I'll hand you an [sic] copy of what has been previously marked as Defendant's Exhibit No. 19 and ask you, sir, is that the article --

* * *

[73] THE COURT: I'm just trying to get a sense of the case and if we just tried the issue of infringement initially, how much time would it take for you to present your case

assuming he did not inquire into the areas of defense? You have this witness.

MR. MALLIN: Yes and I have Mr. Markman. Some of this bears on infringement.

THE COURT: Roughly we would finish up when? I'm just asking for both your informed judgments.

MR. MALLIN: And the very next witness would be the patent expert and then I'm assuming you're asking beyond that. The patent expert is, of course, infringement and then Mr. Markman's testimony some of it would bear perhaps -- Damage witness, of course, doesn't go to infringement.

THE COURT: Understood.

MR. GRIFFIN: Your Honor, we could finish very quickly. I intend to call only one witness if --

THE COURT: How long would you guesstimate -- [74] I'm not going to hold you you [sic] to it -- for completing the plaintiffs' case on that issue?

MR. RYAN: Probably one more day, Your Honor.

THE COURT: You'd be finished sometime tomorrow your guesstimate is and you you'd --

MR. GRIFFIN: I'd finish very promptly within an hour and a half.

THE COURT: You people are the pros. Give me your judgment whether we should do it that way. That does seem to be the crux of the case. I know you filed a motion on the subject.

MR. MALLIN: I think it's better to do all the liability issues.

THE COURT: How long would that take if we got all the liability out of the way?

MR. MALLIN: If he puts evidence in on prior art and so on, we would rebut it.

MR. GRIFFIN: That would add several days at a minimum.

THE COURT: Do you agree with the time estimate on all liability?

MR. MALLIN: I could be longer.

THE COURT: Okay. I'm not sure what's the best way and I'd sort of like to leave my options open so why don't we do this at this point? Let's limit the [75] examinations just to the issue of infringement as a matter of proof. I ruled otherwise before lunch. I had an opportunity to read counsel's memorandum which was submitted to me after I ruled and let me just see how it goes doing it that way so you examine just on infringement and he'll be finished sometime tomorrow and we'll talk again.

* * *

[76]Q You have the Byte magazine article in front of you?

A Yes, I do.

Q Did you read it at or about the time it came out?

A I don't remember when I originally read it. I reread it recently.

Q It deals with putting --

You testified earlier on direct examination that the "Datamark" literature says that it will detect extra or missing transactions. Where in the literature does it say that?

A Well, if I can go to the display --

Q Please do.

(Witness stepped down to the board.)

A The wording here is the "Datascan" will find all extra invoices and missing invoices.

Q The wording is extra and missing invoices and it's [77] not transactions, isn't that correct?

A I'm not sure I understand the difference. Transaction -- One single unique transaction produces one single unique invoice.

Q Mr. Mikula, when did you first start working with bar codes?

A In the late '70s.

Q When did you first start working with on demand bar code printing?

A I have to clarify just what I did. The controller board that we developed was a general purpose controller board which allowed a range of existing dot matrix printers to print bar codes. I have to differentiate what we did versus how the end users actually used what was printed. Ours was a general purpose controller. You commanded it to print a bar code and we did the dot-by-dot construction of the bar codes. The actual use of it whether it was what we call a batch printing process where a great number of bar codes are printed or whether it was on demand where bar codes are printed as you need them, I don't know necessarily where all these were used by the end users. We sold our boards to people who integrated them with computers and then resold them for various users -- to end users.

MR. GRIFFIN: Thank you, sir.

[78] MR. MALLIN: No questions.

THE COURT: Thank you, sir.

MR. MALLIN: Plaintiff calls Mr. Chovanes.

EUGENE CHOVANES, PLAINTIFF'S WITNESS,
SWORN

DIRECT EXAMINATION

BY MR. MALLIN:

Q Would you state your name, please?

A My name is Eugene Chovanes.

Q What is your address?

A My address is, residence address is 114 Maple Avenue in Bala-Cynwyd, Pennsylvania, a suburb of Philadelphia.

Q Have you had experience with patents and the question of infringement of patents?

A Yes.

Q Would you tell the jury about your experience?

A Well, I am 65 years of age. After high school, I went into the Army World War II Europe, then I went into Lehigh University 1946 to 1950, graduated from Lehigh with a Bachelor's degree in mechanical engineering. In 1957, I went to work for a patent law firm called William Steel Jackson and Sons. This was a law firm, a very old-time law firm. I am still with that firm, Jackson and Chovanes. I am the survivor of the people in that firm. We have practiced

patent law -- I've been in the practice of patent law since 1957 to the present.

[79]Q In your practice of patent law, what kind of areas did you deal with? Did you deal with patent prosecutions before the Patent Office?

A Well, first of all, I'm a member of the bar. I graduated from Villanova School of Law in 1960 so I am admitted to practice in the United States Patent and Trademark Office since 1960 or '61 right in that time as a lawyer to practice before the Patent Office.

Q Have you practiced before the Patent Office?

A I have practiced before the United States Patent Office since 1960 but in fact from 1957 on I have been with a patent law firm, my predecessor, doing work for them in their their [sic] present firm.

Q Aside from practicing before a Patent Office, have you had experience in determining whether accused devices of one kind or another infringe patents?

A Yes, in my practice, I have evaluated patents, I have prosecuted patents before the United States Patent and Trademark Office. I have made searches on patent matters. I have defended patents in courts. I have prosecuted patents. I have appeared as an expert witness as I'm now doing in patent practice on a number of occasions. I have searched in the United States Patent Office which is a vast library of patents to determine in my opinion patentability or lack of

patentability validity of [80] patents. I have negotiated patent matters, licenses regarding patents.

I think that pretty well covers what I've been doing.

Q Have you had experience in evaluating claims and scope of claims of patents?

A Yes, I have. Each patent has a claim or claims and in evaluating patents and in determining whether there is infringement in my opinion or not infringement, I have worked on claims and could have -- When you apply to the United States Patent and Trademark Office for a patent, you write an application on behalf of the client with the invention and you must submit claims. That's the definition. That's the legal boundary of what the patent is for so I have worked with the Patent Office in perhaps hundreds of applications determining and arguing for claims and determining what claims are so I have had modestly extensive experience with claims of patents.

Q Have you done any teaching in the area of patents?

A Yes. I was a part-time or adjunct, however one wants to call it, of patent law at Villanova University School of Law from approximately 1968 to 1980 and I would teach patent law to the law students. This wasn't their main course, of course, but I would go out once a week for three hours combining two sessions into one extended one [81] and I taught patent law for I'd say approximately 12 years.

Q On the occasions when you have appeared as an expert witness in patent cases, have you sometimes testified on claim evaluation and infringement of patents?

A I have.

MR. MALLIN: Your Honor, I offer this witness as an expert on patents and patent --

MR. GRIFFIN: No need to voir dire, Your Honor.

BY MR. MALLIN:

Q Were you retained to make a study to determine whether the Westview inventory and control system, the "Datamark" and "Datascan" working together, infringed Mr. Markman's '054 patent?

A Yes.

Q Were you here in court to hear Mr. Mikula's testimony describing the Westview inventory control system?

A Yes.

Q Prior to hearing him in court, had he imparted to you the substance of that information about the Westview inventory control system?

A Yes.

Q Have you looked at other materials as part of your study?

A Yes.

[82]Q Would you tell the jury what other materials you have looked at?

A Well, I looked at the patent in suit. That's the reissued patent. I have looked at the original patent on which the reissued patent was granted or reissued. I looked at the file histories of both those patents. That means the record, the official record in the United States Patent Office, Patent Trademark Office -- I'll refer to it as the Patent Office -- which is a history, which is a record of every document that exists with respect to the prosecution how that patent was obtained.

One of the requirements in patent practice is that everything must be be [sic] in written form. If you interview the examiner, there has to be a record of that interview so I reviewed what's called the file history. That's the file of everything that went on with respect to the application of that patent, the examination of the patent, the responses from the actions of the Patent Office, the response from the applicant back. I reviewed both histories on that. There was prior art cited in the application, that is, prior art meaning patents or other possible documents which would show what went on before the application and the patent examiner, one of over a thousand who's a specialist in this area and is assigned to him, he's an expert, he will in his search and so forth [83] of Patent Office records determine to the best of his ability what is the best prior art, that is, what went on before and that becomes a record in this file so I considered that in the file history, in both file histories.

I have reviewed -- studied and reviewed a lot of documents of Westview, the defendant, in this action. Some of them are left over here but, for example, price sheets, operator's manuals both the 1985 "Datamark" and the 1988. I have studied the pleadings in this case, who is saying what, motions in this case, studied those, and a lot of brochures relating to -- of Westview relating to what or describing what their system does, how it does it.

Of course, as I stated earlier, Mr. Mikula demonstrated all this to me. I was present where he did it in a private session with me and I saw it again today. I saw the tickets. I have reviewed the tickets that are involved here. I have reviewed the printouts of the "Datascan" printer. There may be some others but I'm trying to review it.

Q Everybody will be happy to hear I'm not not [sic] going to try to mark all of that but there are a couple of things.

I show you Plaintiffs [sic] Exhibit 1. What is that?

A This a copy of the patent in suit what this case is all about.

[84] MR. MALLIN: May it please the Court, I offer Plaintiff's Exhibit 1 in evidence. Your Honor, since it's the patent in suit, I would like to pass it among the jury if I may.

THE COURT: My practice is all the exhibits will go to the jury at the conclusion of the matter unless there's some extraordinary circumstance so why don't we do it that way if you don't mind.

BY MR. MALLIN:

Q I show you Plaintiff's Exhibit 13 and ask you what that is.

A This is a copy of the original patent upon which the reissued patent in suit was filed and obtained.

Q When was the original patent filed?

A The original patent that is Plaintiff's Exhibit 13 was filed on April the 13th, 1984.

Q When was that patent issued by the Patent Office?

A This patent was issued -- by this patent, I'm referring to the original, Plaintiff's Exhibit 13 -- on October the 29th, 1985.

Q When was the application made for the reissue of the Mr. Markman's '054 patent, the patent in suit?

Q[sic] You said when was it issued?

Q First when was it issued?

A The patent in suit, Plaintiffs [sic] Exhibit 1, was issued [85] on September the 12th, 1989.

Q When was the application made for the reissued patent?

A The application for the reissued patent was made on August the 28th, 1987.

Q You mentioned a moment or two ago you looked through certain Westview brochures and literature and I want to direct your attention to Plaintiff's Exhibit 8. Is that one of the ones you looked at?

A Yes.

Q I direct our attention to the blow-up of that exhibit each side which has been marked as Plaintiff's Exhibits 8-A and 8-B and have you looked at those blow-ups as well?

A Yes.

MR. MALLIN: May it please the Court, I offer Plaintiffs's Exhibits 8-A and 8-B. 8 is already in evidence.

BY MR. MALLIN:

Q You touched on it in describing what you looked at. Will you tell the jury how you go about getting a patent from the U. S. Government? We'll start with an inventor coming up with an invention or what he or she feels is an invention.

A The U. S. Patent Office requires that an inventor or [86] his assignee who he sells his invention to in effect apply to the United States Patent Office for a patent and in applying, you must file a patent application. The application must conform to patent practice. It has to have a drawing if it lends itself to a drawing. It has a description or a specification of what the inventor feels is the best mode. It's not the scope of his invention but he has to put forth at least one preferred embodiment, is the word of art, to show one way, the way maybe he thinks is best at that time but he's

not held to that in time and then what is considered to be the most important part of the patent is the claim or claims. These come at the very end. You only need one claim in a patent but the patent practice permits you to put alternative claims in. It's somewhat analogous -- Excuse me. The claim is the legal definition of the patent. It's analogous if you own a piece of real estate if you look to your deed, a house or something, the house isn't described in all that but the area of land that you own is laid out starting at a point, a certain point from a corner back a hundred feet over to the west 200 feet so forth back to the beginning.

The claim of a patent is an attempt to find the scope of the invention with words, intellectual concepts and the law recognizes this going back to the Constitution. It's one of the few pieces of property [87] that's set forth in the Constitution of the United States. You set forth the claim and you're allowed to put in as many claims as you wish to try to differentiate the different scopes of your invention as well as trying to set forth by definition the invention in different ways because you're going to have to -- you get the right to exclude others if you get the patent for 17 years from that piece of property so the law, the patent practice is such that it gives you in this application, it not only gives you but demands that you set forth in your claim the definition of your invention, the legal boundary, when a patent is issued, what rights does it give the patent holder, if and when a patent is issued from the date of issue not before -- and precisely they're issued every Tuesday -- for 17 years from that date the patent, the patent holder which we call the patentee has the right for 17 years to exclude others from making, selling or using that invention defined, of course, in the claim or claims. After 17 years, it's now free for anyone

to do it. That's part of what the patent incentive of the incentive sentence patent meaning open to give them out after 17 years it becomes public domain.

Q You mentioned the ingredients of the application but I want to focus specifically on an issued patent itself like Plaintiffs [sic] Exhibit 1, the reissued Mr. Markman '054 [88] patent. What are the basic components [sic] of a patent issue?

A The basic components of a patent issue certainly the prior claims. You look at the claims as to what is patented, each individual claims and then there are drawings if the case lends itself to that and there are what we call a specification. It's a written portion which would include the claims but it sets forth in the description the preferred embodiment or as required by the law the best mode that the inventor contemplates at that time.

Q Is the claim of the patent limited to the preferred embodiment or the best mode?

A Absolutely it is not limited to either, absolutely not limited to either. The claim defines the invention and the claim is what you look to to [sic] see if it defines the invention. The best mode is one way of doing it or the preferred embodiment and that's synonymous.

Q Plaintiff's Exhibit 1, Mr. Markman's '054 patent, is a reissued patent. Will you tell the jury what that means?

A Well, as far as being a patent of invention, the reissued patent is simply the original patent that has gone back and in

effect been reexamined. In the practice, once the patent issued time is running, the reissued patent in this instance will run out 17 years from the [89] date of the original patent so the original patent sets the time.

Now if the inventor or patentee feels or believes is a more accurate term that the original patent is such that he wants it in effect reexamined because there's some prior art, for instance, that wasn't considered before and he feels for whatever reason it should be reconsidered or that as in this case he was entitled to more, inadvertently he could have claimed more -- I told you about how claims define it so he felt he should get additional claims, then you have the right to go back to the Patent Office with your original patents, in effect lay it on the line and say: Take a look at it, Patent Office, including these original claims. If they're no good, I'll take my lumps here but if they're good, set those forth again but I believe I'm entitled to not only what was given to me originally but I'm entitled to more.

In the specific Plaintiff's Exhibit 1, the reissued patent in the case, that's what happened. It went back to the same expert examiner, and said: Look, we want more. Here we believe we're entitled to more. Here's additional prior art that's come up. Someone said in a prior suit or something some things came up, we went to take a look at this and we went to take a look at this [sic] [90] including for our original claims.

Now the Patent Office as what happened in this case, the Patent office looked it all over this second time. They came to a conclusion that not only was the patentee entitled to those original 13 claims but they were entitled to even

broad claims and we talk about broad and narrow as to how big that definition is so Claims 14 and 15 were granted on the reissue.

Q Now --

A In addition to the original 13 in identical form --

Q So we're clear in this, the first 13 claims in the issued patent-- in the reissued patent were already in the reissued patent?

A That is correct.

Q Were they identical to the reissued patent ?

A Absolutely.

Q What was the effective date of those first 13 claims in the reissued patent?

A By effective date I understand that to mean that when did they become effective excluding others from making, using or selling the legal effect? Those 13 claims in the reissued patent were the original identical claims in the original patent, Plaintiff's Exhibit 13, those claims are effective as of the date of issuance of the original patent which was October the 29th, 1985.

[91]Q What is the effective date of the two additional claims, Claims 14 and 15, of Mr. Markman's reissue '054 patent?

A The reissue date on that is September the 12th, 1989 and those two additional Claims 14 and 15 are effective as of September the 12th, 1989.

Q Now would you please tell the jury what is meant by infringing a patent or a claim of a patent?

A Well, in determining infringement and talking about infringement, we have to consider one claim at a time because each claim stands on its own. To infringe a patent you only have to infringe one claim. Many patents or some patents only have one claim but nevertheless, we take one claim at a time. We see what that claim says or in patent practice what the claim requires. This is in an effort now to determine what that claim is, what it defines, what the invention is so we look at that claim and obviously we see what it's to. Is it to a system? Is it to a machine? Is it to a process? Is it to a substance such as a drug, something like that, pharmaceutical but we look to see what it is and then we see what are called elements in a claim. Now it can only have one element but the vast majority of things are a combination of elements but whether as one or more, we see what are those elements.

[92] Now we look to the claim of the patent which I said defines the scope. It's just like your piece of property I talked about and then we see whether the infringer is coming in on that, whether in effect it's a trespasser across your property. You have a right to exclude that infringer. To determine whether or not he is infringing, you must look first of all to the claim. You take the claim of the patent. What are the elements of that claim? Within those elements, what are the limitations? We call limitations, meaning, what

does it say about that? You look to see what does it say about all of that. Now once you look at the claim language, the elements and all that, now you look at the accused device, that's the term, or accused system. That's the term of patent practice. You look to the accused system and you look to see if each and every one of those elements in your claim -- Not one of them can be missing or in addition, if there's functional language, does it do what that functional language requires which means what the effect or how it works, you see if that's present in the accused device within the language of that claim and what is called by the accused. If you call something a leg and if it's a tail, it's still a leg. You look to see what it is and not what it's called. You look to see if those elements are present and that description or functional [93] language is present or its equivalent. Patent practice recognizes that there's -- you can't be drafting claims, everything. You must interpret that fairly, the claim so its equivalent in patent -- and patent practice has come down: Does that element or language there present in equivalent form, as to how patent practice has defined equivalent, form which means is it doing it in the same way, substantially the same way, to obtain substantially the same result with substantially the same means so you look to if it's not within the language -- and by language, I don't mean exactly those words, you still have the equivalent [sic] -- you look to see if those are present in the accused system and when we say reading, we say if the claim then reads on the accused device because what you're doing is you're reading the elements of the claim and looking to see if they are present in the system. If each and every one of those elements the functional language or the equivalent is present, then infringement is made out.

Q Did you make a determination of whether Westview's inventory and control system comprised of the "Datamark" and "Datascan" infringes Claim 1, PX 1, Mr. Markman's '054 reissue patent?

A Yes, I did make such a determination.

Q And did you read Claim 1 on the accused system?

A Yes, I did read Claim 1 on the accused system.

[94]Q I'd like to put Claim 1 up so the jury can follow what you're doing.

(Counsel did so.)

MR. GRIFFIN: Your Honor, may I walk around so I can see?

THE COURT: Sure. Walk around and make yourself comfortable. You don't need my permission.

BY MR. MALLIN:

Q Is Claim 1 a dependent or an independent claim?

A Claim 1 is an independent claim.

Q What is the difference between an independent claim and a dependent claim?

A Well, I said earlier that patent practice permits more than one claim as far as setting forth defining the invention. Now

I also said each claim stands by itself. Now the first claim, for instance in this case, is independent in that it sets forth the system that is being patented here and it sets forth the elements and I'll be referring in my own way to elements A, B, C and D and then it concludes with functional language "whereby". That's an independent claim. It's standing in effect by itself.

Now Claim 2, which isn't here, but this is to illustrate it, that is it's not on the board, it would say: A system of Claim 1 having further, and it defines some further limitation.

[95] Now we say that 2 is dependent on 1. First of all, patent practice permits that kind of a writing simply so you don't have to put in 2 because it does stand totally by itself. It's not dependent in that way. It stands by itself but instead of putting in B -- A, B, C [sic] D, all that stuff again, when it says: A system of Claim 1, then you have to take everything from Claim 1 and put it in 2 wherein -- this is illustrative -- Element D is a pink color. Now we don't make patents in pink color. I'm just trying to illustrate something which means 1 back there not only covers pink but covers red and blue and everything else so we have that sort of independent and dependent claim and it would just follow that if you did not infringe an independent claim which means you didn't have Elements A, B, C, and D, then you would not infringe dependent Claim 2 which says A, B, C and D is pink so this is simply a way of shortcutting writing but you must go to each claim but dependent always means everything on the claim or claims prior in which it's dependent is included in this claim.

Q Let's come back to Independent Claim 1 which stands on its own. Would you please, and feel free to step down by using the blow-up of Independent Claim 1 which I'm going to mark as PX 1-A and the charts that are up, the "Datamark" and "Datascan" or whatever you want to use, [96] would you please read Independent Claim 1 on the accused Westview system?

MR. GRIFFIN: Objection, Your Honor. That seems to me to be asking the witness at this point to then give -- substitute for the jury determining the ultimate question.

THE COURT: Well, no. I think he can read it if you insist that he do.

Is that the most useful way to present it because it's admitted into evidence.

MR. MALLIN: He's going to read the claim on the accused device so you go down through the claim and you show this is where it is on the accused device.

THE COURT: All right. I'm with you now.

Overruled.

BY MR. MALLIN:

Q Using whatever material you choose, and you can step down, would you read Claim 1 using -- so the jury can read it -- Plaintiff's Exhibit 1-A which is a blow-up of Claim 1 and whatever other materials. Read Claim 1 on the accused Westview system.

MR. GRIFFIN: Same objection, Your Honor, because I believe that's the function of the jury in this case.

THE COURT: Overruled. Rule 704.

[97] (Witness stepped down to the board.)

A This is Independent Claim 1 of the reissue patent in suit and the claim runs from No. 1 down here to the period at the very end. It's -- In patent practice a claim is set forth in a long sentence regardless how long the sentence is and there are abbreviation marks. Again you're permitted to choose --
- The drafter of the claim is permitted to choose how he wants to present.

Now in this instance, we look to what the claim introduces, what is it about. It's the inventory control and reporting system, comprising --

There's been a lot of testimony. You've seen it. Places where I really feel there's absolutely no controversy I will still cover it but I won't go into it in depth and I think there's no question referring, for instance, here to Plaintiffs [sic] Exhibit 8-A that this is the accused system is an inventory control system, reporting system comprising --
Comprising is a word you'll always see which means with a colon we're now going to set forth these elements and may I mark this if --

MR. MALLIN: It's all right with me.

THE COURT: It doesn't matter to me, sir. Whatever you'd like.

THE WITNESS: Okay. Thank you.

Nothing magic in the marking. I'm just trying [98] to go through it.

Now, if we took this and we simply -- If we took this as a data input device, here, we have A here. That's a data broadly speaking. I told you about the four elements here so we have the data input device as A, a data processor that would be B then a dot matrix printer, this is C, at least one optical scanner I'll designate that D so we have elements, broadly Elements A, B, C, D. Again I don't think -- On the "Datamark" the data input device is the keyboard. You put in the data with that. It doesn't matter what you call it, what the accused device calls it and so forth, in the patent itself, in the description it's clearly the keyboard but the drafter of the claim he's got to try to foresee and cover within the invention whatever possibilities may arise that are validly his so it was set forth as a data input device under the patent. It's the keyboard so you have a keyboard on the "Datamark". No question that's there.

Again, data processor. Mr. Mikula was here testifying as an expert in his area and he indicated in here that this is a data processor or microprocessor or form of computer. Those are all within what's called a data processor. Again no question.

Now a dot matrix printer and I will go back incidentally and go into these in detail. I'm trying to [99] give a broad picture now. A dot matrix printer. Here was the printer. The ticket when he typed it came right out here. There's a little printer right there. He has two little things

there: Pup, pup, pup. At least one optical scanner. Again, all those things I studied, reviewed over there's no question that this is a scanner goes over within that so we have Elements A, B, C, D.

Now we have to go back. Now let's see about this other thing in here. "A data input device for manual operation by an attendant". Well, the person, in this case the laundry clerk, the one that's there, takes them, puts in suit, coat, whatever it is there. By attendant. "The input device" -- Now we go back in here. The input device that they're talking about is in here -- "having switch means operable to encode information relating to sequential transactions".

Now let's go here for just one moment to this sequential transaction. Sequential means one following another.

MR. GRIFFIN: Objection, Your Honor. The basis for my objection is the way Mr. Chovanes is proceeding is it's my understanding that the determination of the scope of the patent is a question of law for the Court. He can help the jury out as an expert in saying how he thinks you can look at the accused device but to interpret, take away [100] the Court's function and to interpret the patent itself is improper.

THE COURT: I'll hear the testimony. I can use all the help I can get.

BY MR. MALLIN:

Q Go ahead, please.

A Now sequential -- Up in here sequential transaction simply means one after another.

Now going back again to the keyboard, "having switch means" -- again that's simply keys in the accused -- "operable to encode information relating to sequential transactions".

Well, that's what happens. One customer comes in, the manual operator encodes, puts in there -- encode means take data from one; put it into another medium. It's putting it into the computer putting it into a microprocessor: One shirt, puts it in the memory of that processor, plaid, punches it, puts it in the memory of the processor so it's encoding that information into the memory of the processor. So it is encoding information relating to those sequential transactions.

Customer 1 comes in: Coat, suit, tie. Another person comes in next: One dress, sweater, so it records it.

"...each of the transactions having articles [101] associated therewith".

In other words, it's encoding information which we will see then will be printed out on a ticket relating to those articles.

"...descriptions of said articles associated with the transactions".

So clearly here along with its limiting language here is being read on the accused system, the keyboard is there with these things.

Now Element B -- and remember I have just designated them Element B for my explanation purposes -- a data processor. Okay. I said we had a microprocessor including memory. See these are certain limitations -- including someone here -- "... memory operable to record said information."

Well, the said information is this up in here, said information including transaction identity.

Going back for one moment, transaction identity it puts in information about that. Now Mr. Mikula and the operating manuals and all this when a person comes in, you put a customer identification on there. It's a customer tag number. In this instance, they put it right here, Tag 121961 on this ticket. The customer comes in and they give a customer identification so it has that "including memory operable to record said information".

[102] Well, as set forth in their manuals and as was shown here and so forth by Mr. Mikula, when we put in the customer [sic] one, you put in one, then here pants, sweater, color here, the color's right here blue, that appears on this thing here, on the scanner and it's in a memory of this computer. The memory is holding it in there. Mr. Mikula pointed out how when you put the ticket in there even after you print out one and go to the next item in that transaction, it's still in that memory because before you print the total, you go back and change and see it so the computer

here it does have memory operable to record. To record is when you put it on the ticket here in this instance then it's recorded on the ticket but it's put in from the keyboard, it's encoded into the microprocessor, the microprocessor holds it there and it puts it on the ticket but it still holds it until we -- We'll get to that at a certain point.

"...and means to maintain an inventory total". That's another thing that this data processor includes a memory. I told you how it reads on it there, "...and means to maintain an inventory total." Well, that's inherent in this system because Item -- the first transaction comes in: One sweater, coat, \$7.00. It's remembered in here. It's always remembered in here as to the total of that transaction \$7.00 so then when -- as Mr. [103] Mikula stated and is in the operating manuals and so forth, you can at any time get this computer, get this "Datamark" to tell you what is the total like. For instance, if you start off in a day, the total is zero. You get 20 customers in, I mean 20 transactions and you say: I wonder what my inventory total is: pup it hits: zet, zet, zet it prints out, it will show you by inventory or invoice number and for that day if it's 001 happens to be the first one and so forth, it will have \$6.00, next one so down at the bottom it will show the inventory total for that day. It's in the operating manuals and it's just the way the system works.

We're reading it through now. "... said data processor" -- that simply -- "having means to associate sequential transactions" -- that's one after another -- "with unique sequential indicia".

So here we have "sequential" transactions -- it repeats that word in there -- one after another -- "with unique sequential indicia". Those words there cover -- If you recall, the "Datamark" here assigns an invoice number. That's this number right here. That's this number right here, on here. It's zero, zero, one eight. It assigns that number to it and also as we will see this bar code down here is that same number written in this scan that the expert was talking about today how you scan [104] all that so anyway the processor has means to associate the transaction with unique sequential indicia. It gives an invoice number and that bar code "to generate at least one report of said total".

Now that's where it takes the zero, zero, one invoice number \$6.00, zero, zero, two, \$8.00, zero, zero three, \$9.00 and gives you the total so that generates the total. "...report of said total". That's this inventory total we're talking about here. "Said" is a fancy way of going back the way it was maintains that total, "generates at least one report of said transaction" so the total is in there and the transactions are in the report by the invoice number you identify it. It's over in there.

Now the next term here, "unique sequential indicia", that is the invoice number -- "and the description of articles" -- the description of articles was pants [sic] sweater, blue; the next one was sweater, yellow, some other description and so forth -- those description of articles -- so now we have unique sequential indicia. That's the invoice number and the description of articles in the sequential transactions. That's each one, the serial numbers on each ticket now and there's a description of articles on the tickets.

If you'll recall when they're printed out, the -- not only recall but it's right on there -- "the [105] unique sequential indicia and the sequential transactions being reconcilable against one another."

Now you can go out to this point which is how this thing works, this is Westview's brochure but you see -- and we're all familiar with this -- here's a batch of clothes or a package of clothes that's enveloped in a plastic envelope and attached to that envelope is this ticket that has been printed up, this invoice number and so forth so not only this is perhaps -- well, it can be anywhere in the system where this is so enveloped -- but you can look to see here the invoice number, which is the unique sequential indicia, and you can look at the list of clothes in this case one pants, black, CK -- maybe that means check -- and you can see is there a pair of black pants if you look in there or is there a gray suit, is there a pantssuit [sic], so forth so you can reconcile, which means check one back against another, you can reconcile to make certain that the invoice number which represents that transaction and the items identified with that transaction which are right here, the specific items are right here on the ticket. You'll go out and you'll simply -- I mean go to that point and when you say reconcilable, you'll see if they're there if one agrees with another.

We've gone through A and B. Shall I continue with C and D?

[106]Q Yes.

A C is a matrix printer. It works -- The data processor is what works it there "to generate a written record of the indicia associated with the --

The written record is the ticket. They have to print it out. The indicia that they're talking about is the indicia above associated with sequential transactions. It's the invoice number as well as the bar code. It didn't call for the bar code yet but it will. That's the indicia, a written record of the indicia associated with. That's the invoice number in the bar code. It generates that on the ticket. The written record. That's the ticket. I'll just put "ticket" here (Writing) "including -- Now the written record which is the ticket -- "including optically-detectable bar codes having a series of contrasting spaced bands".

There's no question of course on that. The bar codes are on there, on tickets printed out here. Here's Plaintiff's Exhibit 25 and Plaintiff's Exhibit 26. The bar code is down here in the bottom and seeing them right there which are printed right at that time, "including optically-detected bar codes" and that's the purpose of having a series of contrasting spaced bands. They have that. "...the bar codes being printed only in coincidence with each said transaction". Well, they don't exist. When [107] the ticket goes in there as brought out by Mr. Mikula, it doesn't have any bar codes. When it comes out of that printer, it's got them so they are printed only in coincidence with each transaction and the only printed ticket for each transaction. It's only printed when the goods are brought in at that time so -- "... and at least part of the written record". At least part. It could be the whole but at least part of the written record, "bearing a portion to be attached to said articles".

To be attached. In other words, when this ticket is printed here under here, it's to be attached to the said articles. Well, we can see clearly here on their own this is a written record attached to the articles of the individual articles there and they have an envelope over them and they're attached. You can go look at it and see if those individual things are right there.

This is at least one optical scanner connected to the data processor which it is connected through here at one point. You take this "Datascan" and you put a connecting line in there and so forth and, "operable to detect said bar codes on all articles passing a predetermined station".

Let's take the station, here. Whatever it is is a station and bar codes are being detected on all articles at that station. It could be when they're being sent out [108] the door finally when a customer comes or when or as stated in the operating manuals and that sort of thing you take a physical inventory, you go out and go wherever those things are in the system and you scan them to see what's there and what isn't.

" Whereby" -- we call this functional language. It's not part of D. Remember up here I said that was the preamble so this is functional language. It tells you, puts in there what the system does. "Whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom". Of course you know spurious is false or counterfeit or whatever you want to call it. The manual and everywhere else, manuals they have that but here showing you right here in this "Datascan" which is the opposite side of this after a physical inventory is taken by simply wandering -- wandering is the bar code -- on each invoice

hanging on line -- there you are -- "Datascan" will find all extra invoices and missing invoices, compute the inventory cash total and provide a printed record".

And again as Mr. Mikula pointed out here after it's been scanned, it shows a list of invoices so much on Plaintiffs [sic] Exhibit 8-B and missing invoices and the extra invoices so you see there's some invoices in there that shouldn't or some invoices that should be and weren't when [109] you're computing the total.

That is the way I would read that claim.

Q Have you reached an opinion as to whether Westview's accused inventory control system comprised of the "Datamark" and the "Datascan" infringes Independent Claim 1 of Mr. Markman's '054 reissue patent?

A Yes, I have reached an opinion and based on the analysis, of course, in more depth or extensively, I've done my opinion is that there is infringement of Claim 1 of the reissue patent in suit by the accused system that has been testified to here today.

(Witness resumed the stand.)

Q I would now like to direct your attention to Claim 10 of Plaintiff's Exhibit 1 reissue patent '054 and I'll put a blow-up before the jury that I'm going to mark for the jury as Plaintiff's Exhibit 1-B. This is much shorter. Would you please read the Dependent Claim 10 of Mr. Markman's patent on the accused Westview system?

A Yes.

(Witness stepped down to the board.)

I said this is dependent back on 1. The system of Claim 1 is everything here. I won't cover it.

In order to infringe Claim 10, you must infringe Claim 1.

Now further -- It's a further limitation -- It [110] means something that you have to satisfy more in an accused device. The accused device now has not only a cover now but blue. "Wherein the input device" -- that's the keyboard -- "is a keyboard having alpha-numeric keys".

Mr. Mikula testified to that and apparently if it's got numbers on there, it's got numeric. If it's got the option of having those keys -- and I'm no expert on this -- if you put in A, B and C, then you've got the alpha so my understanding is from the testimony and I think the description as I recall it in the accused device's operating manual they are alpha-numeric keys, "and also having keys specific to plurality of common attributes of the articles --

Here, for instance, plaid or red. In other words, you may have a red shirt but you may also have a red dress so that is what is meant by plurality of attributes of the articles.

-- "and common optional attributes of the sequential transactions, said common attributes being recorded using single key strokes." Of course they mean the common attributes of both of these so red for either a dress or pants is a common attribute and single key strokes.

Now common optional attributes of sequential transactions. For instance, there's a percent here. [111] Well, when I went to the cleaners the other day to get mine, they gave me a senior citizen's discount so that would be a percent that would be a discount off. I accepted it with mixed emotions but nevertheless, that would be the attribute there. I think it would come under 10.

Q Now, would you turn your attention to Claim 14?

A Should I go up there or come down here?

Q Either way. You can sit up there because I won't take the jury's time to go to the blow-up.

Before I go to 14 on Claim 10, did you arrive at an opinion as to whether the accused Westview system infringes Dependent Claim 10 of Mr. Markman's '054 patent?

A Yes, I did arrive at an opinion.

Q What is your opinion?

A That the accused system, Westview system does infringe Claim 10 of the patented suit.

Q Now turning to Claim 14 of Mr. Markman's '054 reissue patent -- I'm going to put it up for the jury but I'm not going to ask you to read through the blow-up of Claim 14 I'll mark as Plaintiffs [sic] Exhibit 1-C. Is Claim 14 an independent or dependent claim?

A It is an independent claim.

Q Did you read Independent Claim 14 on the Westview accused system?

[112]A Yes, I did.

Q Did you arrive at an opinion as to whether the Westview accused system infringes Claim 14 of Mr. Markman's '054 patent?

A I did arrive at that opinion, yes.

Q What is your opinion?

A My opinion is that the accused system does infringe Claim 14 of the reissue patent.

Q I'd like to return to Claim 1 for a moment, please. Perhaps it would be easier if you came down here so you'd be in front of the blow-up.

(Witness stepped down to the exhibit.)

Q I'd like to direct your attention to the particular language, " a data processor including memory operable to record said information, and means to maintain an inventory total".

I want to ask you specifically does Claim 1 in Mr. Markman's '054 patent require that the descriptions of each article maintain -- be maintained in the computer memory until the customer comes and gets his or her order back?

MR. GRIFFIN: Objection, Your Honor. That is a question of law for the Court and as Mr. Chovanes knows and the Court knows, the proper interpretation of that independent claim requires a review of the specifications [113] and drawing and also of the file and he's now asking for a legal conclusion from Mr. Chovanes as opposed to asking him for any type of factual testimony.

THE COURT: I'll hear it. Yes, sir. I didn't mean to cut you off.

MR. MALLIN: No, Your Honor, I do not after your ruling is favorable.

THE COURT: Okay.

BY MR. MALLIN:

Q Would you answer the question? Do you remember the question?

A I remember the question. I would prefer if the reporter --

THE COURT: No, just rely on your memory.

A The answer is no. I don't want to get a double negative there. No. That is, it does not require that it be maintained beyond ad infinitum.

Q Please explain.

A Well, here it says, "a data processor including memory operable to record said information".

It is required that the processor do remember and in fact the data processor does remember it. It remembers it until it's recorded on the ticket. Once it's recorded in the ticket, there's no need -- there's no requirement of the claim to maintain. The word is not up [114] in here: to maintain up in the memory operable to record information. It is not required to maintain.

Q What is required to be maintained?

A What is required here is to be maintained an inventory total which is a total of the price, the total price on each individual transaction so there must be a total of those transactions in the way that is shown on the ticket here in this exhibit. There is a -- the invoice numbers which indicate transactions. Each transaction is remembered here by an invoice number and then this is also maintained in the data processor, micro-processor is the invoice number and the amount on that ticket, individual ticket total, individual transaction total is maintained in the computer and then the total down at the bottom, the total down here on this ticket, that's the inventory total. That is required under the claim to be maintained. That's this inventory total here. Data processor including means to maintain an inventory total and we can see it does that.

Q Now does Independent Claim 1 that Mr. -- of Mr. Markman's '054 patent require that part of the written record, the ticket, be attached to each individual garment which is part of the transaction?

A No.

Q And please explain why not.

[115]A Well --

MR. GRIFFIN: Your Honor, for the record I'd note the same objection that I made to the last conclusion.

THE COURT: Of course, sure.

A May I answer that?

Q Yes.

A One of the ways is to simply look to the patent itself which is Patent Exhibit 1 and in numerous places throughout that patent in setting forth what is the best mode and so forth, they talk about the ticket being -- the tag being attached to badges, in other words, or badges they're alternatives but in four or five places in here there is a reference to a ticket being attached to batches of the articles so in the claim, for instance, in Column 4, Lines 48, the bar code tags which are the ticket here may be attached to articles of clothing and/or batches thereof for use with standing apparatus which would facilitate generation of reports according to the various things there but -- and in a number of places there you read that batches and/or means or batches, the bar code tags may be attached to articles of clothing or batches that are on there so clearly they're being attached to what we can designate here as batches but to the clothing, to the articles.

[116]Q In patent practice, is it customary to refer back to the specifications in the patent to help you understand what the claim is?

A Yes. If there's any perceived ambiguity, you may refer back to the specification to clear that up.

Q Is there a claim of Mr. Markman's '054 patent that does require the ticket or a portion of the written record to be attached to the individual articles of clothing?

A Yes. There is a Dependent Claim 5 that is directed to that specific embodiment.

Q I have a blow-up that shows -- Dependent Claim 5 is the one you referred to?

A I believe --

Q It shows several but it shows Dependent Claim 5. Using that blow-up which I will mark as Plaintiff's Exhibit 1-D, would you point out to the jury where that dependent claim requires that a ticket or a written record or a portion of it be attached to the individual items of clothing?

A Well, Dependent Claim 5, again you'll recall about dependent claims where here 5 is the system of Claim 1 so everything in the system of Claim 1 that we went through earlier is in Claim 5 and it goes on.

" Wherein the written record" -- that's the ticket -- that's multiple separate parts concurrently" -- Now [117] Claim 5 stands by itself. It's an entirely different claim. The plaintiff

is not claiming it's infringed but where there would be such an arrangement where the written record, the ticket, "has multiple separate parts printed concurrently" -- you can separate them -- "including a customer ticket, an establishment ticket and a plurality of article" -- that says tags there; that in a patent 2 is a typographical error -- that should be tags -- "at least one of the tickets and tags having a bar code printed thereon and each tag being detachable from the written record for direct association with at least one of the customer articles".

So that would require I think at least one direct attachment to at least one of the articles.

Q In patent practice, is it appropriate, is it an appropriate interpretation to take a new limitation in a dependent claim and put that back into the independent claim?

A No, no. Again -- I just pulled this analogy up but if the independent claim would say "of color" and the dependent claim says "blue", it doesn't mean you've got to take it back; just the opposite that you've got to take blue into the independent. The independent stands by itself. Dependent is specifically directed to -- And each claim stands by itself is specifically directed to, [118] for instance, a blue sweater. In this instance, Claim 5 is a specific claim directed to direct attachment on at least one article which would mean that the Independent Claim 1 on which this depends is broader so we're back to support for the argument that the specification says batches. You don't have this written record under Claim 1 is not required to be attached to each article. A batch of articles as you see so clearly here in Plaintiff's Exhibit 8-A where it's enveloped with this wrapping and then the ticket

is attached to those articles by those means provides the necessary support for that to read on the claim for the claim to read on that system.

MR. MALLIN: You can take the stand if you would.

May it please the Court, I offer in evidence the blow-ups marked 1-A, 1-B, 1-C and 1-D.

That's all I have, Your Honor.

* * *

[119]BY MR. GRIFFIN:

Q Mr. Chovanes, let's get right to the heart of it, okay? For your opinion to stand up, inventory has to equal dollars, doesn't it? It can't equal articles of clothing.

A The answer is that articles of clothing are included in the inventory so I can't answer -- I mean I just don't follow your question.

Q Well, then let's go put back up on the easel Plaintiffs [sic] Exhibit 1-A which was Independent Claim No. 1 and you went through all of this and you told us that the "Datamark"/"Datascan" system infringed for a lot of different reasons but you said it had a means to maintain an inventory total. For that to be right, inventory has to mean dollars, doesn't it?

A The inventory total referred to in "B" that you are pointing to there is in the accused device a dollar total.

Q All right. And given your interpretation and when you say inventory means dollars there, you need a system to make sure that it can detect localized spurious additions to inventory; somebody is going to put money into the till?

A I don't -- Is your question is someone going to put [120] money into the till?

Q The spurious addition means illegitimate addition, doesn't it?

A May I come down?

Q Please stay there.

A Well, I'll refer to the claim. I want to be careful that I answer your question based on my understanding so I must understand your question and then I will answer. Your question is as to the "whereby" clause, "Whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom"?

Q Yes, sir.

A And my answer is yes based on Westview's own representation.

Q So inventory there must mean dollars?

A It ends up in dollars but that's why your very first question when you said is inventory totally dollars, inventory is tied in with the transactions and the transactions very

clearly identify the articles of clothing. Those are identified in the written record so --

Q Let's go back?

A I'm not through with my answer yet.

So in the written record, there is a total at the bottom of dollars for that particular transaction on a [121] ticket and it -- that can be seen over on this exhibit.

Now that dollar total on the ticket is carried forward in the "Datamark" in the accused system but that dollar total is also reconcilable through the number with the articles so inventory -- although the inventory total carried by the accused system in the printout is a dollar total, that's reconcilable back with -- through the written record with the invoice numbers as well as the articles associated with that transaction so it is all tied together.

Q So you're saying, sir, and let me make sure I understand it, that the written record that reconciles all of this and allows the system to reconcile all of this is the invoice?

A The claim calls for it in those specific elements and the requirements of those elements. Included in the elements of the claim is the written record. It's one of the elements which is by the accused system which goes to this entire way it works, the way it works, the way you describe so a ticket and invoice or ticket, same words for both things, is part of what is called for in the Claim 1 and which is present in the accused system.

Q Sir, you didn't direct the jury's attention back to the patent itself to the specifications and the drawings until you wanted to deal with the question of whether [122] something was to be attached to individual articles. I'd like to direct your attention back to the patent itself and I'd ask you to look at Page 5, detail description of the preferred embodiments.

A Excuse me, Mr. Griffin, you're talking about Column 5?

Q Column 5.

A Yes, because there are two columns labeled on each page.

Q Look over actually at Column 6, sir.

A All right.

Q And it's describing what happens. "Information -- Talking in terms of articles of clothing and I direct your attention to the second full paragraph.

A Excuse me. There are line numbers.

Q I'll direct your attention to Line 20.

A Column 6, Line 20?

Q 20 right before the printed line.

A I have it.

Q It says, "This information is manually entered on a data input device especially adapted for drycleaning operations, and is stored in the system memory".

That referred to descriptions of the article of clothing?

[123]A Now we're reading as to how the preferred embodiment in the patent is?

Q We're looking at that and we're going to try to find out from all of this what inventory means, sir.

A You read correctly and are you asking me to define information now, is that --

Q Then do you think information there refers to information about the individual articles of clothing?

A Well, right up above in the sentence before it says, "The keyboard is discussed more fully hereinafter. At least information as to the customer's identity is required" -- That was the customer's number that we talked about in the accused structure -- "together with information as to the type of articles being deposited suit, color, so forth and the particular operations such as dry cleaning to be performed on the articles" and in particular, of course there's designated dry cleaning or laundry or provisions for that. "This information is manually entered on a data input device."

That was your question. The information set forth there is the same as the information that's being put in by the accused.

Q And it's stored in system memory then and the remainder is itself stored in the system memory. That's what it says there. The information isn't stored in the [124] memory system in the "Datamark", is it?

A It sure is.

Q It's stored in the system memory?

A It sure is.

Q And you can go back to this system and if you don't have the invoice, you lose it, you can say: What did Mrs. Jones' number, whatever her number is, order? What's it made of? You can do that with this system.

A That's not what it's saying in this preferred embodiment and that's certainly not what the claim requires. In the operating manuals, both '85 and '88 of Westview, the information that is put in as to garments, customer tag -- customer's number is stored. The claim calls for operable to record. Mr. Mikula testified when that information in the "Datamark" appears on screen, it is stored in the memory of that "Datamark" microcomputer, microprocessor. It's stored there and Mr. Mikula brought out how you can even revise that or get a print back on that until you finally push the total or the "Enter" key on that particular transaction so the claim calls the memory to be such and specifically, "a data processor including memory operable to record said information".

The "Datamark" processor does remember the description of articles and that satisfies the claim.

Q You're telling us because it keeps it there until you [125] print out the ticket, that is storing it in memory?

A Until you print out the ticket but finally the ticket is print [sic] out, it is still stored in there while individual lines of the ticket as Mr. Mikula said but essentially, right, I am saying that the claim is satisfied, Claim 1 is satisfied, the language of that claim which defines the invention, the limitation that the data processor includes memory operable to record said information. My testimony is that that data processor, "Datamark", has memory operable to record said information meaning as to the specific articles as well as the tag, the customer's number until the ticket is finally completely printed.

Q All right, sir. Let's try it another way.

Background of the invention. Paragraph 1. "Field of the Invention. This invention relates to inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment".

Do you believe, sir, that that inventory there is associated with cash?

A Will [sic], yes, it's associated with cash.

Q Does it mean cash?

A Sir, may I just explain that when you say associated with cash, the invention in the specifications where you refer to the background is patent practice to tell the [126] general area when you first get in. What is the area? This is the area

of inventory control and it gives broadly the area that it's entered into but I must get back to say to look to define the invention, you look to the claim. This language is simply background material and even at this point in the patent, you're simply giving what has gone on before and what the background is but in no way can you take each word and apply it to the definition of the invention. It just doesn't -- That's not patent practice.

Q All right. Let's just look at the claim without reference to anything.

A All right.

Q What you've labeled as Paragraph A --

A Element A.

Q Doesn't that just describe a typewriter?

A Well, a claim does not describe anything.

Q Let's put it differently.

A I'm not through yet.

The claim does not describe anything. It defines. It's laying out areas so you don't look to say does "A" describe a typewriter. It doesn't. It defines a certain element in a certain way so you look to see when you, just as we did it in determining whether or not a claim is infringed, you take the language of the claim and [127] and [sic] you apply it to the accused device or the element of the device.

Q I take it, sir, you're getting paid to testify here today?

A I certainly am. I have a big family.

Q How much?

A I am getting paid \$150.00 per hour which is my normal rate.

Q Now, you say Paragraph A defines something?

A Yes.

Q Can it define a typewriter?

A Is your question does it?

Q Is a typewriter a data input device?

A A typewriter has a keyboard. In that sense, you put data into that machine by virtue of a keyboard so in that sense, the term data input device for manual operation by an attendant, as to that specific language, the answer is yes, the keyboard of a typewriter would be a data input device.

Q Okay. And having a switch is keys operable to encode --

A Are you asking me that question or are you telling me that is the case? I mean if that's a question --

Q No, it's not a question.

A I'm sorry.

[128]Q When you go through this and if you took what you have labeled as Section A, a typewriter could be defined --

A If your question -- and I'm just trying to make certain we understand each other, Mr. Griffin -- if your question is does Element A -- could Element A read on a typewriter --

Q Yes.

A -- I will then answer that but I have to look at it so you'll have to bear with me.

"A data input device for manual operation by an attendant" -- You put data into it as I have testified. -- "the input device having switch means operable to encode information" --

Well, it encodes. In this instance it encodes it directly from the switches on to the paper so it's encoding information broadly. -- "relating to sequential transactions" -- Well, if you had a typewriter and people were there bringing in -- typewriter at the laundry, for instance, and one customer was coming in after another, it could type out individual tickets so that would be yes. -- "each of the transactions having articles associated therewith" -- So again the typewriter could be at the desk of the laundry and the person typing out and each transaction the articles would be there [129] -- "said information including transaction identity" -- Well, you could have a list and type on the customer's invoice number on a sheet or ticket so yes -- "and descriptions of each of said articles associated with the transactions".

You could type out the description and so forth so again to the question by itself would Element A read on a typewriter in a laundry receiving as we've set forth, the answer is yes.

Q Now I'd ask you to accept, sir, that the term data processor can be used to refer to a number of things and in a number of businesses refers to a clerk whose job it is to input data and and [sic] with that, I'd ask you if the paragraph that you labeled "B" whether that would read on a system that had a smart clerk with a pencil and a piece of paper?

A I'm drawing a blank as to visualize what you're saying.

Q A data processor meaning a smart clerk --

A Meaning not a machine but a person?

Q A person.

A I don't think data processor is used that way.

Q I believe, sir, that we can find plenty references to data processor meaning an individual who works in a data processing department whose job it is to --

[130]A But the data processor there would be working with a data processing machine. Is that your hypothetical?

Q He or she could be or he or she could manually --

A Does the person have a machine or not have a machine in your hypothetical?

Q No, sir, no machine yet. We'll add that later.

A And what is your question?

Q Doesn't that read on a smart clerk with a pencil and a piece of paper?

A Oh, I could never testify to that. A data processor reading this claim and looking what's involved including memory operable to record said information, that refers to a machine and means --

Q Well --

A Excuse me. I'm not through yet. I'm sorry.

"...and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the description of articles in the sequential transactions being reconcilable against one another".

No, my testimony with that element would never cover a person with a pencil. You look to what is the invention all about and such an interpretation would be [131] absolutely absurd. I would not practice patent law if --

Q Well --

A I'm not through.

-- if that was any semblance of logic or -- No, absolutely not.

Q Well, sir, let's go back. We're talking about an inventory reporting control system and you're saying and you've defined what inventory is going to be for us and I'd like to go through here and see how we can match it up to other things.

If we say, "a data processor" -- and we call that person a clerk -- "including memory operable to record said information" -- the person only has to have the mind to be able to write it down with a piece of paper and a pencil -- "and means to maintain an inventory total" -- that's the paper where he keeps the running list -- "said data processor having means to associate sequential transactions" -- which is to put down in your words a unique number with it -- "and generate at least one report of said total" -- that's to total it up at the end of the day, isn't it? -- "and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another" -- that's just looking on that list back and forth?"

[132]A Is that a question?

Q Yes, sir.

A Well, it's my really humble and respectful opinion you're totally wrong and just without any basis. The data processor here refers to a machine. We look to the patent. You

interpret the data processor. There's no ambiguity there. It's in reference to a machine. Now you then could take every patent virtually in the U. S. Patent Office and say: Can a person do that? Can a person do that? And that would be totally outside of any inventiveness.

Q Then it's correct to avoid something like that which is a literal interpretation of this claim, you go back and you take a look at the specifications, the file wrapper, the drawings to see what this patent covers and what these words mean, isn't that correct?

A I disagree that your representation is a literal interpretation of the claim. In patent practice, a literal infringement looks to -- you look to the elements of the claim and see whether they're present in the accused device in terms of what the patent is all about. This patent isn't about a clerk, as respectful as I am of clerks, it's not with respect to a clerk and a pencil. The patent by all we've described and all we've been talking about and all that's in a patent is with reference to a [133] data processor which is a machine capable and well known -- As Mr. Mikula said, he has been in the forefront here. He got into -- Microprocessors used to be big then they made them small. They put on the chips. I don't know anything about this data processor in terms of wiring and all that but I think that -- And this is written for a person skilled in the art. A person skilled in the art here would know what a data processor is in terms of it with the introduction of the chip in 1951 or 2. We all know that. I mean you go in, you don't have a clerk print out my credit card, things and all that. That's all done by what we call computers or processors or microprocessors

or data processors. It's all in that box there, mysterious there but that's what we're talking about.

Q What's the difference between a data processor and a microprocessor?

A I am not an expert in that. It appeared to me from listening to the testimony of Mr. Mikula that a data processor term covers a microprocessor. A microprocessor just seems to be a smaller, within the computer and chip technology, a chip where they do these marvelous things. They didn't invent this but the people who did invent these marvelous chips that he talked about all this stuff, vacuum tubes you'd need a room as big as this courtroom to do with -- I would say they're synonymous particularly [134] for this patent purpose as a patent expert.

Q Sir, is it your testimony here today that if this patent -- I guess -- Is it your testimony here today that this patent does not require the system to be able to keep track of individual articles of clothing?

A Well, again, that question has to be answered this way. It does keep on the tickets which are then attached -- which are to be attached and are attached to the batches, to the articles as called for in the claims, it does keep track. You can reconcile all the items on that and through the total, and through the invoice number the total and invoice number are back in the "Datamark", you can reconcile the whole works where, as they say themselves, whereby missing and extra you can find out where they are so you are in that sense if a person comes in and you do all those things and so forth, you are keeping -- you are reconciling with the invoice

number the articles and with the actual inventory of articles out on line so the claim, what the claim calls for is what I have gone over there in great detail and that's all present, that's the test of infringement. Are the elements of the claim or their equivalent present in the accused structure and we've shown how they are or I have tried to show how they are.

Q Any system that has a ticket, that is capable of [135] reconciling the inventory according to your testimony?

A No, I didn't say that any system. I said --

Q Well, sir --

A May I go ahead?

Q Yes. Go ahead.

A I'll let you go ahead.

Q I'll be happy to listen to your testimony -- explanation.

A My sole testimony is that the system that has been described here by Mr. Mikula, the system that's present in that table, the system that's set forth in Westview's documents from them in my opinion could for the reasons explained infringe Claim 1. Any other system -- you know, I haven't studied any other system -- could do all the work that's in this machine here far above --

Q I'm going to put on the easel Defendant's Exhibit 3-A. It's a blow-up of Claim 1. It's taken from the file wrapper.

Sir, you testified you reviewed the file wrapper for the originally filed patent, is that correct?

A That is correct, the file wrapper or prosecution history. They're generally synonymously referred to.

Q Do you recall this section from it?

A Mr. Griffin, with the Court's permission, may I come down and see if I can read it?

[136]Q Please do.

(Witness stepped down to the exhibit.)

A Okay.

Q Do you remember this, sir?

A Well, I remember it generally. I would appreciate being able to look directly at -- because that's a voluminous file -- anything associated with that.

Q I'll hand you what has been previously marked as Defendant's Exhibit 3 and ask you to tell the Court what that is.

A This appears to be and based on what I studied before seems to be a certified copy, that is, the Patent Office has run the copy and run the ribbon through and put the seal on. This is to certify a copy of the file wrapper and contents of the file identified above (Read) and this is a certified copy

from the Commissioner. It's a copy of that file of the original patent, application patent.

Q And this is from the original patent application?

A Yes.

Q Do you recall the portions here that are underlined are language which was added to the patent after -- added to the language of the claim after the application was initially rejected?

A Mr. Griffin, if you will bear with me, I'll get that part of this.

[137]THE COURT: I hate to bother you, Counsel. While he's looking for it, where do I look for what you're referring to? Can you tell me is it No. 3 in your book here?

MR. GRIFFIN: 3 in the book here.

THE COURT: Would you mind showing me?

MR. GRIFFIN: Sure.

(Counsel did so.)

THE COURT: Thank you, sir. Sorry to bother you.

THE WITNESS: It is on --

THE COURT: Go ahead, sir. That's fine. Go ahead. Don't wait for me.

THE WITNESS: Well, I'll wait for Mr. Griffin.

(Pause)

THE COURT: Thank you.

A If this purports -- and I just want us to understand one another before we begin to -- if this purports to be a copy of one page and these are the actual pages that were filed --

Q It's a copy of the claim, sir.

A Yes. It is not a copy of the one page of this. It's a copy of two pages with part of the second page. There are more than that but this portion down here is a portion of claim -- the next page but this claim here is Page 2 [138] for the record so we know what -- we know what we're talking about is Page 2 of the amendment filed by counsel on behalf of that received in the United States Patent Office on March 8, 1985 in Group 230 and this is the upper portion of this exhibit here is Page 2 of that amendment and what is your question?

A Now, is the words which are underlined represent additions which were made to satisfy the objections of the patent examiner?

A The words that were added and underlined were made by the applicant in what was called a response and that doesn't necessarily mean to "satisfy" some objections. Common practice is the examiner examines and offers suggestions. The applicant comes back and makes whatever changes he deems necessary for whatever reasons so I would say they

are at this point, I would want to simply qualify them as changes made in this instance to Claim 1 by applicant's attorney and specifically the language which is underlined was added during this activity, during this response and the language which is in brackets was deleted from what was there originally --

Q Thank you, sir.

A -- as filed.

Q And wasn't that language added and that language deleted after the patent examiner rejected the original [139] patent application?

A In the earlier office actions to which this is a response, there were -- Let me get to specifically the language so again we don't misinterpret. Prior to that response -- that's a part of the response -- the examiner, in the Patent Office on August 23rd, 1984 examined Claims 1 to 14 and he rejected Claims 1 to 14 but he rejected them on a certain basis and the specific basis that he rejected them over was prior art which included a steward(ph) record. These changes were made to distinguish from the prior art or to make more clear or for whatever reason as explained.

If you wish, I can go into what the applicant's attorney explained here.

Q Sir, let's take a language which was added so that this application satisfied the applicant.

A Well, I'm not conceding to satisfy it. Changes were made.

Q Changes were made in response to a rejection of the application, is that not correct?

A That is correct.

Q All right. Now let's first take a look at the paragraph that starts with the dot matrix printer.

A Okay.

Q Now in the original application, it required only -- [140] it described only that at least part of the written record bearing a portion to be directly associated with said art, is that correct?

A Well, are you referring to the -- You said to the dot matrix printer. Your question was again the original claim what?

Q When it was first submitted --

A Right.

Q -- the claim only required the written record to be directly associated with said articles?

A Well, specifically here again, the claim as originally presented said "The written record" and it had the word -- it did not have "including" but it had "comprising a plurality of optically detectable bar codes having a series" -- I'm sorry -- "a series of contrasting space bands, the bar

codes being printed only" -- it didn't have "only" then -- "being printed in coincidence with each said transaction and at least part of the written record bearing a portion to be directly associated with said articles".

That was the way the claim read as originally put in.

Q And and [sic] it was changed to say, "part of the written record bearing a portion to be attached to said articles", didn't it?

[141]A Yes. The "directly associated with" was deleted and inserted was "attached to" -- the words "attached to said articles". Of course, the articles here plurality remain the same. It was originally "articles" and continued the articles up there like we have up there, a batch of articles.

Q If we go back and look at what was added to Claim 1 after the initial application was rejected, we see in the first paragraph they added an explanation of the transactions, said, "each of the transactions having articles associated therewith", is that correct?

A Well, no. First of all, again you're characterizing as an explanation. That is not what a claim does. A patent claim defines, and that's very, very important and it added the language, "each of the transactions having articles associated therewith, said information". It added that language and which is as underlined there so it did it, not descriptive language. It's a definition. You look to see does the accused device come under that just as I have done so this now becomes part of those metes and bounds. It's as simple as that. You're adjusting the metes and bounds of

what you own by way of this invention here and what is defined so that was simply set in there as you see in that first paragraph.

Q And entire language which appears on the bottom of [142] the page and three quarters of this one, "at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station", is that correct?

A As I view it here, this paragraph here, the last -- This -- Wait a minute. All right. This was added. If I'm -- Let me just see what page is added correctly because we're dealing with two pages here, one added over the other. What you read was added. At least one, "said bar codes on all articles passing to a station", that was added.

Also what was added and presumably you want to bring this in although this was on the second page, this too is simply the page number. It doesn't mean anything except it was carried over to the second page but that's part of the Claim 1 that I read here so this whereby clause which we added the functional language was also added in that amendment which was in response to the examiner's rejection.

Q Sir, will you please take the stand again?

A Sure.

(Witness resumed the stand).

Q Sir, who drafts the abstract that is printed with the patent?

A The applicant or his attorney. Generally it's his [143] attorney that does the work.

Q So that person should understand what the patent covers, correct?

A Does that person understand what the patent covers? Well, yes, he's presumed based on information given to him.

Q Does this not refer -- I'm talking about the abstract on the first page of the patent which is the first thing that appears on the patent after the U. S. Patent documents and other publications, the first written prose paragraph is the abstract, is that correct?

A This is on Plaintiff's Exhibit 1 that you're referring to on the first coversheet which is sort of a summary sheet of what happened?

Q That's correct.

A And your question?

Q Does that explain in the abstract what the invention is?

A No.

Q What does it do?

A The abstract has been something that has been added in recent years. The purpose of the abstract is to permit a

classification in a general way or a general understanding of where the direction of the patent is, however, in the law or in the regulations I should say in [144] patent practice, I don't have it at my fingertips, but there's a specific reference to an abstract shall not be determinative in setting forth the scope of the patent so I'm willing to go through the abstract with you but --

Q We understand --

A The purpose of the abstract is not to interpret the invention or the claims.

Q The abstract gives you an idea, doesn't it, sir, of what the drafter thought of the claim?

A No.

Q All right. Then we'll skip the abstract. Does the specification, "which includes the drawing" explain -- You told the jury when you were referring earlier to the question of whether articles had to be attached -- I assume the records had to be attached to the articles of clothing. You referred back to the specifications and you said when you're not sure -- and this is paraphrasing you -- when you're not sure of what this means, you go back and take a look at the specifications, and actually when you interpret the patent, it's proper to look at the specifications and the drawings and the prosecution history, is that fair?

A Well, first of all, you mischaracterize some of my testimony. I was never in doubt from the claim itself [145] without going back that the reference to arts and specifically

-- and I'm not in doubt either that specifically the claim covers, "at least part of the written record bearing a portion to be attached to said articles". Articles is plural so without going back ambiguity or anything else, there's no ambiguity there. That refers to articles and we see them right here so they are attached to articles, however, I did say that where there might be any ambiguity, you can go back. There's no ambiguity here but if you go back, they're talking about batches perhaps in four or five places. I mentioned one but we can refer to the specification, to the drawings to further or whatever reason look to see perhaps there is something there but again the specification and the drawings are not determinative of the claims. The claims define the invention. The patent law requires you to give the best mode means, the best way you think but you could not conceivably give every detailed way that your invention could be infringed in a description.

Going to the claim language, it is totally improper to take one sentence out of context or something where it's the best mode, the preferred embodiment using both the same to say: Well, that's the way the invention has to work. You have to go back to the claim.

Q If we try to come up with a definition of the term [146] "inventory" and we go back and we look at the patent and we go through it and we see references to tags attached to articles of clothing, articles to be cleaned, laundry articles and/or batches thereof, given articles, inventory articles, identification of the articles, input of items, given articles, location of specific articles, doesn't it become clear that inventory refers to the articles of clothing?

MR. MALLIN: I object, Your Honor. He didn't direct to the witness where these quotations come from.

THE COURT: Overruled.

A Well, we look again to the claim to see what the language of the claim is. As far as articles of clothing, I've explained and will explain again the specific articles of clothing are a part of the written record. We can go to the ticket which is attached to the batches to this right in here and I can go and see -- I mean let me specifically take the ticket that is written out. It has the inventory with the inventory total in cash. There is on there an invoice number. Next to that invoice number, and the jury --

May I go down to point that out?

(Witness stepped down to the jury.)

(Continuing) Here is an inventory total as we refer to in the claim. It's \$188.87. In there are the [147] invoice number listings 314, 315, 316 with a separate 356 on each one, 275, 350 so there is a corresponding cash amount for each one of these invoice numbers.

Now with the invention -- I'm sorry. You were tied up there.

With the invention, you go and you scan the bar codes. That's the invention. You scan the bar codes and so forth, the bar codes that are printed at the time, and you find out what's extra, what's missing so you now can in here find the extra invoices, find the extra ones and missing invoices. You

would also reconcile by going out and looking to the invoice numbers, for instance, 322, you can look to see Invoice 322, the ticket here. See it says 322. This one doesn't but an example you can see the total here for 322. 322 it should be 350 so you'd see is there a 350 right here.

* * *

Trial Testimony of September 26, 1991 -- Volume II

[1] (Commencing at 9:30 a.m. there was an on the record side bar discussion after which the following proceedings were held in open court with the witness Chovanes resuming the stand.)

MR. GRIFFIN: May I, Your Honor?

THE COURT: Of course.

CROSS EXAMINATION (Cont'd)

BY MR. GRIFFIN:

Q Mr. Chovanes, yesterday you told us each and every element of a patent at suit has to be in the accused device in order to be --

A The element or its --

Q You gave us the opinion that the "Datamark" infringed the patent at suit. To get to that opinion you had to read and interpret the claims, didn't you?

A I had to read the claims on the accused structure, accused system.

Q And in doing that, you had to give some meaning to the words and phrases used in the claim, correct?

A That is correct.

Q Let's take a quick look at those but before we do and to make it easy for you and the jury, perhaps I can put this right up here for you. For the record what I have referred to as "this" is Plaintiff's Exhibit 1-A which had been marked up yesterday by Mr. Chovanes.

[2] In the first paragraph of that Independent Claim No. 1 it defines for us what said information means, doesn't it, sir?

A Said information, the answer is yes.

Q Said information including transaction identity and descriptions of each of said articles associated with the transactions, correct?

A Correct.

Q Now, let's turn to some of the words and phrases you had to look at yesterday and if you look at Claim 1 and if you can refer to that or if you're more comfortable just referring to the patent, I'll give you the line numbers, Lines 56 and 57 which is the paragraph which you've marked as " B" up there.

A Okay.

Q It talks about memory operable to record said information, said information meaning the information including transaction identity and descriptions of each of said articles associated with the transactions. For the "Datamark" to infringe, doesn't [sic] that have to mean capable of temporarily keeping the information until the ticket is printed?

A Including memory operable to record said information. Your question is in order for that to read on the accused system, the accused system must keep it in [3] there for a period of time short or long?

Q Okay.

A The answer is yes.

Q Now you will agree with me, won't you, that once the "Datamark" ticket is printed, the "Datamark" no longer has any description of articles of clothing recorded in memory, won't you?

A It's my understanding that the -- from Mr. Mikula's explanation and my reading of the operating manuals and the other material that the article descriptions are still in there. Now as to what you can retrieve, that's something else.

Q And the article descriptions once the ticket is printed is no longer there?

A My understanding is they are there. There is something like a production report which can retrieve those article descriptions. Now, that is not the inventory total but the end

of the day after printing all of the tickets, you can still retrieve from the "Datamark" a listing of how many sweaters just in total groups went in and how many total suits so the article description is in there but not with respect to this security aspect.

Q It doesn't tie to the individual transaction?

A That is correct.

Q So --

[4]A The article description, once the ticket is entered, when they say printed because it's being printed successively but the -- I mean the final entry, when you say "Enter", then for purposes of article description tying in the "Datamark" to the transaction, it is not in there.

Q That's right so to put it another way, once a ticket has been printed, the "Datamark" can no longer tell you what that order is comprised of?

A That is correct. That transaction is comprised of with respect to the indicia, the invoice number.

Q Now, sir, would you --

A It is on the ticket at that point and you can go out and look at it on the ticket and on the articles as you can see.

Q We'll get to the ticket in a minute, sir.

If you'll take a look at the patent, Column 6, Line 24 --

A I have it.

Q -- it's talking about the information and it says, " This information is manually entered on a data input device specially adapted for drycleaning operations and is stored in the system memory."

Doesn't that suggest to you that it's kept information a little bit longer than just the short time [5] it takes to print it out?

A On, no, I won't agree with that.

Q All right. Let's take a look.

A May I explain why?

Q No. You can explain when you're asked that, sir.

A Okay.

Q Please take a look at Lines 31 to 35. It says, "The processor is programmed to associate sequential customers and/or transactions with the unique indicia, generally a number, whereby the customer and/or transaction number can later be used to call up information associated with it".

Doesn't it suggest that it has to stay in the system so it can be recalled later?

A No. One, this is the preferred embodiment one way of doing it but the very fact -- statement, "whereby the customer and/or transaction number can later be used" -- and

you can use it in the "Datamark" -- "to call up information associated with it", meaning the transaction number, the customer number. That is the very heart in many ways the security involved. You can call up by using that customer number, you can call up -- the customer number or the invoice number, information --

Q What information can you call up from the "Datamark" using that number?

A I was just going to say that when you interrupted me [6] but I'll be delighted to continue.

The information that is called up is the sequential transactions by invoice number and the total dollars associated with each of those invoice transactions and then the total of all the invoice numbers which represent these transactions as to what is in inventory. That was the -- That is on that ticket on one of the displays over there.

Q Please get to the ticket. Let me digress for a second.

Do you agree or disagree with the following statement and just please answer yes or no: "In interpreting a claim of a patent, one may properly look to the prosecution history of the patent and to other --

A I didn't quite catch -- Did you say one may?

Q One may look to the prosecution history of the patent and to the other claims in the patent.

A As a general statement with respect to patent practice, that's a valid statement.

Q The way the patented system works, the unique indicia, the individual number is what is used to call up information about that order, is that correct?

A Well, when you say the patented system, we must go to the claim. What does the claim define?

Q Would you answer that please, sir, yes or no and if [7] you say no, we'll go on to something else and then if you say yes, we have finished the question?

A It can't be answered yes or no because you're characterizing the patent system and I'm just saying you're not characterizing the patent system correctly. The patent system is characterized as what is defined by the claim.

Q Yesterday we talked about your interpretation of the word inventory as used in claim No. 1. Now I'd like to direct your attention to the patent Column 9, Lines 50 to 61.

A I have that, Mr. Griffin.

Q And that says, " In this respect each unique number or code or other indicia associated with an article or that transaction remains alive until all of the articles is completed and delivered to the customer together. Therefore, the inventory can be reconciled at any point in the sequence. Upon sorting or unsorting the batches, for example, at sorting stations, optical scanning inputs data to reconcile the inventory with the expected inventory. Any loss of articles

or errors in entering data can be immediately reported before the physical association of given articles to a given customer is lost."

Does that suggest to you that using the -- using inventory it means to include the articles of clothing?

[8]A Again, this is one preferred embodiment. It doesn't suggest that by the only way --

Q Sir, let's look at Column 7, Lines 35 to 41.

A I wasn't completed with my answer. May I complete the answer?

Q Please complete the other answer.

A The suggestion there in that one example and that's really only what is being given when you say preferred embodiment or best mode, that's an example. It indicates in that best described mode, which is not the invention designed by the claim, you go to the claim for that, but it would suggest there that an inventory cash total would be adequate or would be within the scope.

Now I'm sorry, you went to another --

Q Why don't we then take a look at Column 7, Lines 35 through 41?

A Column 7 --

Q Lines 35 through 41.

Do you have that, sir?

A I do.

Q And it says, " Unlike the conventional laundry operating system in which pre-printed alpha numeric character labels (i.e., using Arabic numerals and letters) are attached to articles or containers for articles in inventory, according to the invention custom-[9]printed bar code labels are used".

Doesn't that suggest to you that inventory includes the articles of clothing?

A No. In the term that the inventory is used there and that specific -- what you read emphasizes that where printing the ticket, the ticket is being printed at the time of the transaction and it goes on to then say, " These tickets are attached to articles" -- just as we see it there -- "for articles in inventory".

Well, those articles are in inventory. The inventory is what the inventory control system as "Datamark" and "Datascan" and as defined by the Claim 1 is directed to the cash total inventory which as I stated yesterday, that ties in with what the articles are there. You can start with the cash, check out the articles by going to where the tickets are attached to the batches there and see that the articles are there but I think that statement is consistent with the invention.

Q Well, then, let's take a look at Column 8, Lines 21 to 23 where it says, "The garment tags and customer ticket

associate a unique indicia with transactions, persons and physical items in inventory."

Doesn't that suggest to you that the way this system considers inventory it considers the articles in inventory?

[10]A Well, again, it's the preferred embodiment but I think that very statement supports the reading of Claim 1 --

Q All right.

A -- which covers the accused system. If you read that particular statement that you read, the garment tags and customer ticket, now we have the customer ticket -- associated unique indicia -- that is the invoice number and bar code which is the same as the invoice number with transactions, the transaction being that group of items that are brought in -- persons and physical items in inventory.

Q That's right.

A Well, the customer ticket has on there the invoice number. It has the customer, the person is the customer, tag number that identifies the person and physical items in inventory. The physical items in inventory you just look there, see what's on that ticket: One brown suit, one blue coat, you look in the package that is right there, the thing you -- and and [sic] you see whether it's there so I think that statement although again, it's a preferred embodiment or a description and not controlling on the definition of the reading of Claim 1, I think that is right on point with what the accused system is doing, the "Datamark" and "Datascan" system.

[11]Q So you think the ticket, not the system is the important thing for tying it all together and giving you the description of the individual articles?

A On, no, I didn't say that. I didn't say that ticket is important. I'm continuing. You asked a question. The entire claim defines the invention. The claim does include a written record which is a ticket. If we didn't have any ticket here, if there was no ticket, I wouldn't be sitting here. I would say no infringement. How could I say that? So as an independent person here, consultant, I have to look at this whole thing in the way I'm looking at it and be totally objective and the written ticket is part of this system. It's called for in the claim so it's got to be present but it's one element in a claim.

Q Sir, let's go back to the claim and Claim 1 and in the patent, Lines 59 to 61, that's your Paragraph " B" still. That's the unique indicia.

Looking at this, doesn't that require a data processor having the means to generate at least one report of said total and transactions" [sic] plural, then going on, and I'm paraphrasing now, in which the descriptions of the articles are reconcilable against the unique sequential indicia or in this case invoice number?

A And, Mr. Griffin, what's the question?

Q The question is isn't that what that requires?

[12]A What the unique and -- and I'm taking --

Q Let's break it down if you're having trouble. You have to have a data processor --

A I can answer that question. I'm not having trouble. I just want to make myself clear to everyone.

Q Since it's got a couple parts, let's take it piece by piece. The data processor has to have the means to generate at least one report of said total and said transactions and transactions is plural, correct?

A Is your question in this statement "means to maintain an inventory" --

Q No, sir. The question, sir, is it says a data processor having means to associate -- taking the means to associate -- and to generate at least one report of said total and said transactions, the data processor has to be able to prepare, have the means to generate at least one report of said total -- total referring back to earlier -- and said transactions, transactions referring back to earlier in the claim, correct?

A Well, your earlier question that you didn't allow me to answer was transactions plural in there. I just wanted to make clear as to where you're talking. I'll answer that question.

Q Right at the end of your bracket thre, [sic] sir.

A I know where you're referring. The word here is [13]transactions so as to the question is that transactions plural, the answer is yes that word is plural. As to the second question you asked me, you asked me whether the

claim requires that at least one report of said total and transactions as required here. The answer is yes and the accused system does it and I was pointing out right on the ticket there that it gives the report of what is called for there.

Q Well, let's take a look at that then for a second.

A I'm trying to answer the question and if you interrupt when I haven't completed it, fine.

Q Go ahead and complete it.

A So it does generate a report, at least one report of said total and said transactions.

Q Sir, is your testimony that the report, the one report is the ticket?

A No.

Q All right. How does --

A It hasn't been --

Q Then tell me how the one report of said total and said transactions have the unique sequential indicia and description of the articles in the sequential transactions being reconcilable against one another?

A May I go to the ticket over there?

Q Please.

[14] (Witness stepped down to the exhibit.)

I'm sorry. I wanted to get the claim language.

Q Here's the claim language. I thought you wanted to look at the ticket.

A And both. I'm sorry.

As to what I understand, Mr. Griffin, your question is this. We have -- In reading the claim on the accused device, the claim states, "A data processor including memory operable to record".

Now we already reported out in memory.

Q Mr. Chovanes, I'm not asking you to go over everything you went over yesterday. The one or two points we're talking about now is in response to my question that it does generate at least one report of the total and said transactions, plural, and it continues there. It says unique sequential indicia, which are the invoice numbers and the description of the articles and the sequential articles -- that's the articles each time somebody brings something in -- has to be reconcilable against one another. I want to see the report that does it.

A I was simply trying to answer one of your questions that you asked about three questions ago and interrupted. You said is the --

Q Would you answer the question?

A -- is the printed report the ticket? I'm trying to [15] distinguish so that we don't get confused there is in answer to your question -- I'm honestly trying to answer your question. You asked me whether it's the ticket that is that generates at least one report. My answer was no. I'm simply trying now to explain why it isn't the ticket and what is that written report. I want to make clear, because this is important, that when we talk about a ticket, we're talking about this that is attached to the garment, to be attached to the garment, to be attached to the batch here. When we're talking about a written report, we're talking about this written report that comes out of the "Datascan" and that written report that comes out of the "Datascan" which Mr. Mikula showed how that comes out and out of the other, that written report -- out of the "Datamark" II, that is, a said data processor having means to generate at least one report of said total and said transactions and the said transactions are which are identified here. Here's what we're talking about on that report. Here's that from the accused system. Here are the transactions.

Q Sir --

A I'm not through with this, Mr. Griffin. I want to explain this. You asked.

Here are the transactions 1-4, 1-5, 1-6. Here are the total for that transaction in dollars. Here is [16] the inventory total. This inventory total is this word "said" total here. "At least one report of said total" and the total is associated sequential transactions to generate at least one report of said total. That's the said total and said transactions, here are the said transactions.

Q Doesn't it continue, sir, "the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable one against the other"? Would you point to me, sir, where on that report does it have any descriptions of articles?

A This is not tied in with that report by a requirement of that. You see there's a comma. Now this is another limitation. "... unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another". Here where they are on the ticket they're reconcilable. That limitation is not put back in with the said means to generate that. That limitation which you're referring to the unique sequential indicia, this is the invoice number as well as the bar code, "and the description of articles in a sequential transaction being reconcilable against one another", that's referring here in terms of defining the invention that reads on what is done here.

Q You're saying, sir --

[17]A You go out and you look at the ticket, you look at the items on the ticket, you see if they're present there and you see the transaction, you have the number of the transaction there.

Q Wouldn't that be true in a manual system?

A I don't know what you mean by a manual --

Q If somebody wrote out a ticket and you put a ticket number on it and wrote out what all the items are, that's

how they would reconcile what's there and it's a unique sequential indicia but you're only looking at one transaction there, aren't you, sir? You're not looking at all of them.

A You have a lot of questions in there and I'm not clear which one you're asking. If you'll ask me one question and I'll --

Q Let's go back to the patent then. How many transactions are reflected on that ticket?

A Now by that ticket are you referring --

Q The one that you're pointing to on the exhibit where you have your pointer.

A That's Plaintiff's Exhibit 8-A.

Q Yes, sir.

A There is a ticket which is rather large with a person scanning the bar code on that ticket so I'll refer to that and your question is how many transactions does that [18] ticket represent?

Q Yes.

A And the answer is one.

Q How does just that ticket reconcile the unique sequential indicia and descriptions of the articles in the sequential transactions against one another?

A Well, you have to go if you want to say more than one transaction on one very clearly that is shown here on Plaintiff's Exhibit 8-A where you have two batches. You'll have one ticket which is that transaction, the blue on this blow-up so you reconcile that transaction with that ticket. You go to the next ticket and you reconcile that description. You have the invoice [sic] number in there with the read.

Q Sir, is that anything other than the physical --

A You reconcile the transactions by going to each ticket on line.

Q Is that anything other than taking a physical inventory?

A Well, what do you mean by physical inventory?

Q If you say you have to look at each ticket and count each little item because you're doing it manually, isn't that a physical inventory?

A Well, I don't know what you mean by physical inventory. As part of the system, as part of the system, [19] that's part of the entire patent that is involved in Claim 1 so that's what you do within it. Now if you say is everything in here totally never heard before, well, I don't think there's a patent in the whole world that doesn't have elements --

Q That wasn't my question, sir.

A Well, if you're saying physical inventory does that involve a human being looking and counting, I don't think this invention purports to limit a human being's activity.

Q Sir, isn't this whole section that you are talking to us about deals [sic] with the data processor and what its memory is capable of doing?

A Well, you can't generalize, Mr. Griffin, like that. You have to go through a claim and that's patent practice. You don't come up with a sweeping statement. I have labored, and you have to do that, to identify each item but that's the nature of items. You must go through each item and you can't generalize just as if on a land deed you can't roughly say 500 feet and 6 inches. You've got to laboriously pace it off so I really have to go through it the way I am. I've been doing that for 34 years.

(Witness resumed the stand.)

Q I'd like you to take a look at the patent and here to give us a help if you would look, sir, at the first claim still and now it's Column 10 and it's the Line 67 through [20] the top of the next page, Column 11, doesn't that say, "The written record including optically detectable bar codes", codes plural?

A The word codes is plural, yes.

Q Would you show me where there are bar codes in plural on the "Datamark" system?

(Witness stepped down to the exhibit.)

A Right here. (Indicating).

Q That's a single bar code, is it not?

A No.

Q It's not a single bar code?

A May I answer that? This is referred to as bar codes. It also can be referred to as a bar code so really you're talking as to two descriptions. The patent says bar codes. That's really grasping here, Mr. Griffin, when you say -- Bar codes is totally referred to as -- It's a bar -- I'll explain why and I'm not an expert but based on what Mr. Mikula has said, you see --

Q If you're not an expert, sir, and you can't explain, I don't think you ought to because it's not proper testimony.

A I listened to Mr. Mikula very carefully. He's a tremendous expert.

Q Then we all did.

A Let me explain why it's a bar code, it can be [21] determined a bar code. These series of whole things here represent this number up in here. It's the same thing so you look and find five spacings make one number so you could say five spacings, a thin, thin, thin, thin, fat. That represents one number. That would be one traditionally. Fat, thin, thin, thin, and a little bit more space thin, thin, that represents another. Fat, fat. It's like the semaphore(ph), you used to do that, so now when it runs there, it reads up in there it reads it boom, boom, boom just in the wink of an eye so it's reading zero, zero, one, eight so it's a code in the sense that each grouping of five represents one code for a number one then the next grouping of five represents code for number

two then the next grouping for three so there are codes for individual numbers but if you want to call the whole thing a bar code, now it's called codes or code so this is a -- These are bar codes.

Q Sir, would you take a look at Figure 2 in the reissue patent? I'm putting this up on the stand. It's a blow-up. It's Exhibit 4-A. It's a blow-up of Figure 1 and Figure 2 in the reissue patent.

A Yes.

Q Figure 2 is a depiction of a ticket, is it not?

A Yes.

Q And it has multiple bar codes on it, does it not?

[22]A It has bar codes plural, bar codes.

Q And there are as I see one, two, three, four [sic] five, different lines of code?

A That is true. This would be bar codes one, bar codes and then it's my understanding this is repeated here.

Q That is a written record including optically detected bar codes, plural, correct?

A This has -- That's bar codes up in here and this is bar codes. This, incidentally, so we're clear, this is one embodiment of the invention. That is one in which you would take a ticket and you would split these up. These are

intended to be separated, these bar codes down in here and then you would attach them to individual articles or individual batches or something in here but you must remember again this is one embodiment. It's covered by a separate claim. We talked about that. We're not claiming, that is, the plaintiff is not claiming that this is infringed so this is merely illustrative of one way the invention can be used but again, the specification sets forth the best mode how one way the invention can be made -- can be used but the claim defines how all these things can be used. This is one embodiment and this is not -- this kind of ticket that's split up is just one possibility that you can use and it's not being the claim that's being infringed here.

[23]Q Sir, you just said best mode and you referred to best mode yesterday. Does that mean generally that in disclosing the invention to the Patent Office and disclosing it in the patent the individual has to set out the information necessary to let someone who would be skilled in the art reproduce it so that after 17 years when the patent expires somebody could look at it and take that patent and build the thing which is describe?

A Yes.

Q And --

A And even before that on a standard so they can make additions to it or noninfringing or something but the answer is yes to your question.

Q If you would look, sir, at Claim 1, Line 11, Column 11 on yours, Column 11, Lines 4 and 5 --

A I have it, Mr. Griffin.

Q -- that's where it says, "bearing a portion to be attached to said articles", correct?

A I see that.

Q When the claim was rejected, that said, "directly associated with", did it not?

A Well, again I want to make perfectly certain that we are discussing correctly. Could you let me have it?

(Exhibit was placed in front of the witness.)

A This is what we were discussing yesterday as being a [24] copy of one sheet.

Q So the record is clear, that's Defendant's Exhibit 3- A?

A But I would also appreciate having the certified copy of the file history from which this was taken.

Q I'm handing you, sir, Defendant's Exhibit 3 from which Defendant's Exhibit 3-A was taken.

A Thank you.

(Exhibit was handed to the witness.)

Q I have a very simple question.

A All right. Let me just get this here if you'll bear with me.

A Okay. I have the corresponding page here. Yes, Mr. Griffin.

Q Where in the "Datamark" system is the written record or a portion of it attached to the articles of clothing?

A Well, we will go to the specific language here. "At least part of the written record" -- that's what's required here -- "At least part of the written record bearing a portion to be attached to said articles" -- That's what you're asking me. If we look to here, this is at least part of the written record is the written record at least part of it is attached to said articles.

Q Well, sir, isn't that attached to the plastic bag?

A Here are the articles the batch I was pointing out. [25] Here are the articles. They're enveloped by this plastic bag. They're grouped together and the ticket, the written record is attached to these articles.

Q That's attached to the plastic bag there, isn't it, sir?

A It is stapled or otherwise pinned or something to the plastic bag.

Q Have you ever picked up your suit from the drycleaners and seen one of these tags that are actually attached to the suit?

A Yes. I might be wearing one with one on now.

Q So that a tag attached to as opposed to associated with, correct?

A Not as opposed to, no.

Q All right.

A I mean attached -- To me I have absolutely no question that the tag is attached to the articles.

Q All right.

A When you envelope it with -- I mean you could say well, the ticket is right on that bag and that bag -- As a matter of fact, I find a lot of things more difficult -- I find it difficult to get those batches of clothes from the bag and ripping and pulling and doing all of that so I think they're attached pretty well.

Q All right. Now, sir. Let's take a look at [26] Claim 1, Column 11, Line 6 and it says, "at least one optical scanner connected to the data processor".

Do you see that, sir?

A I do. That's this right here what I've designated as "D". One optical scanner --

Q Do you know what an optical scanner is?

A Based on what I have learned here and in the case and so forth, it's that scanner there.

Q The optical scanner is just this part, isn't it, sir, and I'm holding up the wand?

A The wand?

Q That's correct.

A I'm no expert there but I would say that's an optical scanner, yes.

Q The wand is the optical scanner?

A I would qualify that further. If we simply chopped the wand off, that is, chopped it off the cord here and so forth, I don't think you'd have much of an optical scanner. An optical scanner has to go into something.

Q That's what we're talking about.

A All right. Your question to me, just so we understand one another, is the actual pencil or whatever it is there with the little eye, is that an optical scanner? My answer is yes.

Q Where on the "Datamark" system is the optical scanner [27] connected to the data processor, "Datamark"?

A Well, two things: No. 1 --

Q Could you just tell us where?

A I will answer you in the best way I can and that is that when the system was demonstrated by Mr. Mikula in the manuals, in the descriptions, you take and you connect the

"Datascan" er [sic] which is designated as the datascanner to the "Datamark" so, you know, the ankle bone is connected to the thigh bone and the thigh bone is connected to the knee bone. You've got the scanner into the processor.

Q This whole thing is a bar code reader, is it not?

A Well --

Q The whole thing I'm referring to is the datascanner unit. It's a bar code reader because it has an optical scanner attached to it and it has internal processing chips to enable it to read what the optical scanner scans.

All I'm trying to find out is where is an optical scanner in this system, the "Datamark" system which you say infringes, where is an optical scanner attached to the processor, the "Datamark" itself?

A Again, you have many questions in there. I'll take one at a time and I'll answer them all as to the best of my ability.

Your first question as I understood it, you held up the box that is attached to the optical scanner and you [28] said: This is a reader. Well, whatever Westview wants to call that, okay. I don't care what they call it. If you're calling it a reader, okay. However, it is simply this. Whatever is in this box, and I'll refer to this right in here this box here, it's connected to that "Datascan" box. As Mr. Mikula has testified, there's a processor in there. As a matter of fact, you could take that, maybe you can print out from that. However, a critical part of the system, of the accused system -- it won't work otherwise -- is you've got to have an

umbilical cord there and it has to be tied in from the "Datamark" into the scanner here. You have to unload those and you do it here -- In your descriptions, you unload into this so I said there are 2 reasons: No. 1, you are connected. It happens to be -- if I may walk over here -- that it is not connected at this point. The reason you break the connection is so you can go and walk around and make a portable thing plus the fact you can serve more than one "Datamark", however, certainly it's connected through to the processor to in fact both processors. You have a data processor in the datascanner and you have a data processor in the "Datamark".

It's basic patent law if you can avoid a patent by breaking something down into two instead of one, patents would be laughing matters.

[29]Q I believe, sir --

A If the claim were going from Market Street to City Hall -

Q Mr. Chovanes, the Judge will tell the Jury what law is applicable here I'm quite sure.

Does Figure 1 in the patent show a -- I'll hold up Defendant's Exhibit 4-A for the jury. Does Figure 1 show an optical scanner attached directly to the data processor?

A In the best mode which is shown here which was required but only an example of what is called --

I can point to the jury on that, sir, before you remove it. I think -- The answer would be yes. We happen to have two on Figure 1. This is apparently a busy place. They're showing two on here. But there's a "Datamark" here -- I'm sorry. It's illustrative of the thing. Here you do have a computer, the input the data processor, the input so Mr. Griffin's question was is the scanner directly connected and the answer is yes it is tied in there but that's one embodiment, the best embodiment. To take the invention and simply say we're going to unplug the scanner and later do it -- later plug it, you can't do that.

Q The datascanner you told us is portable, right?

A That is correct.

[30]Q And it can be moved any place around in the dry-cleaning establishment?

A Or to another drycleaning establishment.

Q Where is it connected to the data processor and operable to detect bar codes on all articles passing a predetermined station?

A All right. The reference there as I understand it is to "D". "At least one optical scanner" -- we've determined that -- "connected to the data processor". You have my basis there of why I say that's the case because we've been discussing it -- "and operable to detect said bar codes on all articles passing a predetermined station."

Well, again I can go right here to this blowup, Plaintiffs [sic] Exhibit 8-A, and the the [sic] optical scanner is optical to detect -- operable to detect bar codes on all articles passing a predetermined station. Here's a predetermined station. It simply means one place. A predetermined station can be right here with the articles passing or they can be in a group and you walk down the articles. As to whether the person is moving, again you can't invade patents by saying: Well, we're not putting the articles past the station, but the person is moving down the line. We're keeping the articles steady. We're keeping the articles stationary so again you just can't do that.

[31]Q Sir, let's take a look then at what this patented system says, not what you'd like it to say but what it says and it says, "at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station, whereby said system can detect and localize spurious additions to inventory as well as spurious deletions [sic] therefrom" and if you don't have a fixed point and you're not always monitoring at the same point, how are you going to detect and localize spurious additions to inventory as well as spurious deletions therefrom?

A Very simply and it's shown right here.

Let's take 10 packages, 10 bundles. 10 of these batches are hanging on the line and whether it's 10,000 or 10, the same principle would hold but you have 10 of them hanging on the line now. You have the "Datamark" is sitting over there. The operator, the person here just as shown in Plaintiff's [sic] Exhibit 8, now takes and goes down and

scans every bar code, the bar codes on each ticket on those 10 batches that are hanging there. Now that is then read into the processor. A ticket is printed out as shown here on the reverse of -- not a ticket, I'm sorry, a report -- Plaintiffs's 8, Exhibit 8-B and Mr. Mikula showed how that printer is there, is put on to the "Datascan", then there is printed out the -- as shown [32] here listed invoices, extra invoices, missing invoices, total of them missing. So it now as pointed out again in "Datascan", Exhibit 8-B here and after a physical inventory is taken by simply wandering, wandering in quotes, the bar codes in each invoice hanging on a line just as is done here. "Datascan" will find all 'extra' invoices and 'missing' invoices, compute the inventory cash total and provide a printed record" [sic] which is here so that's precisely how the accused system, how we can read this limitation on the accused system.

Q How does that tell you that somebody took a sweater out of -- a green sweater out of Mrs. Jones' order?

A Well, what you do if someone -- you want to check whether Mrs. Jones' order, green sweater has been taken out, you then go to the claim. What does the claim call for? We went over that.

* * *

BY MR. GRIFFIN:

Q Mr. Chovanes, with the "Datamark" system, if the ticket is lost, is there any way of telling what articles make up that order?

A You'd probably have a complaining customer. They'd tell you what's in it but I think trying to answer it as I understand it, I haven't thought of that but I would say no that it is -- If the ticket is lost, what articles are missing, I would say no way other than relying on the customer.

Q Under the system claimed in the patented suit, it would be possible, would it not, to reconstruct that information?

A Well, again, we're back to the claim. The claim covers what the accused is doing so under -- The claimed invention in, for instance, the preferred embodiment where you might have as in Claim 5, that I said was a dependentt [sic] claim, there you're attaching the written record or part of the written record like in, for instance, Figure 1 that I showed there where you're attaching a tag directly to that garment, the individual garment and the individual garment continues to be listed in the data processor. In that embodiment, you could find the individual patent. The claim also covers the present version. The claim does not require anything beyond what is stated as we have [34] put it forth so the answer to your thing is the claim covers the accused structure as it operates.

Q That's right because part of the things that in going back to this claim would do, this system would do with the -- what the "Datamark" system doesn't do is, "the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another" and you can get a report of that, is that correct?

A First of all, this system -- You opened up your question with "this system". What system are you talking about?

Q Let's talk about the system claimed in the patent and in Claim 1.

A The claim -- The invention covered by Claim 1, all right. Now what is the question with respect to that?

Q That invention if the written record of the transaction was lost would still be able because it can generate a report.

A No, no, no because the claim covers all these versions.

Q Let me --

A You're taking -- You're constantly missing the point that when you're required by the best mode and the reason you're required by the best mode the law doesn't -- and [35] you may change later on. You may say: Well, I had three versions the best mode now wasn't the best mode because we can't see in the future totally but the best mode means that they don't want the inventor coming in and -- Because you must remember what the -- why you're getting a patent. You're getting a patent because you're disclosing an invention. Then you get a definition with the claim but they don't want an inventor coming in and telling what may be just a version that's not very good but he's keeping the good version as he thinks in this end under wraps so he's got to put forth what he believes the best mode is.

Mr. Markman through his attorney set forth one version. Now you cannot read that version as you're constantly doing as to the claimed invention. The claim sets forth the invention. That includes whether or not as we're doing in this instance, the missing ticket that you're referring to, then

you don't know what article is missing there but you look to the claim. The claim says the ticket is printed up reconcilable. They are reconcilable.

Q Sir, isn't one of the stated functions of this patented system the tracking of articles through the drycleaning process?

A It's an example of a function again set forth -- Are [36] you referring to the specification, some specific place?

Q I was going to direct your attention, sir, to Column 2, specifically Line 50 through Line 57 where it says, "Article identification, customer identification and descriptions needed for generation of cost and pricing reports are entered and the articles to be cleaned are associated with a unique bar code indicia for later automatic or semiautomatic optical scanning and data input", and then the important language, "whereby the progress of articles through the laundry and drycleaning system can be completely monitored".

A First of all, it does state that. You're reading correctly but again that is background of the invention. It's giving some -- what the inventor feels is what some of the things the system can do and it can do those things but those are not the claims that require that. The accused structure is by its very own admission doing certain things. One of them is locating missing and extra invoices. The claim comes right within the claimed structure, Claim 1, so as to the specification again, yes, they stated some of these things but that again under patent practice if you read all the description back in the specification of the best mode and now are attempting to read all that as being necessary in the

claimed invention or accused device, it's just not correct. It's [37] just not patent -- the way patents are done and on top of it, it would render every patent worthless because you could pick out one statement and then by hindsight say: Aha, you said we're doing this; we're not doing that. You said it should be a red data processor; ours is blue and that's really what some of the arguments here on something like that come down to.

Q Sir, especially when a claim is unclear or can be read in a number of different ways, isn't it important to go back and look at what the inventor says in the background of the invention and look at the specifications for guidance to see what it means? Is that a yes or no?

A Well, as a broad statement, it goes back to what you said first. You do look at the specification, you do look to the drawings if there are these ambiguities. There are no ambiguities here. You read it in view of what was stated but you look to the claim language over and over. This is patent practice. You look to the claim language. Again it's simply like you -- I can say to you: Look, boy, our property out there is great; it's got trees. May or may not be true. That doesn't define my property. When it comes down to it, when I'm selling my property to you, you're going to look to see what property do I have. You look to the description, the metes and bounds, so many feet that way, so many feet that way and so many feet [38] back. That's what the claim does and the information that discloses on the best mode and the preferred embodiment is certainly a part of the patent but the claim is what defines it and here very definitely --

* * *

[39] REDIRECT EXAMINATION

BY MR. MALLIN:

Q Under patent practice if the preferred embodiment, the description of the structure of the system describes two possible ways of doing something, does that mean that you have to read both possible ways into each claim?

A When you're reading it on the accused structure, no. You can take one of those two and either one to read it on the accused structure.

Q And if you have two claims, one of which claims it by doing it the one way and one of which claims it by doing it the other way, is that in accordance with normal patent practice?

A Yes.

Q Does Westview's accused system infringe Claims 1, 10 and 14?

A Yes.

Q Does Westview's accused system infringe Claims 5, 6 and 7 that I put up on the board?

A No.

MR. MALLIN: That's all I have.

[40] THE COURT: Thank you, sir.

THE WITNESS: Thank you, Your Honor.

(Witness excused.)

Trial Testimony of September 26, 1991 -- Volume III

[2] MR. GRIFFIN: I wanted to make it clear on the way Your Honor wanted to proceed. I was left with the message at the end of the day yesterday is it the Court's intention to complete the question on -- and submit that and add the plaintiffs' case on infringement to go directly to all the defenses?

THE COURT: May I ask for your best guesstimate as to (A) if we do the question of infringement first, when will you be ready to go to the jury with that? In other words, when will I be in a position to charge?

MR. GRIFFIN: I'd expect you'd be able to do that by this afternoon.

MR. MALLIN: I don't think it's the right way to proceed. We're here to try the whole case and we're prepared to try the whole case and I think we ought to try [3]the whole case. At an earlier time we wanted a bifurcation. They opposed it. We spent money and got the witness ready.

Secondly, I'll have to call all my witnesses in any event. My one witness who will testify to damages also is going to put in the invoices to show the infringement so we're not going save anything much on that part of it and I just simply think we ought to go ahead and do the case. Our direct case

in chief is an infringement case and we ought to see what they have, not only infringement or anything. I don't think it's going to be all that long in any event.

MR. GRIFFIN: The reason I asked is this witness yesterday testified one of the things he did was reviewed the prior art and that opens up the entire prior art question. If we are going to go ahead and deal with just the infringement question now, I have to go ahead and question him.

THE COURT: Let me ask --

MR. MALLIN: What he testified is in reviewing the file wrapper, he reviewed the prior art cited on the file wrapper in terms of the claims.

THE COURT: Let me just ask you if I may for my education on the witnesses if we go with infringement, is prior art one of the issues on infringement?

[4] MR. GRIFFIN: No.

MR. MALLIN: Only to the extent that it's in the file wrapper.

THE COURT: The file wrapper is --

MR. GRIFFIN: Yes.

MR. MALLIN: Validity is something different from infringement but I think we ought to get the case on validity and go to the jury. A lot of these jurors it was clear in the voir dire would like to go home and they don't have to be

very bright to know if they say no there's -- We've spent a lot of money. We're prepared. There's been orders on how to get ready and go to the jury.

[5] THE COURT: Let me go back to my original question. If we go just with the infringement, when I will be in a position to charge the jury.

MR. MALLIN: I think it's going to take -- First of all, I've got to put the evidence in. Since it's a new way of dealing with the case, I'm being told at the last minute I've got to cross examine their witnesses on infringement and later I've got to get ready for summation and you've got to figure out a charge on the infringement and we've got to do it in a very inefficient, fragmented way so I think it's a while before we get to the jury and we'll --

THE COURT: Let me put it differently. If we do all of the liability aspects, when will I be in a position to charge the jury?

MR. MALLIN: If you do all the liability aspects, other than -- Three days I suppose.

MR. GRIFFIN: I guess --

THE COURT: Give him a chance.

MR. RYAN: Two to three.

THE COURT: So that would be --

MR. RYAN: Perhaps Tuesday of next week.

THE COURT: Today is only Thursday.

MR. MALLIN: Right. It would be very early next week.

MR. GRIFFIN: It would take us several trial days to put it all in.

THE COURT: So your guess is --

MR. GRIFFIN: My guess is if they take until Monday or Tuesday, the jury doesn't get the whole case until Thursday or Friday. Mr. Mallin and I don't think damages is going to take a lot of time. Certainly our evidence --

THE COURT: Let me ask you this if I may again just to try to get it in my mind. Let's say we go just on infringement now and then there's a verdict in favor of the plaintiff on infringement, how long would the rest of [6] the case take?

MR. GRIFFIN: A verdict in favor of the plaintiff in favor of infringement? At this point to put on the defense challenging the validity of the patent and they have to put on their damages --

If your damages go quickly, we would put on our challenge to it 2, 2 1/2 days.

THE COURT: Well, how long will the whole thing take after the jury decides in his favor assuming that --

MR. GRIFFIN: It would be the same thing as the entire trial.

THE COURT: I'm sorry, would it take two days did you say after the verdict?

MR. GRIFFIN: After the verdict and he will put on his damage evidence, we would put on ours. We would put on our evidence about development, prior art, what wasn't disclosed and legal challenges. I think it would take us my guess 2 1/2 days. We'd pare down some of the depositions we would read.

THE COURT: On that hypothetical, are you talking about both sides taking 2 1/2 days after the verdict of the plaintiff?

MR. GRIFFIN: Us taking that time.

THE COURT: How about you?

MR. MALLIN: I think altogether it could be done [7] in two or three days.

THE COURT: After the verdict?

MR. MALLIN: The whole thing. If I win on infringement, I think we can do the rest of the case in two or three days.

THE COURT: You're not disagreeing with that.

MR. GRIFFIN: No.

THE COURT: Two or [sic] days after a favorable verdict -- I'm not saying there is one but if you're successful --

MR. MALLIN: I don't think we should allow stopping for a verdict on infringement. We ought to go ahead and do the case so it's not a matter of dividing this up.

THE COURT: What's your response to that?

MR. GRIFFIN: I don't see how a damage expert is at all connected with the infringement action.

THE COURT: I'm not clear either.

MR. MALLIN: I went home and analyzed that. He's -- The witness we call him damages but the first thing we're going to do he knows how many infringing systems were sold. Part of the infringement is they were selling. This jury is entitled to know that they really did infringe even though --

THE COURT: Isn't that a stipulated item that [8] they were selling?

MR. GRIFFIN: We don't challenge our own invoices certainly.

THE COURT: And you don't challenge the authenticity?

MR. GRIFFIN: No. We produced them.

MR. MALLIN: Somebody's got to explain the invoices.

MR. RYAN: Perhaps I --

If they could stipulate to the number of infringing systems that were derived from those invoices --

THE COURT: Exactly.

MR. GRIFFIN: We can talk about that because I want to see --

MR. MALLIN: You see what we're into already.

MR. GRIFFIN: My suspicion, Your Honor, is we can sit down and count them although we would probably come up -

MR. MALLIN: Right from the beginning, Your Honor, you told us how to try this case it's created some difficulty but I got the message. A few weeks ago I said maybe you'd bifurcate damages; you said no, Your Honor. I suggest to you that we go and do this case and get it done whether we win or lose, you know, let's do the case.

[9] THE COURT: Well, you're gradually educating me about a patent case. Although I'm inexperienced in patent matters, I have very good teachers and I am educable. I had the benefit of your memorandum actually on a somewhat related point about the order of proof which I found very, very helpful and it highlighted the importance of separating infringement in the jury's mind and in this case it does seem to me from all that I've seen of the preliminary papers including the motion for summary judgment that the thrust of the case really does go on infringement and that's where

the biggest difference is and that seems to me to be a key decisive issue so balancing all those considerations, we'll go to the jury solely on the issue of infringement and I would appreciate your economizing to the extent that you can in getting the evidence in promptly but that's what we'll do.

MR. MALLIN: That's very unusual in a patent case. I must put on the record that's being done over my objection.

* * *

[11] MR. RYAN: With the Court's permission, the plaintiffs next call Mr. Donald Pfingstler.

DONALD JOSEPH PFINGSTLER, PLAINTIFFS'
WITNESS, SWORN

DIRECT EXAMINATION

BY MR. RYAN:

Q Again would you please state your name for the record?

A My name is Donald Joseph Pfingstler.

Q Mr. Pfingstler, where do you live?

A I live at 300 Chauser(ph) Court North in Sewickley, Pennsylvania.

Q With whom are you presently employed?

A I'm employed by the Barrington Consulting Group, Inc.

Q And what is the Barrington Group?

A The Barrington Consulting Group is a financial economic and accounting consulting firm that deals primarily in financial analysis of matters that are in dispute such as this litigation here.

Q Could you briefly describe for us, Mr. Pfingstler, your educational background?

A Following high school?

Q Yes.

A Following high school I attended Gannon University which is located in Erie, Pennsylvania and I graduated [12] from Gannon in 1968 with a Bachelor of Science degree in Business Administration with a concentration in accounting.

Q And following your graduation from college, could you briefly describe for us your employment history?

A Sure. Following graduation I joined the international public accounting firm of Arthur Anderson [sic] Company in their Chicago office. Initially I joined as a staff accountant in the audit and practice. I was with Arthur Anderson [sic] in total for approximately a 12-year period of time until October of 1980 in various capacities. I had about a two-year period in there from 1969 through 1971 when I was on leave of absence for service in the U. S. Army. After I completed that service, I returned to Arthur Anderson [sic] and over that period of time from roughly 1971 to 1980, I received a series of promotions as I gained additional experience and

took on more responsibilities for both the review and conduct of audit examination of business records as well as other consulting projects within that organization.

Following my tenure with Arthuor [sic] Anderson [sic], I left Arthur Anderson [sic] in about October of 1980 and was one of the finding [sic] partners of one of the firms called Peterson's Consulting in Chicago and they're in a business very similar to the kinds of things I'm doing now. It's also [13] a forensic accounting and financial economic firm doing these kind of matters.

I was partner in that firm in 1985 when I relocated to the Pittsburgh area to open Peterson Consulting office in that city, remained then in a partner capacity until approximately 1987 at which time Peterson was sold and in effect the form of the organization switched from being a partnership to a corporation.

At that point in time I became a vice president within Peterson Consulting and was in charge of the Pittsburgh office of Peterson Consulting. I remained in that capacity until approximately the middle of 1990 when I left Peterson Consulting and was one of the finding [sic] shareholders of the Barrington Consulting Group.

Q Do you hold any professional certifications?

A Yes. I'm a certified public account [sic] and I'm licensed to practice in both the States of Illinois and Pennsylvania.

Q And do you participate and are you a member of various professional organizations?

A Yes. I'm a member of the American Institute of Certified Public Accountants as well as the State societies for both the States of Illinois and Pennsylvania and there's a few other professional organizations that I have membership in as well.

[14]Q Mr. Pfingstler, are you experienced in the review and analysis of business and financial records?

A Yes. I've been doing that for over 20 years.

Q Have you been involved in the review and analysis of financial records in connection with a patent infringement action?

A Yes, on a number of different occasions.

MR. RYAN: Your Honor, I offer Mr. Pfingstler as an expert witness on the analysis of business and financial records.

MR. GRIFFIN: Your Honor, I have no questions about the witness's qualifications in that area but I would ask for an offer of proof of why we need him.

THE COURT: I think it's what we discussed at side bar.

Why don't you just get right to that?

MR. RYAN: Thank you, Your Honor.

THE COURT: Under our local rules, we don't have offers of proof as such when the witness has been identified in the pretrial memorandum as I assume this one was.

MR. RYAN: He was.

THE COURT: If you can get right to the substance --

BY MR. RYAN:

[15]Q Mr. Pfingstler, were you and the Barrington Group retained by me and my firm to consult with us in connection with various business records and analyses in connection with this case?

A Yes.

Q And could you please describe for us some of the materials which you reviewed in connection with that engagement?

A Okay. Do you want my response at this time to deal with the limited question that I understand is in front of us now?

THE COURT: If you would. Just deal with that.

BY MR. RYAN:

Q In connection with the business records, sir.

A Okay. Well, essentially we reviewed a list of information concerning a number of "Datamarks" and "Datascans" that the plaintiffs represented had been sold as well as stacks of invoices that also deal with the sale of products made by Westview over a period of time.

Q And did you specifically review those materials with an eye to determining the number of infringing systems sold by Westview?

A Yes, that was among the things we did.

Q Did you do all this work yourself, Mr. Pfingstler?

A No. I had several members of my staff that [16] participated in the analysis work we did.

Q They were under your supervision?

A Yes.

Q What time period did you key in on in connection with the sales of the Westview system?

A Well, essentially we looked at information as I can best recall now on sales information from around the 1985 timeframe [sic] into sometime I believe in 1991. I don't think the records we had went all the way through to the current date. I believe they cut sometime earlier off in 1991 but I can't tell you precisely what the start and stop point was but in broad terms I think that covers the area.

Q After your review of the invoices and the various materials that you described, did you arrive at an opinion to a reasonable degree of certainty as to the number of systems sold by Westview in that time period?

A In terms of the number of infringing systems, I did.

Q Could you please tell the jury what that number is?

A 695 systems.

MR. RYAN: No further questions at this time, Your Honor.

THE COURT: Okay.

CROSS EXAMINATION

BY MR. GRIFFIN:

Q When you counted infringing systems, who told you [17] what systems were infringing?

A An infringing system -- We assumed based on our discussions with counsel and with the other experts and also with Mr. Markman, we made the assumption that in order to have an infringing system, you had to have both a "Datamark" and a "Datascan" so it had to be in combination of that.

Q I just want to get it clear you didn't make any independent judgment about something being infringing at all, did you?

A We conducted the analysis under that assumption with respect to the numbering systems given that assumption it would infringe.

Q It's what the lawyers and the experts told you?

A Constituted an infringing system, that's correct.

MR. GRIFFIN: Thank you.

THE COURT: Thank you, sir.

(Witness excused.)

MR. MALLIN: Mr. Markman, please.

HERBERT LEONARD MARKMAN, ONE OF THE
PLAINTIFFS, SWORN

DIRECT EXAMINATION

BY MR. MALLIN:

Q Please state your name.

A Herbert Markman.

[18]Q Where do you live?

A 631 Fairston Drive in Wynnewood, Pennsylvania.

Q And are you one of the plaintiffs in this case?

A Yes.

Q Would you tell the jury your educational background beyond high school?

A I attended Drexel Institute of Technology which is now Drexel University and I received a Bachelor of Science specializing in commerce and engineering science and that

was my undergraduate degree. I also received a Master's in Business Administration from Drexel University in 1968.

Q Give us a brief resume of your career experience after you left Drexel?

A For a short period of time I worked for a small consulting firm called Morrison Associates which did data processing consulting and then I went to work for a company called Rentex Services Corporation which is in the business of providing uniform rental and linen supply services to general industry and at Rentex I started out as Director of Management Information System, ran the Computer Department and then became Assistant Treasurer still providing guidance for the data processing group and for the last 2 1/2 years was Vice President of Operations and was responsible for half of the company's plants [19] throughout the United States.

Q What year does that get us up to?

A 1973.

Q What did you do after 1973?

A In 1973 I started my own consulting firm to provide data processing systems to the, primarily to the uniform rental and linen supply industry and actually I just provided consulting for the first couple of years and about 1975 we incorporated H. L. Markman Associates and at that time started provided turnkey(ph) data processing systems for the textile rental industry and that provided the hardware and the

software and the training support and that really continued until 1984.

Q And then what did you do?

A In 1984 we formed Drycleaning Computer Systems, Inc. which is now called Positek, Inc. It was just a name change.

Q Let's be sure we're clear. You formed Drycleaning Computer Systems, Inc.

A Yes.

Q I take it it was a company you owned?

A It was a new company and we started with three employees.

Q At some point the same company changed its name to Positek?

[20]A Just in January of this year.

Q And tell the jury the nature of that business.

A Well, I had been working on developing a system prior to forming that company for the retail drycleaning industry and that company supplied a hardware/software system for retail drycleaners to help them perform accurate, consistent pricing, do inventory cash control and we started growing that business from '84 through this year. We still consider us a small company but we've grown to 45 employees which we have and we're located in Norristown, Pennsylvania.

Q And Norristown, is that where the assembly operation is performed?

A Yes. That's where we do the customer support, assembly and research and development for the company.

Q I show you Plaintiffs' Exhibit 1 which is the reissue patent suit and ask you whether you are the owner of the patent?

A Yes, I'm the owner of the patent.

Q And I show you Plaintiffs' Exhibit 13, which is the original 2, 4, 6 [sic] issued October 29th, 1985. Were you the owner of that patent as well?

A Yes, I'm the owner of that patent.

Q Did you license that patent as DCCS, Inc. so that Positek could use it?

[21]A Yes, there's a licensing agreement between myself and DCCS Positek.

Q I show you Plaintiffs' Exhibit 24. What is that?

A That's the ticket license agreement that was in 1984 between myself and Drycleaning Computer Systems, Inc.

MR. MALLIN: May it please the Court, I offer Plaintiffs' Exhibit 24.

BY MR. MALLIN:

Q Does Drycleaning Computer Systems, Inc. under that name or Positek sell patented products?

A Yes, we do.

Q On the products that you sell at the time after the reissue patent, did you put any marking on the product to show that it's a patented product?

A Yes, we have.

Q I show you Plaintiffs' Exhibit 25. Can you tell me what that is?

A This is a label that we put on the printers that we ship out for the patented systems and it says Drycleaning Computer Systems, Inc. and it refers to the patent numbers: The U. S. patent number, the reissue patent number and the Canadian patent number.

Q And printers that that's put on is that part of the printed system that you sell at Positek?

A Yes.

[22]Q Before the reissue patent while the original patent was in fact after it was issued after October 29th 1985, did DCCS --

What's that name again, dry --

A Drycleaning Computer Systems, Inc.

Q Did it put a notification on the patented systems being sold concerning that it was patented?

A Yes, we did.

Q And what did that notification say?

A It was a similar label. It only had the initial --

The initial one only had the original patent number on it and and [sic] it didn't contain the reissue number on it because it didn't exist and it didn't contain the Canadian patent because that was issued after the original patent.

Q Would you tell the jury what a drycleaning trade show is?

A It's a major event.

Drycleaners also attend and coin operated laundry companies and it's held every two years and I've been attending those during 1980 and 1990. It's our major contact with the industry from a marketing standpoint.

Q Did you you [sic] say the show is held every two years?

A Yes.

Q Was one held this year?

[23]A Yes. There was just one recently held. I think it was during the last week of June in Las Vegas.

Q And was one held in 1989?

A There was one held in 1989. I believe that was in Dallas, Texas.

Q And that means there was one held in 1987?

A The '87 one I believe was either New Orleans or Atlanta but they're every --

Q That's why I'm not asking you whether there was a show -- There's a lot of trade shows so since the issuance of the original patent, do I have it there would be a cleaning show in '87, '89 and '91?

A Right.

Q Did Drycleaning Computer Systems, Inc. or Positek --

And you attend and display your products at that trade show?

A Yes.

Q Who comes to those trade shows?

A As far as the attendees?

Q Yes?

A It's really drycleaners from all over the United States and actually all over the world; people as far away as Australia at the one in Las Vegas.

Q Is this an important show?

A It's the most important as far as we're concerned for [24] our industry because it's held every two years and it takes a lot of effort. The reason it's not every year it takes so much effort to prepare for the shows that to have them every year would be too monumental a task.

Q Do companies that provide systems and supplies or equipment for the drycleaners put on displays at that show?

A Yes. Every significant vendor who is supplying systems to that industry I would say would be at that show.

Q Now at the 1987, 1989, 1991 show, did Drycleaning Computer Systems, Inc. Positek and you display the patented system?

A Yes, we did.

Q Did you personally attended [sic] each of those two years?

A Yes, I did.

Q At each of those three shows did Westview Instruments have a display or booth?

A Yes, they did.

Q And at the display booth presented by Westview Instruments at those shows to the drycleaning industry, was the "Datamark" and the "Datascan" inventory control system displayed?

A Yes, it was.

Q And did Westview Instruments have brochures at those [25] shows displaying its system?

A Yes, it did.

MR. MALLIN: May it please the Court, I offer Plaintiffs' Exhibit 25.

I have nothing further at this time.

THE COURT: Very good, sir.

MR. GRIFFIN:

CROSS EXAMINATION

BY MR. GRIFFIN:

Q Mr. Markman, is the purpose of your invention to track specific articles dropped off by a customer in the drycleaning system?

MR. MALLIN: Under the rulings of how you wanted to proceed, I object to that question at this point.

THE COURT: Well, it does seem to me that it goes to the issue that we're trying of infringement so I'll overrule your objection for that reason.

A Could you repeat the question?

Q Yes, sir. I'll rephrase it.

Does your invention track the specific articles belonging to a customer through the drycleaning process?

A My invention is an inventory control and reporting system which has several options and as I understand it, the options are presented in the claims [26] and one of the options that is presented in one of the subsequent claims other than 1 tracks individual articles.

Q It's not limited to tracking individual articles with a tag. Let's talk in terms of tracking the articles associated with the unique indicia through the drycleaning process.

A The system --

MR. MALLIN: Your Honor, now he's gotten into the patent terminology. This is the inventor not a patent expert. When we start using the patent terminology, I don't think it's appropriate cross examination.

THE COURT: Well, as you point out, he is the inventor and I don't think there's anything unfair about asking that question. Overruled.

A The system tracts [sic] individual tickets that have unique ticket numbers as far as the inventory control system is concerned.

Q And the information about the articles of clothing associated with each ticket is stored in your system, is it not?

A One of the options that the system has is to store the detailed information regarding the ticket.

* * *

[28]Q How much computer memory, sir, do you have to have to carry out your invention?

A See, I think -- There's a distinction here. We had a system that we offered for sale that is -- which deals with certain aspects that are in the patent. The patent doesn't really say how much memory you have to have. It doesn't say what kind of computer you have to have. It doesn't deal with any of those specific issues and I can answer the questions -- I'm not a patent attorney. I'm not a lawyer. I can answer the questions -- I know how we implement the patent at Drycleaning Computer and Positek. I really -- In terms of the patent itself and how it's implemented by other people, there's all kinds of ranges of memory devices that can be utilized.

Q My question is as the inventor, what's your understanding of how much you need in memory to be able to do what your system is supposed to do.

MR. MALLIN: Objection, Your Honor. He just said there could be a range of memory.

THE COURT: Overruled. It seems to me it's an appropriate question.

A I don't really -- If you want a range of memory, it probably is 32 K bytes of memory to 16 K bytes of memory up to two million bytes of memory. It can be implemented in many different ways depending on the system design.

[29]Q How many pages of text is 16 K bytes?

A We're talking about 16,000 positions of memory but it's -

Q How many pages of text does that turn out to be?

A I don't know.

Q Do you know --

A Depends on how fine the type is.

Q Do you know how much information that can store?

A 16,000 positions of -- digits of memory or alpha/numeric fields but --

Q Is that sufficient to track orders and what makes them up through the drycleaning process?

A I don't know.

Q When you applied for your reissue patent, did you not explain to the Patent Office your invention was for tracking articles and groups of articles through the drycleaning process?

A I have to look at the materials but I don't have the reissue patent in front of me. I have to see what you're referring to.

Q Is the purpose of your system to track articles of clothing through the drycleaning process?

A The purpose -- It's an inventory control and reporting system that has certain elements in it and you are tracking -- The primary tracking done is done with [30] the unique ticket numbers as they enter and leave inventory in order to provide inventory control and that can be done and is done through the implementation of it at the invoice [sic] summary total which is the total dollars per ticket.

Q And your claim in your patent, sir, says that the --

In your system, the unique sequential indicia and I take it --

A The ticket number is one implementation of that.

Q And the description of the articles in the transaction, I guess the dropping off of the bundle of clothes, are reconcilable against each other?

A Yes.

Q So in your system, you can go in and see if there is an article of clothing missing from an order?

A By looking at the ticket.

Q If you lost a ticket, can you query [sic] your system?

A One option, okay, which is covered I believe in the first claim of the option is to -- The way to do the reconciliation -- One way of doing the reconciliation is to look at the ticket or a copy of the ticket because most drycleaners keep multiple copies of the ticket in a control file and so one

could go to the customer, one goes on the clothes and one to be kept. Any one of the copies can be used to do that reconciliation.

[31]Q There's a green sweater that you know you saw somebody, the operator of the -- saw someone take out of an area. Your system lets you identify the invoices that you'd have to check to find which one might be missing a green sweater?

A As I said, there's many options in the system. As a matter of fact, if you want to talk -- I guess they were calling it the preferred embodiment which I guess is different ways things work but we have many, many options of how that can be done. One of the options, one of the options is to maintain the detail. Another option is not to maintain the detail.

Q As an inventor, when you were coming up with this system, did you conceive it as being a system to track the articles through the drycleaning process?

A That was conceived that way as an additional claim because it was a future enhancement to the system which I thought would be worthwhile but it wasn't the primary reason that I developed the invention. It was a future alternative that I had developed.

Q What was the primary reason why you developed the invention?

A It's an inventory control and reporting system and has the component parts that we've been talking about for the last day and an half and I thought it had merit [32] because I had

never seen anybody anyplace do it the way I was envisioning it being done and I guess that's why the Patent Office said it was right twice.

Q And the way you envisioned it being done was to be able to monitor completely the progress of articles through the laundry and drycleaning system, correct?

A There's a basic -- The basic way I saw it being done was at a level where the ticket was controlled and the items within the ticket reconcilable against the ticket. I have an additional claim which includes that which says you can put tags on the ticket and that was an enhancement to the system which I felt would give it another level of value to the original concept.

Q Well, then, sir, let's see if we can't understand this. By looking at the language which you added --

A I'll tell you, I'm going to have trouble with this because I'm not a patent attorney. I can tell you what I do. That's why I hire patent attorneys. I get as messed up in this language as anybody.

Q Let's just try to unmess it and use the language which you've used before, okay? Do you recall --

MR. GRIFFIN: Your Honor, I'm going to try to stay away from issues that --

BY MR. GRIFFIN:

Q You were asked about about [sic] an invention you had [33] designed by Jolicoeur Limited which was taken on I think it was the 16th of July of this year?

A Yes.

Q Do you recall that?

A Yes, I do.

Q And do you recall being asked the question in what way are they different, meaning the Jolicoeur system and your invention?

* * *

[34]Q Do you recall being asked the questions?

A I recall being asked about the Jolicoeur system. I don't specifically recall my answer to it.

Q Do you recall being asked, "In what way are they different?"

A I suppose so, yes.

Q Do you recall what your answer was?

[35]A Not exactly.

Q Would it refresh your recollection if I read it to you?

A Um-hum.

Q "The bar code was printed on the back spaces strictly on a turnaround document for later data entry and specific articles that are identifiable by the customer who dropped them off and were owned by the customer were not tracked into the inventory control system as they were in the invention".

Does that refresh your recollection and fairly represent what you said there?

A In the Jolicoeur situation, the -- It was preprinted bar code used as a turnaround document and the items there were not tracked or even cross referenced as to the individual owner because they were napkins and tablecloths that were -- It was strictly used as a count and when those items went in, they went to somebody else, another restaurant.

Q And that's to contrast with your system where they are tracked into inventory control and are cross referenced?

A See, what we have in the system is a primary claim as to the inventory control and reporting system, then we have a tracking system which is spelled out as I [36] understand it -- I've learned more about this thing -- it's a dependent claim so the system has both -- The system described -- The inventory control system, the reporting system described has an option which is a dependent claim to put tags on and track it.

Q If you're now going to start talking about independent claims, I'm afraid we're going to have to go back to the claim language which you said you don't want to talk about.

A The patent has -- As far as I'm concerned, the way the patent was conceived, it does not have to retain in memory the details associated in the computer memory, the details associated with the ticket after the tickets is created.

Q In your system, is there a difference between a ticket and a report?

A Yes.

Q Is there a difference between a ticket, a report and a tag?

A Yes.

Q In your system, is a microprocessor -- does a microprocessor have to have the means to be able to generate at least one report of the inventory total and transactions --

A See -- All right. Go ahead.

[37]Q -- and cross reference the items of clothing?

A We're getting involved in claim language, okay? We had somebody here who -- I know what the system does and I know what I conceived it to do. I know what the elements are. If we're talking about -- I'm not a patent attorney and we're trying to interpret this -- you're trying to get me to interpret it in that way.

Q No I'm not, sir. What I'm trying to do is as the inventor of the system who had before told us that in distinguishing it from an earlier system which you made, you said, the

earlier system, the individual items were not tracked into inventory -- the inventory control system as they were in the invention and I'm trying to find out -- You said that under oath. That was what you said in trying to describe how that differed from your invention and --

A There was no -- In the Jolicoeur system, there was no unique tickets created.

Q I'm not asking about that. I'm talking about this system. Isn't it the purpose of this system to track the items of clothing, sir?

A The purpose of the system is as far as being an inventory control and reporting system is to keep track of individual tickets that are assigned unique numbers from an inventory for inventory control purposes.

* * *

[38]BY MR. GRIFFIN:

Q How do you localize spurious additions and deletions from inventory in your system?

A The system described in the patent?

Q Yes, sir.

[39]A Okay. When you create a ticket, a unique number is assigned to that ticket and coincidental with that ticket being produced, the number is produced and a bar code that represents it is produced and at that instant, the system

enters the -- the transaction enters the inventory control system as far as the ticket number and the dollar amounts of the ticket are concerned.

Q Does it not also include the transaction identity and the description of each of the said articles associated with the transaction?

A The description of those articles can be printed on the ticket.

Q And is it not -- Are they not stored in the system memory?

A At a minimum while the ticket is being produced and once the ticket is produced, the storage of those articles, the details of those articles are not required as far as the details other than the total dollar amount in memory and the additions and deletions are created by either entering the ticket number at a later point which verifies that it's been picked up and the way the reconciliation is done is by taking an inventory and when you take an inventory, you can have additional tickets or missing tickets.

One of the ways you have additional tickets is [40] somebody brings an order back because they did a junkie job cleaning the clothes and you want them recleaned and they forgot to put it back into the system. A missing ticket can be created because of the clerical error because the ticket; and the dollars are missing. That's by taking inventory is how you reconcile the dollar amounts and the dollar amounts associated with each ticket in order to control the inventory which is one of the things that the drycleaners or anybody

trying to control their inventory is trying to do and that's what the invention is all about.

Q Are you telling us today that the invention does not require descriptions of articles in the sequential transactions to be kept in system memory so they would be reconcilable against the number?

A The transaction is the ticket number. The ticket number is unique. The unique ticket number is kept in memory. The articles associated with that ticket number being the shirt, the pants are not required to be kept in memory after the ticket is created. They can be but they're not.

Q And that's the way you originally came up with this invention?

A I don't know what you mean by that.

Q That's what you intended to come up with when you [41] came up with this invention, a system which didn't store individual article descriptions in memory, is that correct?

A It could keep those articles in memory and I'm not saying it can't and the way I sell it, which is a version of the system that we market, it has the capability of doing it and there is a variable retention of that information. You have to answer a question how long do you want to keep it but that is not -- That's not -- That is just one variable which does not have to -- the invention does not need that retention in order for the original concept to --

Q Why do you have the invention as you implement it store that information?

A I thought that that option was what's -- See it's -- The system as we implement it, which is not what the patent is covering, has all kinds of options because we feel that there may be -- We're trying to fulfill the need for an entire marketplace. Some people could care less about the detail articles associated with the ticket. They're just interested in inventory control. If that's all they care about, that's -- we can implement the system that way. If they're interested in the details, the system can be implemented that way. It's an option and I tried to cover all options that somebody could want and [42] the ones I knew about in 1980, in the beginning, 1983, '84 whatever the timeframe [sic] was, are the ones I put in and since then we've put many more options that are not even included in the patent. We keep enhancing the product. I have three or four people working full time on research and development.

Q It's been your testimony that tracking of articles through the process isn't something that you think is basic to your invention, is that right?

MR. MALLIN: Objection Your Honor. This question has been asked and answered about six or seven times now.

THE COURT: Overruled. I don't think so?

A Could you repeat the question?

Q Yes. Is it your testimony that tracking of articles, whether they be individual or batches, isn't something that is basic to your invention?

A It's one of the components.

Q Now, sir, you asked for a reissue patent, correct?

A Correct.

Q And that reissue added a Claim 16 I believe.

MR. MALLIN: 14 and 15.

Q 14 and 15. Excuse me. That's right. I ought to look at it.

Is that correct?

[43]A I happen to have it here so -

Claim 14 and 15 were added, yes.

Q And in doing that and the reason -- Let me go back.

Nothing from Claim 1 was deleted, was it? Nothing from your original patent Claim 1 was deleted when you got your reissue patent, was it?

A Claims 1 through 13 stayed unchanged.

Q And so you added -- wanted a Claim 14 to make some points clear and 15 to make other points clear?

A Well, what happened was -- and I don't know -- This patent was challenged with many -- with prior art, all kinds of issues.

Q We're not supposed to get into those, sir. Maybe --

A You're talking about the reissue patent --

Q Let me get into what you said when you went to get the reissue patent.

MR. MALLIN: Your Honor, he was cut off when he was explaining the context.

THE COURT: I'm sorry. Go right ahead.

A Okay. What happened was that other people were including Liberty and Max and a whole bunch of other companies said that there was prior art, the patent was invalid. There were all kinds of issues so what I did to clarify all of that, I sent the patent -- I took it back to the experts. The experts I felt were the Patent Office [44] and I said: Okay, experts, if people are saying it's invalid, there's prior art, all this kind of problems, I'm going to put it in your hands and you make the decision and -- because you're the expert and Liberty, Max and whoever else wanted to put all kinds of materials in front of the Patent Office and I understood that if any of that material was in fact valid, I would lose the patent because the patent wouldn't be reissued so the claims that are reflected, the primary reason for the reissue patent are the claims -- of the claims that are reflected there clarify the contentions that were being made about the patent in terms of what these parties felt the issues

were and I just felt give it to the Patent Office, they're the experts. If they say it's no good, it's no good if it's --

Q You didn't take it to the Patent Office. You took it back to your patent attorneys, didn't you?

A I took it back to my patent attorneys, that's correct.

Q Then you filed an affidavit with the Patent Office, didn't you?

A Yes, I did.

Q And in part of that affidavit you said, "It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing [45] brought in by a single consumer to the dry cleaning establishment and the like --

MR. MALLIN: Your Honor, I think the witness ought to be able to look at the piece of paper that's being read from rather than see it orally.

MR. GRIFFIN: I'll be happy to, Your Honor.

While we're taking care of the clerical issue there to make sure the certified copy is appropriately marked, I'll move off this and come back to it.

(Pause)

BY MR. GRIFFIN:

Q Mr. Markman, was it your understanding that Claim 1 dealt with tracking individual articles of clothing through the drycleaning process?

MR. MALLIN: Now we're exactly asking the lay witness, the inventor, not what the invention was but for him to explain what's in Claim 1 for which we brought a patent expert to testify --

THE COURT: Would you rephrase the question, Counsel?

MR. GRIFFIN: Yes, sir.

BY MR. GRIFFIN:

Q Did you work with your patent counsel to add language after your initial application was rejected?

A I communicated with him, yes.

[46]Q Did you review the language that was to be added?

A I read the language that was to be added.

Q And you understood what you were doing then?

A I understood what he told me he was doing. I'm not a patent attorney. Some of this stuff -- In fact, because of some of the expert witness, I understand more than I ever did before. I'm not a lawyer. I'm not a patent attorney. I know what the invention is. And I rely on the patent

attorneys to submit that to the Patent Office and follow their rules.

Q I know you sat here and you listened to Mr. Chovanes?

A Right.

Q I don't want you to testify based on what you heard Mr. Chovanes say. We want you to testify based upon what your understanding of your patent is, okay?

MR. MALLIN: Your Honor, this witness's understanding of what a patent is isn't relevant in this case. This witness's --

THE COURT: Let me hear the question, object if you wish and I'll rule on it. I haven't heard the question. You interrupted him in the preface I think unintentionally.

BY MR. GRIFFIN:

Q You added language to your patent and let's take a look at it because I don't want to be unfair to you. I [47] put Defendants' Exhibit 3-A up on the easel.

Now, when you added the language in the first paragraph: "Each of the transactions having articles associated therewith, said information meaning the information which was being put in --"

Then it goes on, "-- including transaction identity and descriptions of each said articles".

Why did you add "of each said article"?

A You know, when this was all done, which is in, what, 1985 I guess, the patent counsel and I reviewed what he was doing; why he was doing it. I understood it then. I'm not sure if I understand it now. I' [sic] know what the final results were but I don't remember all the reasoning that we went through in order to come up with the end result.

Q You said you knew why he was doing it. Was he doing it to meet the objections of the patent examiner?

A We submitted the patent and there were some objections and it was changed to resubmit it. It was resubmitted in order to deal with those objections and once it was resubmitted, the patent was granted and it was not only granted once, it was granted twice. I feel real good about that that it's a very difficult, long process. I do not understand the procedures that you have to go through in dealing with the Patent Office. I'm not a [48] patent attorney.

Q Sir, when I started to ask you questions about what you said in the Patent Office before, you said -- Your counsel rightly pointed out that you ought to have the exact language in front of you and I have it in front of me now. I'm going to try to find it in the certified record of the Patent Office so you will have it.

Rather than delay the Court's time --

THE COURT: I think your colleague can help you there.

BY MR. GRIFFIN:

Q Sir, is it the purpose of your invention to be able to tell whether an individual item has been lost out of someone's drycleaning order?

A The primary -- It's an inventory control and reporting system that tracks individual tickets that have unique numbers and the retention of the detail after the ticket is created is an option in the system and is not what the primary function of the system is. I think I said that several times.

Q Where is it stated as an option as you understand it?

MR. MALLIN: I'm sorry. I didn't hear the question.

THE COURT: And where is it stated as an option [49] as you understand it?

A I have to start reading through the patent. I mean -- The primary claim, Claim 1, does not require that the system retain details as far as the articles associated with the ticket after the ticket is produced.

Q If it doesn't, how do you generate a report of the total and the transactions with the unique sequential indicia and descriptions of the articles in the sequential transactions being reconcilable one against the other?

A Okay. I think we just spent this morning like and yesterday hours on this stuff.

Q Let's try it another way then. I'm putting in front of you, sir, a document which has been marked as Defendants' Exhibit 2. It is the certified copy from the Patent Office of the reissue patent filed. I'm opening it, sir, to a portion of it which is "Reissue Declaration and Power of Attorney by Inventor" and I'm turning it to Page 2 of that where it says, "Tracking of individual articles". Okay? Do you have that in front of you? Directing your attention to the paragraph --

A I see. "Tracking of individual articles".

Q "Tracking of individual articles" and that goes --

A Right. I see that.

Q Does that paragraph suggest, sir, that at that time you were telling the Office that while it may be argued [50] that the claims are limited to a system that tracks individual articles such as individual pieces of clothing, you think it also ought to include the tracking of batches of articles brought in?

A The purpose of this claim -- I mean of this document was that the patent was being reissued under the objection of --

Q Sir, could you read that paragraph, please?

MR. MALLIN: I think he ought to be allowed to finish his answer.

THE COURT: Sure. Go right ahead, sir.

A Okay. It says right up here "Max Business Systems, plaintiff". Okay. And I think I have to give some background here because Max Business Systems was formed, they infringed the patent and in 1987 they sued me to declare the patent invalid. They came up with all kinds of objections and they said this is why we consider the patent invalid and they had lots of paper. "It may be argued" is that Max was arguing that these issues were problems so what we did is -- when I say "we", it's myself and my patent attorney -- said: Fine, let's send all this back to the Patent Office. "It may be argued" that's what Max is arguing and we sent this back in, Max sent in loads of paper, Liberty Lister sent in loads of papers and as a net result of that, in 1989, the patent was reissued, all [51] 13 claims were held and two additional claims were added and I went through this whole thing so that the Patent Office who I felt were the experts would make the decision and all this language was reviewed by them and they reissued the patent and at that point I had flipped a coin and if they said we're not going to reissue it, the patent was mine so I'm not a patent attorney. I know what the reason for this is and that's why this document was created.

Q This is something that you signed, isn't it, sir?

A Yes, it is.

Q And so this fairly reflects what you thought, doesn't it?

A Yes, it does.

Q And you told the Patent Office that you thought instead of limiting it just to individuals, you said, "The grouping of

such articles into sets for tracking print, e.g., a suit comprising pants under a jacket and/or suit or dress or other separable items grouped together is reasonably disclosed as forming a part of the invention".

You're talking about tracking articles in groups identifying what is part of the group and tracking individual lines, aren't you?

A That's too many questions all at once.

Q Okay. If it could be argued it was limited to [52] tracking individual articles, and that's what you said it could be, right?

A Can I read -- I have to read what this is all about because it's complicated and --

Q Please read.

* * *

Q Mr. Markman, did you have an opportunity to review your declaration?

A Parts of it, yes.

Q And you took a look at what you said about tracking [53] clothes?

A Yes.

Q I'd like you to keep that in mind, please, sir.

Right now I'm going to hand to you a document which has been marked as Defendants' Exhibit No. 76 and ask you to turn to Page, handwritten numbers, 467 of this exhibit, Page 467 of Defendants' Exhibit 76, an inventory report generated by your prototype machine, prototype unit.

A Yes.

Q That is a prototype of your invention that we're referring to, correct?

MR. MALLIN: I understood that question to be asking about the prototype of the invention and I thought the ruling of the Court was not to get into those issues at this point.

THE COURT: I'm not sure I understand what the problem is.

MR. GRIFFIN: I don't think there is one, Your Honor, because we're just going to what Mr. Markman thought his system did and what it tracked and it seems to me probative of what his system was -- what his original system was doing. It doesn't track clothing. It doesn't --

THE COURT: It seems to me -- that way to me, [54] Counsel. I don't see what's wrong with the question.

MR. MALLIN: And, of course, it's my position all along we're happy to get into that sort of thing at the appropriate time.

THE COURT: Right. The only issue we're trying now is whether the products produced by Westview infringes on

Mr. Markman's patent claim and the question does seem it's relevant on that issue.

BY MR. GRIFFIN:

Q I'll rephrase the question for you. Is that an inventory report generated by a prototype of your invention?

A This is an inventory report that was generated by the first --

Q Does that show ticket number?

A Yes.

Q Does it show account number?

A Yes.

Q Does it show garment type?

A Yes.

Q It tracked individual items of clothing, correct?

A This is a listing -- I have to look at the rest of the brochure to get -- to understand the context because I haven't really dealt with this for many years so I'd like to look at the rest of the pages.

[55]Q Please.

(Witness did so.)

A It appears as if this report reflects one of the options in the system and that option is to keep the detail records relative to the tickets on file but it is only -- it is only one of the options. It is not required as part of the invention.

Q Are you trying to tell us, sir, that your invention did not require the system to maintain information about individual items or maintain descriptions of items which made up an order?

A It only requires that that information be present, detailed information on ticket at the time the ticket is generated. Once the ticket is generated, the unique number, which is the ticket number, and the total, being the total dollars, is retained. To retain any more information is optional under the invention and you may or may not retain that detail but it is not part of the primary invention.

Q Then, sir, please tell me why you added the language to Claim 1 after your original patent had been denied, the application had been denied that said, "said total and said transactions the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another"?

[56]A The unique articles which we've gone over many times are printed on the ticket during the process of printing the ticket. Once the ticket is totaled, you do not have to retain the detail as far as the articles associated with the unique number pass that point in time.

Q Isn't it true you never made a unit that did only that?

A Let me think about that.

A Probably the commercial use -- In commercial use it's probably true that the product that we sell which is not --

Q The question was isn't it true you never made a unit like that? That's the question, yes or no?

A We never sold a unit like that.

Q Did you ever make a unit like that?

A I'm not sure.

MR. GRIFFIN: No further questions, Your Honor.

MR. MALLIN: Your Honor, I would like to read to the jury an allegation appended to the complaint which is admitted by Westview.

THE COURT: Are you finished with this gentleman?

MR. MALLIN: Oh yes. I'm sorry. I was looking at these papers. Very bad to forget your client.

(Witness excused.)

[57] MR. MALLIN: Now I would like to read.

Ladies and gentlemen of the jury, in the papers that plaintiffs filed in this case Paragraph 10, plaintiff said, "Westview Instruments is in the business of, inter alia," --

that's a legal word for among other things so maybe I'll read it again in plain English.

"Westview Instruments is in the business business [sic] of, inter alia, manufacturing and selling inventory control systems."

And Westview in response to that said answering Paragraph 10, "Westview admits the allegations above.

MR. MALLIN: Your Honor, am I understanding of the way the Court has elected to proceed at this point we're going to stop on infringement and infringement only?

THE COURT: Very good. That's exactly right.

(Mr. Griffin handed up a document.)

THE COURT: I will defer on the motion you were kind enough to hand up for the present.

MR. GRIFFIN: Thank you, sir. It was a Rule 50 motion which we handed to you, sir.

THE COURT: That is correct. I'll simply defer ruling on that and you may proceed.

MR. GRIFFIN: I'd like to have Mr. Jim Jenkins take the stand, sir.

[58] JAMES ALAN JENKINS, DEFENDANT'S [sic]
WITNESS, SWORN

DIRECT EXAMINATION

BY MR. GRIFFIN:

Q Mr. Jenkins, how old are you, sir?

A I'm 41 years old.

Q Where do you work?

A I work at Westview Instruments in Houston, Texas.

Q What's your job at Westview?

A At Westview I'm president of the company.

Q What else do you do there?

A Well, I do the design and supervise the construction, development of listing machines, car wash controllers, bar code readers and time clocks.

Q Where did you go to school, sir?

A I got my BS double E in electrical engineering from the University of Houston magna cum laude and I went to Rice University and picked up a Master's Degree in electrical engineering.

Q Do you have any formal education beyond that?

A No, sir.

Q Did you do any development work when you were at Rice?

A Well, I developed the first wave guide laser --

Q What's a wave guide laser?

A It produces millimeter light. It's optimally pumped [59] by a CO2 laser. At the time we were developing it so we could pierce the cloud that spaceships have to pass through when they're entering the atmosphere.

Q What is your relation to the "Datamark" system?

A I was the developer of the "Datamark" system.

Q I'd like to ask you a lot of other questions about that but right now we're going to confine ourselves just to the system and how it works.

Can the "Datamark" system maintain an inventory total?

A No, sir, it can't.

Q Would you explain to us why that is?

A Well, what the unit does is as it's been explained before, it totals the tickets that are entered into the machine and keeps a running listing of those invoice numbers and ticket totals. When we are -- One way of looking at it is it keeps a -- It keeps a listing of the cash inventory that's coming into a drycleaning shop. The inventory, of course, is the cash that you have there and and [sic] then your cash register

keeps track of the dollars that are leaving the drycleaning shop. The listing machine of itself doesn't keep a running total of the inventory. The total of the inventory, the cash total can only be generated when you actually go out and do a physical inventory of the laundry tickets.

[60]Q When you do that, what physically does the machine do?

A Well, the "Datamark" since it's keeping a listing of these tickets that are in the inventory and cash totals, you plug your "Datascan" into the "Datamark" and that dumps the information from the "Datamark" into the "Datascan" then in theory, the "Datascan" has all of the I'll say the cash that has come into the business, you take the "Datascan" and you wand out any tickets -- When I say wand out, you wand through the bar code on those tickets and then --

Q Which tickets are those?

A I'm sorry. Those are the laundry tickets. When you wand those tickets, it subtracts those tickets from the "Datascan" and and [sic] then at that point your "Datascan" in theory should have all of the tickets that are throughout the drycleaning plant so you take your "Datascan" and you wand through every ticket that you can find in the drycleaning plant and it will give you a list of -- First of all, it will give you a total of the inventory and it will calculate it at that point then it will give you a list of all of the extra invoice numbers and ticket totals that are found and then also a list of all the missing invoice numbers and ticket totals that it could not match up.

[61]Q Now, a number of people have been referring to a blow-up which is over here by the jury which has been marked as Plaintiff's Exhibit 8-B and I'll bring it around so we can all see. This is part of the "Datascan" brochure. It has on it pictures of three different reports, does it not?

A Right.

Q One says inventory. Would you tell us what that is?

A That was the inventory that I was referring to just a few minutes ago. There's a date on that inventory. That would have been the date at which point an operator would have taken the "Datascan" and gone throughout the drycleaning plant to wand all the tickets. The listed invoices --

Q That's the middle one?

A No. Would you like me to explain the ticket?

Q Yes, would you please?

A The listed invoices represents the invoices -- invoice dollars that it found of the ticket that you wandered through. The extra invoices represent the extra invoices that were found that shouldn't have been there for whatever reason and dollars that they represent. Since you had no listing of that invoice number, you would have to manually enter the dollar amount. You'd have to take that right off of the ticket.

[62]Q Does this report, the inventory report ever list all of the invoice numbers?

A No, sir, it does not.

Q So there's no way of tying a number to that report?

A No, there isn't.

Q That's only with your -- That's only --

What is this missing invoices [sic]?

A Right above that it has the total inventory. That would be the calculated inventory that it found from you wandering through. At no point did it maintain that total. It's that total that's calculated as you wand it through the drycleaning shop.

Q That's not the total that comes from the "Datamark" itself?

A No, it's not. It's something you go out and find. It's a total that's generated as you're going through and wandering those individual invoice numbers.

Q The invoice listing, what's that?

A The invoice listing you notice there's a date up there, 4/25. That represents the invoices that came into your drycleaning shop for that day like 4/25.

Q That information does come from the "Datamark"?

A That comes from the "Datamark" but in no way does that represent an inventory. All that is is the amount of business

that came into your shop, say, on one day. Now [63] you could get a total for all of the days but still in that case, it's not an inventory because it in no way reflects the amount of business that's being paid for at the register.

Q Would you explain that to me?

A Well, that invoice listing represents the business that's coming in, your business through the listing machine.

Q What happens -- How does it record if it does something that goes out?

A Well, the only way to record what goes out is to physically go over to the machine and remove it or as I mentioned previously, take the "Datascan" and wand those invoice numbers out.

Q Now where it says "Invoices removed".

A That's what I just described. Those would be where the stack of invoice [sic] you had wand through the bar codes and that would remove the bar codes from the record.

Q Does the "Datascan"/"Datamark" system create another report?

A The "Datascan" does not I believe. The "Datamark" generates some other reports.

Q What reports are those?

A The "Datamark" will generate what we call an "X" reading and also a "Z" reading. An "X" reading is like a [64] subtotal. As you're running tickets through your listing machine, the "Datamark", it's keeping a total of the ticket totals. As the ticket goes through, it's keeping a total of all the tickets and an "X" reading would be just a reading that accumulates. A "Z" reading is -- When you take a "Z" reading, it zeros it. There's one other too. It prints out a production report.

Q What goes on the production report?

A A production report is basically nothing more than a total of each of the items and I should say each of the types of items that has gone through the machine. In other words, if I started a production report on the first of the month, as I'm running tickets through, it might say pants and the number of pants that went through the machine accumulate. At the end of the month, I could zero that or I could let it keep running. It's just a running total. A lot of drycleaning managers will pay the production help off of that. Again in no way does that represent an inventory total.

Q Is that report -- Does it have invoice numbers with it?

A No, sir, it does not.

Q Is there any report that your system generates that ties invoice numbers and description of clothing together?

A No, there's not.

[65]Q Is your system capable of identifying spurious additions or deletions to inventory?

A No, sir.

Q Can it localize it?

A No, it can't.

Q When I say spurious additions and deletions to inventory, I'm referring to articles of clothing.

A Right.

Q Why can't it?

A By its very nature it's portable and there's no way of identifying where it is you're reading the particular ticket. In order to use the "Datascan" properly, you have to wand through every ticket in the drycleaning shop rack. It means not only the tickets hanging up on the rack but any of the tickets in the process. In other words, the reading of the ticket is of no value to the operator.

Q You're not reading it at any one location?

A No, sir.

MR. GRIFFIN: Thank you.

CROSS EXAMINATION

BY MR. MALLIN:

Q Good afternoon.

Is it true that you have a great deal of difficulty with the language of patent claims?

A I suppose not any more than anyone else does.

[66]Q Well, put it this way. You do remember I took your deposition in Houston?

A Yes, sir.

Q I went there and counsel representing you was there and a court reporter took down what we said and you took the oath?

A Yes, sir.

Q And at that deposition did you tell me, say to me, "I will tell you up front that I have a very difficult time with language in patents"?

A Yes, sir.

Q There's no question about that, right? You're not meaning in anything you said today, and I'm not suggesting, to be changing that testimony, are you?

A No, sir.

Q In the "Datamark" system, is it also true that you told me in Houston that the information that the customer brought in is stored in the "Datamark"?

A Yes, sir, there is some information that's stored in it.

Q And, for example, even after a description of an article is printed, you can press the right buttons and brings up on the display what it said?

A I don't understand.

Q I assume you know how to work this?

[67]A Yes, sir.

Q Maybe you can come down and show us.

(Witness stepped down to the exhibit.)

A What would you like?

Q Is it on?

A It looks like it's -- Okay, I --

Q Now the customer had come in and I give you a red dress and and [sic] a blue suit. What would the attendant do?

A He would grab a ticket first thing.

Q A ticket does not have a bar code?

A That's correct. He'd slide it in the machine. He would type in strip tag number, press the "Enter" key and then he would start marking in the clothes. You said --

Q A red dress I think I said.

A Okay. Dress red, enter, and a blue dress.

Q A blue suit I think I said.

A Two-piece blue suit, enter, okay.

Q Each of those items are now printed on the ticket even though we can't see the ticket?

A That's correct.

Q What does the display screen say now?

A It says suit two, blue, 5.50.

Q If you wanted to check what the first item was, is there a way to bring that up on the display screen?

A Sure. You press the "Clear" key. There's the first [68] item and then there's the second item.

Q Which says --

A Blue suit.

Q I want to see the first item again.

(Witness demonstrated.)

Q And that says dress red?

A Yes, right.

Q If I'm following you correctly, you printed those two items on the ticket, they've already been printed and yet you can go into the memory and bring out on the display screen the description of each of those items?

A It's stored in a buffer until the ticket is printed.

Q But it's there in the memory to be brought up?

A That's correct. There would be no way of getting it otherwise to the printer.

Q That's the point. It goes in the memory as a way of recording on the ticket what the items are?

A Correct.

Q That's what you mean by getting the printer.

Please turn it off.

MR. GRIFFIN: No, please don't turn it off because I'd like the jury to see when you total the ticket and you can't get the information out of it.

BY MR. MALLIN:

Q Total the ticket. Mr. Griffin wants it totaled.

[69] (Witness did so.)

Q By using the memory, the items have been recorded on the ticket?

A That's right. They've been recorded on the ticket.

Q And I think what Mr. Griffin wants to be brought out at this point you cannot pull the description of the individual items out of the "Datamark".

A The "Datamark" right now has no record, has no record of the red dress or the two-piece blue suit.

Q So what you're saying according to your testimony at that point when you printed it out, the red dress and the blue suit left the memory of the computer?

A That's correct.

MR. MALLIN: Is it all right to turn it off now?

MR. GRIFFIN: Why don't we just leave it on?

(Witness resumed the stand.)

BY MR. MALLIN:

Q I put Exhibit 8-B up again which is a blow-up of a sign of a Westview document, right?

A Yes.

Q I assume when that document was issued, you reviewed it back whenever?

A I'm sure I have read it, yes.

Q Now one of the reports shown there -- And this is [70] meant for customers to look at, right?

A Yes.

Q We have it blown up so the jury can see it more easily here but Exhibit 8 is the way it ordinarily exists in the ordinary course of business?

A Yes, sir.

Q And it was meant to be sent to customers so they could read about Westview's inventory reporting system, isn't that correct?

A Yes.

Q Incidentally, Mr. Jenkins, you do agree with me that the Westview system is an inventory reporting and control system?

A Well, I think you're mixing apples and oranges a little bit.

Q Mr. Jenkins, didn't you tell me in Houston that the Westview system was an inventory control and reporting system?

A Yes, but there's --

Q You told me that straight out in those words. I asked you directly in Houston. I came down there to find out what this

case is about and you sat there under oath and I asked you at that time whether Westview's system was an inventory control and reporting system and you told me yes, didn't you?

[71]A Well, there's two --

Q Did you tell me that?

A Yes.

Q Okay. Now --

MR. GRIFFIN: Perhaps you could do --

Excuse me, Your Honor. I object. I think he ought to give the same courtesy [sic] --

THE COURT: Sure.

BY MR. MALLIN:

Q Have you changed your mind?

A Not at all. I haven't changed my mind.

MR. MALLIN: Your Honor, if he hasn't changed his mind, I think we can go on to my questions now.

THE COURT: Just like I did with your client, Counsel, let him finish his sentence. He had a "but" there and I think you inadvertently --

A There's two types of inventory a drycleaner is concerned about. If he doesn't have an idea what it represents in what the inventory is in dollars that's cash and that's represented by dollars on the bottom of each of the laundry tickets, that's the amount of business dollars that he receives for the work that he performs for his customer.

The other type of inventory that he's concerned about because customers will give him a problem if he's [72] not is the items, the individual articles of clothing. That's another type of inventory. If he is not careful with that type of inventory, he has a problem also. The "Datamark"/"Datascan" was designed to take care of the first type of inventory.

Q When we had our discussion in Houston, you knew it was in connection with this patent infringement case, right?

A Yes, sir.

Q And you read the pleadings. You knew what the case was about in general?

A That's right.

Q Although I understand you have trouble with language of patents, I want the record to be clear. In Houston did this happen at the deposition:

"Question: Mr. Jenkins, I want to ask you a number of questions about the inventory control and reporting system marketed by Westview comprised of the "Datamark" XI and a "Datascan". First of all, is it correct that those two pieces

of equipment together comprise an inventory control and reporting system?

"Answer: Yes."

MR. GRIFFIN: Mr. Mallin, could you please tell us what page you're on?

MR. MALLIN: Yes, I'll be happy to. 93.

[73]BY MR. MALLIN:

Q And you answered, "Yes", is that correct and at that point you made no distinctions or discussions of any special meaning or different types of inventory control system, is that correct?

A That's correct.

Q You answered it with a straight yes.

Now on Plaintiffs' Exhibit 8 in it's [sic] normal size form which was sent out to customers to look at, you informed customers, Westview but you read it, and potential customers that the Westview system was America's first choice for inventory control, isn't that correct?

A Yes, sir.

Q And on the back of the form you gave examples of reports prepared, isn't that so?

A Yes, sir.

Q And one of the reports has the title "Inventory" on it. Now I want to make sure we understand this and like television, cross examination isn't for us to have an argument but just so we can understand your testimony, that first says, "List of invoices". Do you see that?

A Yes.

Q And it has a figure under it. What does it represent?

A That figure represents the invoice dollars that the [74] "Datascan" was able to find.

Q And the "Datascan" er -- Where you got that was from the "Datascan"er?

A I got it from the "Datamark". You're talking about the information?

Q The listed invoices. Where did that come from?

A The printout was from the "Datascan".

Q The printout of the report was from which?

A From the "Datascan".

Q From the "Datascan"?

A Right. That report was from the "Datascan".

Q And where did the information come about the number of listed invoices?

A From the "Datamark".

Q Had it been unloaded into the "Datascan" yet?

A In order to get that report, it would already had to have been done at that time.

Q Do you mean unloaded?

A It would have to have been loaded into the "Datascan", yes, sir.

Q So the invoices are listed by pressing the keys and they go into the "Datamark" and then they're unloaded into the "Datascan"?

A At some future point, yes.

Q And what I'm trying to get at is those listed [75] invoices at that time all represent the dollar value of all invoices that have been put into the "Datamark" whether they're present in the "Datamark" or the "Datascan", is that correct?

A That list of invoices is the list -- It's the dollar inventory that was found by the "Datascan" as you went through the plant and wanded all the tickets.

Q Could you do that wandering at the point where the customer is taking the orders back?

A When the customer comes to pick up their clothes?

Q Yes.

A It wouldn't have any value. It would have no value at all.

Q My question is could it be done?

A I suppose so.

Q Is that one way when the customer comes to pick up the clothes that you take that particular transaction out of the "Datascan" or "Datamark" by wandling it out when the customer picks it up?

A It might be done that way.

Q Or the attendant gets a batch of invoices and wands them out?

A Right.

Q On this particular report, this is what's listed by going through and finding out what's hanging on the racks [76] or wherever to find out what's listed?

A The key word is "wherever". I'd have to be anywhere in the drycleaning shop.

Q Now the next line is "Extra invoices". How does the Westview system determine that there are extra invoices?

A Well, as you're wandling invoices, if you found an invoice, you'd wand that invoice, you'd wand the bar code on the invoice and then the "Datascan" would beep to tell you that it could not find that invoice so at that point you'd have to take the ticket and then wand in because there's a

little keyboard on the "Datascan". You'd have to wand in the amount of that ticket and that's the number that's represented there.

Q Now the next item is the missing invoices. How does the Westview system find the missing invoices?

A Well, since the "Datascan" is loaded up with these invoice numbers and ticket totals and as you've gone through your entire plant and wanded the invoice, the bar coded invoice, then if it cannot find an invoice that the "Datamark" says is there, it will flag it at least in the computer and then when it does the printout, it will find all the flagged invoices and print it out.

Q Is it fair to say that the computer compares the information obtained by the "Datascan" with the information in it to determine whether something is [77] missing?

A Okay. That's confusing because the "Datamark"/"Datascan" system is actually two computers. There's the "Datamark" is a computer and the "Datascan" is a computer so the actual comparing is done in the "Datascan".

Q But in the computer the comparing is done --

A In the "Datascan".

Q In the "Datascan" the computer comparing is done?

A Right.

Q And the report is printed up of the type you described?

A That's correct?

A So when the system is used this way, it's not necessary for anyone to do it manually?

A No, it's not. That's what it replaces.

Q And then on missing invoices I see the first one the 7.98 I assume is \$7.98?

A Yes.

Q And then the zero, zero, two, seven, five is what?

A That's the invoice number.

Q That would be the invoice number represented by the bar code on that invoice. By this system the "Datascan" has looked at the bar code, made the comparisons you have described and then the report prints out the missing [78] invoice number and the dollar amount of that invoice, am I correct?

A That's correct.

Q And it goes right on another invoice dollar amount and so on and then it comes up with the total of the missing transactions?

A The missing invoice.

Q The invoice represents a transaction, doesn't it?

A Not really.

Q Then on this the invoice is totaled.

Just so I'm clear, the Westview system can detect the additional invoices and the missing invoices and put that report out?

A Yes.

Q And it does not tell you which particular items of clothing are in the transaction are represented by the invoice?

A No.

Q The Westview system does not have individual bar tags attached to the individual item of clothing?

A It doesn't have any tags of any kind attached to the clothing.

* * *

[79]Q The other two reports we covered but the one on the left is a report of invoices removed?

A Yes, sir.

Q Is that referring to when the customer comes in to move -

A It's whenever an invoice is left at a drycleaning shop.

Q And which of the two pieces of equipment prints out this, the "Datascan"?

A The "Datascan".

Q What period does this report cover?

A It could be at any time.

Q So up to that point?

A Correct.

Q And the middle report invoice listing, that's printed out by the "Datascan" also?

A That's correct.

[80]Q What period does that report cover?

A It's variable. It depends on what date you're requesting it for.

Q If you requested it as of a particular time, could you get it up to that time?

A No. It would be by month and day.

Q Any day that you wanted it you could get it.

A If it was in the memory.

MR. MALLIN: That's all I have, Your Honor.

THE COURT: Thank you.

MR. GRIFFIN: Your Honor, very briefly.

REDIRECT EXAMINATION

BY MR. GRIFFIN:

Q Mr. Jenkins, just for trying to explain the middle report, and I think it's unclear as to how you get that report, what period of time it covers and what it represents so if you could just tell that to the jury please?

A The invoice listing has a list of the invoices and the dollars associated with that invoice and it represents whatever those invoice numbers and dollars that were transferred from the "Datamark". If you -- Let's say you opened -- If you opened up a brand new store and had no invoices or no clothing and started accepting clothes, that -- and you left that invoice running without taking [81] out any invoices, removing any, that invoice listing would just keep running. It would be just adding to the invoice listing by invoice number and dollar amount so it represents the invoices that have come into the drycleaning shop through the listing machine minus any invoices that have been removed at some point.

Q You said that in response to one of the questions from Mr. Mallin that an invoice does not really represent the transaction. What did you mean by that?

A Well, it's my understanding that a transaction has to involve articles of clothing. If you don't have at least one article of clothing, you have no transaction.

Q How much information can the "Datamark" itself store?

A The System III "Datamark" has 2,000 bytes of memory available for storing invoice numbers, ticket totals.

Q That's called two kilobytes?

A Two kilobytes, exactly.

MR. GRIFFIN: Thank you.

RE CROSS EXAMINATION

BY MR. MALLIN:

Q Just one thing, Mr. Jenkins. In the ordinary course of running a drycleaning establishment, when you use a "Datamark" and print a ticket, have an invoice without transaction, it has one or more articles of clothing for that transaction?

[82]A Yes, sir.

Q You're raising a point and theoretically there could be an invoice without having articles?

A No. There would not be an invoice without articles.

Q When you go through here, do you print the bar code and you have the invoice, you have articles?

A That's correct.

Q And there's a number in that, number on that invoice which is readable and it's in bar code and that's what can be referred to in the various steps and reports where you can locate or try to locate that invoice through the number and bar code?

A That's correct.

Q And the invoice has articles associated with it?

A That's correct.

MR. MALLIN: That's all, Your Honor.

MR. GRIFFIN: Thank you, Mr. Jenkins.

THE COURT: Thank you, sir.

(Witness excused.)

MR. GRIFFIN: Your Honor, at this time we'd offer into evidence Defendants' Exhibit 32, which is the certified copy of the file wrapper for the original patent, Defendants' Exhibit 4, which is the certified copy of the file wrapper for the reissue patent, Defendants' Exhibit 76, which contained the prototype printout Mr. [83] Markman identified and, Your Honor, Defendants' Exhibit 3-A and Defendants Exhibit 4-A which are blow-ups of portions of the patent.

At that point, Your Honor, on the issue of infringement, we rest and renew our Rule 50 motion.

THE COURT: I'll defer on that.

MR. MALLIN: Your Honor, I offer Plaintiffs' Exhibit 26 which is a "Datascan" operating manual.

MR. GRIFFIN: He's out of time and out of order but I have no objection, Your Honor.

THE COURT: Same ruling. Without objection it is admitted.

MR. MALLIN: That completes the infringement issue.

THE COURT: Both sides rest on the infringement issue I take it?

Okay. Let me see counsel if I may at side bar for just a moment.

(At side bar.)

THE COURT: I rule as follows on the points for charge. All points for binding instructions are denied at the present time without prejudice. I will charge on the burden of proof and the meaning of preponderance. I will explain as best I can the two-step analysis for infringement. I will describe the dependent and [84] independent claims. I will explain the doctrine of equivalence. I will explain the doctrine of file wrapper estoppel without using that name. I will cover the substance of all of the points which you've submitted on

those subjects in my own words and I will use standard instructions on expert testimony, the role of the jury and credibility.

* * *

MR. MALLIN: May I ask, first of all, I take it [85] our particular points have been rejected.

THE COURT: I'll cover them in substance but I'll use my own words.

MR. MALLIN: I want to be sure I have my objection on the record.

May I ask a couple of questions?

THE COURT: Certainly.

MR. MALLIN: Will you instruct the jury that the way to measure infringement is to compare the accused device to the claims patent?

THE COURT: Yes, sir, in substance I will. The doctrine will get across though.

MR. MALLIN: In substance you will also explain you do not measure infringement by comparing the accused device to preferred embodiment or commercial embodiment?

THE COURT: In substance I will. I'll use my own words.

MR. GRIFFIN: If the issue of interpretation of the patent which is to be judged against is a question for the Court, are you going to instruct them on the scope of the patent?

THE COURT: I'm going to explain it as best I can basically using the terminology in the patent but attempting to simplify it and and [sic] interpret it so it's understandable in eliminating some of the jargon but [86] essentially going by those claims.

MR. MALLIN: Your Honor --

THE COURT: I'm sorry. I didn't mean to walk away from you.

MR. MALLIN: We're going to start the argument right now?

THE COURT: I think so. Yes.

(In open court.)

THE COURT: Okay. We've now concluded the presentation of the evidence on this stage of the case and the next stage of the case is that each of the lawyers has an opportunity to argue his position and summarize his position for you. Under our rules, the plaintiffs' attorney goes first, the defendants' attorney goes second and then the plaintiffs' attorney has the right of the third speech.

Don't worry about all the exhibits. We'll send them all out to you at the conclusion of the case and you can look at them to your heart's content and I will also after all the

speeches are done explain to you the law which will be binding upon you for purposes of the case. And the next stage will be to listen to these very able lawyers sum up on this phase of the case which they will now do.

Is plaintiff ready to close?

[87] MR. MALLIN: I think I need to check where some of the exhibits are.

(Pause)

THE COURT: When I say exhibits in the case, ladies and gentlemen, the question that you will have to answer is do the products manufactured by defendant Westview infringe any of the following claims of plaintiff Markman's patent and then you will answer yes or no as to the three claims at issue in the case which are Claim No. 1, Claim No. 10 and Claim No. 14 and you will have in the jury room with you the Plaintiffs' Exhibit No. 1 and that will contain the three claims that I have referred to and then you will keep an open mind, of course, until you've heard the lawyers and until you've heard my instructions as to the law and then you'll talk it over and make your decision one way or the other with regard to those three claims.

MR. MALLIN: May it please the Court, ladies and gentlemen of the jury.

This is summation and the summation only on the infringement part. Plaintiffs respectfully submit to you that the evidence shows that Westview Instruments' inventory and control system comprised of the "Datamark" and the

"Datascan" infringes Claims 1, 10 and 14 of Plaintiffs [sic] Exhibit No. 1, Mr. Markman's reissue patent.

[88] Up until this point you haven't, although you've seen blow-ups, you real [sic] really haven't had an opportunity to look at the patent in detail and I recommend that to you when you go into the jury room for your deliberations on the infringement issue to determine whether the plaintiffs have proven infringement by a preponderance of the evidence. Remember when we had an opening statement, we were dealing with other issues. We talked about other issues that had to be proved by clear and convincing evidence. That's not so on infringement. The question is whether plaintiffs have have [sic] proved infringement by preponderance of the evidence.

I respectfully submit to you that you can return that infringement is clear. You can go in, you look through the patent. The patent has certain information on the front. It has drawings and specifications and it has something called the preferred embodiment and that has been explained is simply setting forth one way to practice -- that's what lawyers use -- practice the invention. It does not give you the scope of the claim. It gives you one way to practice the invention and it can give options.

For example, this patent says over and over again, over and over again [sic] that you can have an inventory control system that deals with the transaction that has [89] articles associated with it, that the ticket is associated with the transaction, associated with the batch if you will and you find this patent uses the word "batch" or you can do it by individual articles by keeping track of the particular dress or

a suit. You can do it one way or the other then you come to the claims and there are 15 of them in the reissue patent. It's important to note the plaintiff says Westview has infringed three of those claims: 1, 10 and 14. We do not claim that they have infringed all of them nor do we have to claim that they have infringed all of them. Infringing one is enough to create liability for infringement. We claim that they have infringed three of those claims and that's determined by measuring the accused Westview system against the claim, not against a Mr. Markman option or some alternative way of doing it in the preferred embodiment which is the way to get it in the public domain. Everything gets in the public domain except the claims from the beginning and even the claims go in the public domain afterwards. That's what makes our patent system so important to the progress of science and the useful art and I tell you if those patents can't be enforced, then they can't serve that purpose and the trouble with this case is that defendant has been busily proving that the defendants do not infringe Claim 5 and 6.

[90] See, Claim 5 says the system of Claim 1 that means you've got to have what's in Claim 1 but then it goes on and adds some things: "Wherein the written record has multi separate -- written parts concurrently including an establishment ticket and a plurality of tags, at least one of the tickets and tags having a bar code printed thereon and each tag being detachable from the written record for direct association with at least one of the customer's articles".

So there is a tag on an individual suit. That's something that's in addition to the rest of Claim 1. The size -- Then it goes on.

It would be complete foolishness frankly to think this requirement was back in Claim 1. There wouldn't be any point in adding 5 if that's what Claim 1 meant and the specification says batches are individually. And Claim 6, the system of Claim 1, "Wherein the data input device is a keyboard and the printer is operable to generate tags for direct attachment to article comprising textile materials, the article being pieces of drycleaning".

That's something in addition to Claim 1. Claim 1 only requires -- only deals with the transaction with the articles associated with it. It uses the word "is" on articles. It doesn't require in that claim that there be [91] a written record, a tag or whatever you want to call it on the individual items of equipment.

So while defendants have successfully proved that they do not infringe Claims 5 and 6, that isn't in issue. We never said they infringed Claims 5 and 6. We never said that they attached tickets to individual articles of clothing.

Now we brought to you a technical expert who explained how their system works so you can see how it prints out, you can see how the description of articles are put in memory in order to record just like the claim says and the rest of it to go through. We brought a technical expert to explain that and then we brought a patent expert to read -- this is the way patent law works; it may be a strange way of saying it -- to read the claims on the accused system and he went through the claim item by item which you'll be be [sic] glad to hear that I'm not going to insist upon repeating but he went through the claim item by item to show how that claim reads on the Westview system, the Westview system

as explained in their operating manuals, their brochures and their equipment, all that information came from them and it was explained further by the technical information and our patent expert, a man with immense experience [sic], with immense experience has taught law in an excellent law school, [92] understands what is being done, laid that out very clearly and capably and correctly that shows that the Claim 1 reads on the accused system, so does Claim 3 and when you look at Claim 4, it's obviously without a doubt they all read on the system. He was the only witness that you heard in this courtroom who had that kind of experience, that kind of background and that kind of knowledge to read these claims on the accused system. No opposing expert was presented on that. No expert testified for the defendant.

Mr. Jenkins, who is involved in this, gave some testimony on the system indirectly working claim interpretation into it what's an inventory, what's this expecting I take it that you're going to take that back to the claim language but he didn't try to deal with the claim language because he had already testified at his deposition that he has trouble knowing what that means and I'm not criticizing him for that. I mean it's an area of expertise. He has trouble with it so the effort for him to indirectly read the claim, in all due respect, I do not think is entitled to weight but so you have clear-cut testimony from an expert reading the claims, a clear-cut opinion that the accused inventory control system Westview infringes the patent. I respectfully suggest to you that there's no way that that testimony coupled with the other [93] testimony doesn't meet up with to show that these three claims were infringed.

I mentioned to you about the preferred embodiment of the patent which is helpful to go and see what the possibility is but doesn't measure the claim, and, incidentally, the Judge will instruct you that you determine infringement by comparing the accused system to the claims and you do not determine infringement by comparing the accused to the preferred embodiment and you do not determine infringement by comparing the accused system to a commercial embodiment. The fact that Mr. Markman had a number of ideas of what could be done which found their way in their differing claims which deal with specific things just simply means that a defendant infringed one claim but not necessarily all claims. It's not any afterthought for litigation that Claim 1 deals with batches of tickets. The best interpretation and clear interpretation right on -- where it says here: [sic] At least a part of the record, written record to be attached to said articles" -- articles with an "s". To be attached. To be attached doesn't mean attached at a precise moment. Here it is attached to the articles, a batch and in the specifications, it says that any -- he says that any number of times to show it could be done one way or the other, Claim 5 has it the one way and Claim 1 [94] covers the batch. The specifications say the optical scanner reads unique bar codes associated with articles or batches thereof".

Another place it says, "Written records are produced and may be attached to garments".

It goes on another place and talks about individual articles in inventory or for a group of articles in inventory.

The system relies -- I'm quoting from the patent -- "The system relies on the bar code indicia or associated with

articles or batches" and and [sic] that's not the end of it. I don't want to just continue on and on with it so at this point I just simply submit to you based upon the clear-cut evidence of the accused system, it is clear that the claim has been satisfied.

Let me touch on one other point that started out as important and I think it rapidly diminished. "A data processor including memory operable to record said information and means to maintain an inventory report". This is important language. An inventory is maintained and a dollar inventory is clearly maintained. The memory operable to record said information is said very precisely and we saw that a couple of times right in front of us the keys fit the description of the articles in the memory. It's printed out and it's still in the memory until the [95] ticket is finally printed out then there seemed to be some disagreement whether it's accessible or not. That isn't the point. The point is the description of the articles was not contained in the memory until the customer got the material back. There's no reason to do that when we're dealing with batches so that that language it's just like it was drawn to the "Datamark" system. The data processor with memory operable to record said information and memory is operable to record the information on the ticket and the ticket has the list of the individual articles so under Claim 1, Claim 5 is different. Under Claim 1 we have the list of articles on the ticket. It's not required that the articles have tags on it and you follow it all the way through some concept of tracking.

Incidentally, when you read these claims, you won't find the word "tracking" any place. The claims deal with what they deal with. Remember Mr. Chovanes talking about

claims drawing an area, drawing an area and and [sic] if an infringer comes in that area, he has even infringed the patent.

I just want to say one or two other things and I'm going to stop at this point. There was a suggestion -- It's sometimes said that Westview is a small company so maybe it's okay for them to infringe. Of course, that's not the way it works but not only that, Mr. [96] Markman is a small company. He worked by sweat to develop this company. He tried to develop the business. It's gone from three to seven employees over the number of years. He made the invention. I'm not saying to you that you ought to decide in his favor because he's a small businessman but nor should you decide against him because allegedly Westview is a small company. What we should decide and where we are right now is whether this accused system infringes Claims 1, 10 and 14 and when you go to the jury room, you need to look at all three of those claims and I earnestly submit to you that you ought to hearken back to the testimony of the one person that testified who had done this any number of times, who's compared claims to accused devices and knows how to do it and accept his testimony as well as all the other evidence and arrive at a verdict that Westview has infringed Claim 1, infringed Claim 10 and infringed Claim 14.

You don't even have to render a verdict on Claims 5 and 6. They're not going to be submitted to you. The evidence very clearly established that they didn't infringe them. Nobody ever contended it and most of the case we were busy trying to determine whether Claims 5 and 6 are infringed. Look at those when you go back in the jury room. When you see what those mean, what it takes to infringe

those, you'll know that Claim 1 means what the [97] patent expert said it means and the way he read it on.

You can see I have a certain amount of enthusiasm. I've got to watch it. I'll be here for the next couple of hours telling you and telling you and the years during my -- as a student I learned you can only absorb so much while sitting there. I'm going to restrain my enthusiasm.

Thank you and I'll ask you to make a decision in favor of my clients and with that, I'll take my seat. Thank you.

MR. GRIFFIN: Members of the jury, I told you when we started this case that I thought it would come down to couple of very basic points and one of them was this "Datamark" just doesn't have the memory and the capability to do what this patent claims to do.

It's very interesting to me that after I told you that, we went and heard a tortured, tortured reading of the claim. Judge Katz is going to instruct you as I understand it, on the meaning of the other patent but when you go and compare this device to the claim and you take a look at it, you're going to see a lot of things and let's just go back for a few seconds and see what it is. What is it that we have to deal with?

There are a lot of reasons why the Westview "Datamark"/"Datascan" unit doesn't infringe but you only [98] need to look at a couple. It doesn't have memory operable to record. Now we all heard that record only means print out on the ticket. I suggest to you when you take a look at the patent and you listen to the Judge, you'll find -- and

you read this as you go along, you'll see that that doesn't mean just print it out on the ticket. We don't start talking about a ticket, the written record until you get further down in the claim. It's quite obvious that what this claim is dealing with is a computer system which is capable of keeping track of the descriptions, the identity and descriptions of each said articles which is in the first part of the claim, and you heard that the Westview system doesn't do that. The Westview system is an inventory cash control system and the document which has been sitting up on the easel in front of you for the last couple of days says that -- I'll find the exact reference to it on here -- I've got it underlined on my copy. Maybe I'll look at that and come back in a second.

It gives you complete cash control using a simple cash register. You have a record of paid invoices. It speeds up the process of taking a machine inventory. It doesn't maintain an inventory. It doesn't have the ability to go ahead and identify the spurious -- detect and localize spurious additions to the inventory, that is, it can't tell you whether something has been taken out of [99] one place or another. It's not designed to do that. The system just doesn't read on the patent no matter how hard Mr. Chovanes tried to make it. We went through a number of things and some of the examples I made with him: Doesn't this look like a typewriter and couldn't this be a smart clerk. That was to show you that you can take language and try to make it meet any kind of situation here.

The key to the whole thing is it doesn't track articles of clothing through the drycleaning system. It doesn't have the ability to do a number of things that Claim No. 1 says it has to do. Yes, it has a bar code reader. A bar code reader is

not physically attached to the unit. Yes, it gets some information back and forth but the "Datascan" never gets told what the description of the articles -- excuse me -- the identity and description of each said article associated with the transaction. It doesn't create a report of said total and said transactions, then the phrase which Mr. Chovanes tried to read out, the unique sequential indicia and the descriptions of the articles in the sequential transactions. It just doesn't do that and when you go through each of these, you'll see that the system does not infringe and you'll hear from His Honor that before you can find that it infringes that as Mr. Chovanes says, [100] each and every element of the patent in suit has to be present in the accused device and you'll hear that and it just simply isn't there.

Mr. Mallin suggested that you go back and you take a look at the patent. I think you'll find that very interesting. We referred to a lot of places in the patent and we saw people trying to get away from the concept of clothing as inventory for this system as opposed to it being a cash inventory system. The Westview system is a cash inventory system. The claim covers something which can be both but it does itself have to have individual descriptions of clothing and could be in batches but it has to have the description there. There's no way of determining whether someone has taken a shirt out of an order or not and again you'll see that when you look at the patent look -- see what the patent means.

I'm not surprised that Mr. Chovanes, as nice a man as he is, came in here and testified this was infringement. That was his job. He's an expert. He told you he was being paid and he was being paid by the hour to come in and testify.

You heard from the other expert, Mr. Mikula, who told us what the "Datamark" did or didn't do. I was pleased to hear that. He also had a business relationship with Mr. Markman and Mr. Markman just wouldn't, wouldn't [101] address the question of: Did you have descriptions of articles tied to this invoice? He wouldn't do it. He kept going around when he tried to explain why his system wasn't the same as the earlier system and you'll recall I used the deposition with him at that time. He said it was because it didn't have individual items of clothing in an inventory and another thing that people haven't pointed out to you which is very interesting: In Dependent Claim 7, which isn't involved in this lawsuit, it says the system of Claim 1 adapted for specific use in a drycleaning establishment the optical scanner. Now they're going to add more optical scanners along a sequence of retail drycleaning operations. They're going to put them around more places and the indicia and description of articles being reconciled -- They know the system Claim 1 has a -- What they're doing is they're saying they're going to add more optical scanners around the system to be able to find these descriptions of articles of clothing when you get to Claim 7 and you can't get the description of the system from the Westview system. It doesn't do the same thing.

Now I know at this point that I'm probably covering a number of things which you've heard and you've heard way too much and I don't want to go back and go over the evidence you've heard from everyone. I do very much [102] want to thank you for listening to it all and especially for putting up with me when I was getting a little exasperated with Mr. Chovanes. I was at that point trying to go through claims which is one of the things you'll have to do when you

go back in the jury room and I'm sure when you go back and talk this over, you'll find that the system doesn't infringe and one thing His Honor Judge Katz will explain to you is the burden of proof in this case. It is the plaintiffs' burden of proof in here to show you that the "Datamark" does infringe. We believe we've gone a step further and shown you that it doesn't. That isn't our burden here.

I thank you very much and I feel very confident when you deliberate that you will determine that the "Datamark" does not infringe any of the patents in suit.

MR. MALLIN: I'll try to be brief. I have only a couple points to make.

It's one of the saddest things about our litigation process that when there's no answer in the evidence, we all too often make personal attacks. Mr. Chovanes didn't deserve that. Mr. Chovanes, I'm sure you saw, is a high-level person. Sure he consults and he gets paid for his work but he doesn't get paid for his conclusion. What a cynical view of a man who's been a professor at law schools. He's asked to make a study. He [103] gives his conclusion. If the person that hires him doesn't like his conclusions, what is the reason for that? The reason for that. There's no -- Unless you're going to dismiss him by a personal attack. I plead you not to do that. That's not what we're about here.

And then he made an attack on Mr. Markman who made the invention. Mr. Markman was trying to explain to you in answer to questions that there aren't these options to every invention and as you look at these claims in the patent, you'll see they're all there.

Summation by opposing counsel over and over again demonstrated the problem. There must be all this memory because you're trying to keep track of the individual articles like you do in Claims 5 or 6 but look at the specifications. Look at the patent and that's not required for Claim 1. It's simply not required. It's circular reasoning. The accused system cannot infringe because it keeps -- doesn't keep track of the individual items but then when you look in Claim 1 and Claim 10 and Claim 14, it doesn't require that the individual items be kept -- that you tag them. That's Claims 5 and 6. Why would we have 5 and 6 if 1 and 10 -- So you see the circular reasoning and I leave you with one final thought.

We're asking you to find in favor of my clients. You go back to the jury room and you read Claim 1 and you [104] read Claim 10. You read Claim 14 and you look to see if you see the word "track". You won't find it. You look to see if you see the words "individual articles, tags attached to". You won't find it. You look in the specifications and see whether the overall vendor understands that it can be batches and it can be individual articles and you will find that over and over again and then if you look at Claims 5 and 6, you will find that those claims deal with the individual articles and so when you cut the circle and approach it the way the Judge will explain and compare this accused system, compare this accused system to what Claim 1 covers, not what Claim 5 covers or what Claim 10 covers and what Claim 14 covers, I think the conclusion will be clear to you. We only bear the preponderance of the evidence. I think the conclusion of infringement of Claims 1, 10 and 14 are very clear to you. I implore you cast the personal attacks aside,

look at the facts of the law and come in with a verdict for my clients.

* * *

Trial Testimony of September 27, 1991 -- Volume III

* * *

[2] MR. RYAN: Your Honor, this instruction in essence, removes the jury's interpretation of the testimony that was received as to the elements of the patent claims. It attempts to go down and list the elements and make it into a fact, an instruction from you when in fact that's for the jury to decide. As to what, for example, the memory, Your Honor, that is incorrect.

THE COURT: Point out to me what you're saying.

MR. RYAN: It does not infringe the patent on the inventory total. It takes away the discretion of the jury.

THE COURT: I'll have to ask you what is wrong with that. Show me where that's wrong on the Claim 1 that's quoted here. Do you object to the words "and means" because the data processor including memory is able to record, etc. seems to be in there.

MR. RYAN: I wouldn't have any problems with the Court instructing the jury that the system must have a data processor including memory operable to record.

MR. GRIFFIN: The basic problem with it, Your Honor, is that this is an overly vague and ambiguous [3] claim. It's the Court's obligation to interpret to the jury what does it mean.

MR. RYAN: Your Honor, if I may, if we can go back to the patent claim if the Court would note that the data processor only requires memory to record said information -

MR. GRIFFIN: That's a simplistic approach that they've taken throughout this case by separating things and take it apart. If you take a look at the entire patent especially something like Claim 7 where it talks about in the description of the articles, it's clear from the entire patent their system must have information stored in the memory so it's been able to reconcile it to generate the reports and everything down the line and when they try to break it out into tiny pieces, it doesn't work.

MR. RYAN: That's essentially asking for a directed verdict. That's just one example of this thing is one of the defense's problems. They're --

THE COURT: What's the next point that you have?

MR. RYAN: This in particular, Your Honor, "system which does not have memory operable to record and store." That's inaccurate.

THE COURT: Is the word "store" used in the [4] claim? That's all I'm asking you.

MR. RYAN: No, sir. It's not.

MR. GRIFFIN: The word "store" is not used in the claim and in the description in the specifications they specifically use the word "store".

THE COURT: "Memory operable to" -- Okay. What's the next point?

MR. RYAN: And later use, it has nothing to do with it, Your Honor.

THE COURT: Is the later use covered in the claim?

MR. RYAN: Not ours. That's the point.

MR. GRIFFIN: I submit to you it is covered because of the language that's used and the way you interpret that language as against the defendants' claim --

THE COURT: What's the next point that you have?

MR. RYAN: Articles of clothing as Mr. Chovanes --

THE COURT: What does the claim say?

MR. RYAN: Articles.

THE COURT: What's the next point you have?

MR. RYAN: I need a moment to look at it.

THE COURT: I'm giving you the moment. I was just handed it too.

[5] MR. RYAN: The claim doesn't say anything about fixed.

THE COURT: Okay. What the next point?

MR. RYAN: I don't understand -- This has got to be a typo of some sort.

MR. GRIFFIN: There's a typo here.

THE COURT: "Therefrom". Okay. I've got it. Thank you.

MR. RYAN: Excuse me, Your Honor. I apologize. I need a minute to look through this.

Is the Court intending to read any of this?

THE COURT: Just go down to the substantive objections that you have to the point -- I think you're down to the last paragraph.

MR. RYAN: I apologize. I'm bouncing around.

I disagree with this entirely, the language of interpretation.

THE COURT: Don't quarrel about that, Just deal with the last paragraph if you would.

MR. MALLIN: Your Honor, our problem is it just takes certain things out and gives undue emphasis. For example, the claim has a printed bar code coincidental with the transaction. That's there but --

THE COURT: Can I just finish with him, please?

Was there something else, Counsel?

[6] MR. RYAN: Yes, there is, Your Honor. I apologize for my delay.

THE COURT: That's all right.

MR. RYAN: Your Honor, instead of this sentence, why can't we just read the claim -- "must" is pejorative that we don't need to add. I don't understand --

THE COURT: Can you just tell me what part of the last paragraph you object to?

MR. RYAN: That it must be able to detect and localize illegitimate --

THE COURT: But that's what the last paragraph says doesn't it?

MR. RYAN: It says "can" detect and localize. It doesn't say "must".

THE COURT: I understand. Thank you.

MR. RYAN: And this cash inventory, actual physical inventory, Your Honor, we strongly object to that. That's argument of counsel.

MR. GRIFFIN: I believe that's an interpretation.

THE COURT: Okay. Thank you, gentleman.

(In open court.)

THE COURT: This is the moment I'm sure you've all been waiting for, right? Wrong.

This is my opportunity to speak to you and [7] explain the law which you must follow in carrying out your obligations as jurors.

Nothing that I say should be taken by you as an expression of my opinion on the facts. The facts are solely within your province and you call them as you see them.

The record on the facts is now closed on the issue that you have before you in this phase of the case.

It wouldn't be fair to ask: What about this fact? What about that fact? It's either in the record at this point or it's not. If it's in the record, then we rely on your recollection of what the testimony was and what the exhibits show. Be confident in relying on your memory. If it's not in the record, we can't reopen the trial in fairness to both sides. We'd have to resume the trial on this phase. We'd have to give the plaintiff an opportunity to present information about the facts that are missing. We'd have to give the defendant

an opportunity to present information about what's missing. We'd have to give both sides an opportunity to argue about what's missing and that is why the record has to be closed at a certain point or the trial would never end.

The plaintiff, that's Mr. Markman and his company, have the burden of proof. In answering the question that you have before you, "Do the products [8] manufactured by defendant Westview infringe any of the following claims of plaintiff Markman's patent?" and then I list the three claims which are in dispute which I'll explain to you and you'll say yes or no as to the three claims, it is Mr. Markman and his company which have to establish all of the elements which I will give you necessary to prove infringement. If they haven't proven to your satisfaction one of those elements, they lose the case because the plaintiff has the burden of tilting the scales in its favor by a fair preponderance of the evidence.

Now the scales can tilt slightly or otherwise in the plaintiff's favor and if plaintiff has satisfied you by a fair preponderance of the evidence that there was an infringement of the claims by Westview, of course, the plaintiff wins but if a fact is missing or if the credible evidence does not persuade you of one of the elements that I will describe necessary for the plaintiff to win, then your answer should be no to the particular question about the three claims. When I say persuade you by credible evidence, your main task is to use your common sense and I know you've listened. You've listened carefully to the evidence in the case. You've seen the witnesses and you make your own judgment based on the years of living, the relationships you've had, the dealings with people as to [9] what is the truth and that's

your task. You are truth seekers. You have no axe to grind. You are not partisans. If you get stuck, just say: What is the truth? Who is telling the truth? And all of the tests of common sense in judging credibility may be applied by you. What was the witness's demeanor on the witness stand? Was the witness evasive in answering the questions? Was the witness straightforward in answering the questions? Did the testimony of the witness be he an expert witness or an ordinary fact witness make sense and the law trusts you and you alone to make that particular judgment. I have absolutely nothing to say about whom you believe and what you believe. These two parties stand equal before the law. You have heard their case on this phase and you simply call it as you see it.

Plaintiff is claiming damages for infringement of a patent. They call that the patent in suit which the plaintiff owns. The defendants deny that there was an infringement of the patent by the defendant corporations. Once a patent is issued, the law confers upon the owner of the patent the right to exclude others from making, using or selling the patented invention throughout the United States for a term of 17 years, thus, infringement of a patent occurs whenever any person without authority makes, uses or sells the patented invention anywhere in the [10] United States during the 17-year period. The disputed issue for your decision is whether the plaintiff has met its burden of proving by a fair preponderance of the evidence that the Westview products infringed those three claims that I will explain to you in more detail.

Now I'm going to take a drink -- I assure you it's water -- before I go into the explanation of the three claims.

Please don't worry if you don't remember everything because you will have in the jury room with you Plaintiff's [sic] Exhibit No. 1 and that exhibit will set forth the claims that are in dispute in this case. This is what it looks like. It's marked at the bottom, Plaintiff's [sic] Exhibit No. 1, and you will have that and you will see what is claimed is so on and so forth and you'll see in there a Claim No. 1 in the next to the last page and a Claim No. 10 on the last page and a Claim No. 14 which is in a slightly different kind of type so don't worry, you'll have that and you can look at it and study the document to determine the language that the claim uses or the claims, I should say, use.

Claim No. 1 is for an inventory control and reporting system comprising a data input device for manual operation operable to encode information relating to sequential transactions each of the transactions having [11] articles associated therewith, said information including transaction identity and descriptions of each of the articles associated with the transactions.

Claim No. 1 for the inventory control and reporting system also comprises a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions and to generate at least one report of said transactions, the unique sequential indicia and the descriptions of articles in sequential transactions being reconcilable against one another. That's No. 2.

No. 3. Claim No 1's inventory control and reporting system comprises a dot matrix printer operable under control of the data processor to generate a written record of the

indicia associated with sequential transactions, the written record including optically detectable bar codes having a series of contrasting bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles and at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station, whereby said system can detect and localize spurious additions to inventory as [12] well as spurious deletions therefrom. That's claim No. 1.

Claim No. 1 defines a system that "includes a data processor or computer which has sufficient memory to record information about sequential transactions and which also has the means or ability to generate at least one report of inventory total and transaction totals in which the unique sequential indicia or invoice number and the descriptions of articles in the sequential transactions can be reconciled against one another.

A system which does not have memory operable to record information about those matters that I've described including memory operable to record the information including the descriptions of articles in the sequential transactions being reconcilable against one another does not infringe the patent in suit.

The claim also defines a system in which the data processor or computer has the memory which I just referred to and the means to record an inventory total. Further, the claim defines a system which has at least one optical scanner connected to the data processor operable to detect bar codes on the articles of whatever they are that pass a

predetermined station. A system which does not have that does not infringe this patent. The claim is of an inventory and control system which can detect and localize spurious -- that is to say incorrect or [13] illegitimate -- additions as well as deletions from inventory. That is Claim No. 1 and what it means. Mercifully the other claims I will be able to cover much more briefly.

Claim No. 10 is called a dependent claim. Claim No. 1 and Claim No. 14 are what are called independent claims. I'll explain those two notions to you. An independent claim does not refer to any other claim of the patent. An independent claim must be read separately to determine the scope of the claim. A dependent claim incorporates all of the limitations or words of the claim as to which the dependent claim refers.

An [sic] dependent claim includes all of the language in the claim or claims from which it directly or indirectly depends. If you find that the claim on which it depends is not infringed, then you cannot find infringement of the dependent claim. As applied to this case, if you find, for example, that there's no infringement of Claim No. 1, then you cannot find an infringement of Claim No. 10 because Claim No. 10 is a dependent claim. Claim No. 10 is a keyboard having keys specific to a plurality of common attributes of the articles.

Claim No. 14 -- I have finished with No. 1 and 10 now. We're up to 14 -- is an independent claim and [14] Claim No. 14 is an inventory control and reporting system comprising at least one optical scanner operable to detect bar

codes on all articles passing a predetermined station. That's Claim No. 14.

That's all you need to know for the moment about what the claims mean. You can refer to the specific language if you don't remember my use of it. It's not a problem for you to do that.

Before Westview's system can be found to infringe the patent claims in suit, the accused Westview system -- they just use that terminology, accused Westview system, because Westview is the defendant that the plaintiff Markman and his corporation sued -- the accused Westview system must come within the scope of the patent claims that I have described to you, that is, the combination of elements that you find recited in the claims of the patent in suit must also be found combined in Westview's system before Westview's system can be said to infringe those claims. Westview's system infringes plaintiff's patent if it infringes one of the claims, that is, if it infringes Claim 1 and if it infringes Claim 14, the two independent claims, or if it infringes 1 and 10 combined or you could find that it doesn't infringe any of them if that's what your decision is.

In deciding the issue of infringement, the issue [15] is not simply a comparison of Westview's system with plaintiff's commercial embodiment or a preferred embodiment, rather, your decision is to be made on the basis of comparing the patent claims as I've explained them which measure the invention with the accused Westview system that's sitting over there and which we've heard so much about.

In order to find Westview liable for the infringement, the law requires you to do a two-step analysis which I will explain to you now.

First, you must determine the meaning of the claims taking the interpretation as I've explained it to you using the relevant patent documents including the specifications, the drawings and the file histories. As you've heard, the file history is the prosecution history, is the record of the communications between the inventor and the the [sic] Patent Office. Also relevant are other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art.

The meaning must be of an ordinary and of a custom meaning unless it appears from the file history that the inventor used the terms differently. I have interpreted those terms for you. After you've decided what the claims mean, you apply the claims as interpreted [16] to the Westview productions in question to determine if the claims read on them. That's a term of art that these patent lawyers use and what it means is if the words of the claims cover the Westview product -- Frankly I have never heard that term "read on" but your education and mine have improved considerably with these able lawyers explaining these concepts to us and now I'm sure we understand what "read on" means if we didn't at the beginning of the case.

In doing this, you must consider whether or not claims literally cover the products. Literally cover means that all of the structural elements recited in a given claim and having all of the limitations set forth in that claim are found in the accused products. All such elements and limitations must be

present. In other words, each element of a claim is material and essential and for infringement to be found, every element or its substantial equivalent must be found in the accused product.

Now I used the words "or its substantial [sic] equivalent" and permit me to go into an explanation of what that means in the jargon. They call that the doctrine of equivalents but the jargon isn't important and the notion I'm sure you will understand when you hear my explanation.

Plaintiffs in this case argue that their patent [17] is infringed by the defendant's products both literally and because of this doctrine of equivalents. Infringement under the doctrine of equivalents may exist if the accused products perform substantially the same function in substantially the same way as to obtain substantially the same results as the claimed invention.

This insures that minor and inconsequential variations in an element of a patent do not shelter an infringer. What constitutes equivalency must be determined considering the context of the patent and the particular circumstances of the case. It must also be kept in mind that the doctrine of equivalents has certain limits. For example, the doctrine may not be used to support an interpretation that would resurrect or reopen subject matter surrendered or dropped during prosecution by Mr. Markman of the patent application. Also equivalents must be established with respect to the claims of the patent not for the commercial purposes for which the products are used.

In applying the doctrine of equivalents, remember that the infringement requires each and every element of the asserted claims that I've burdened you with in such detail earlier or the equivalent of each and every element that I explained in all of the detail must be present.

[18] One of the limits or restrictions on the use of the doctrine of equivalents is that someone is barred or prevented from taking a certain position because it would be inconsistent with his previous position and it would be unfair to permit him to take a different position now. That simply means that if a patent holder abandoned a contention or point during the application process, he cannot later come back and say that his claim should be interpreted in light of the abandoned subject matter.

The doctrine of equivalents is not to be used to include anything contrary to the limitations expressed to the Patent Office during the application process. This applies to claim amendments to overcome rejections as well as to arguments made to obtain the patent. This means that in deciding what is a substantial equivalent to the literal meaning of the elements of the claim, it is necessary to look at what is in the file history, the application and communication back and forth between the applicant and the Patent Office. You will all have that if you wish to study it in as much detail as you care to.

If the applicant abandoned or dropped the contention or point during the application process, he cannot later go back and claim that his patentt [sic] should be interpreted considering what he originally argued for and later gave up.

[19] He is prevented from later asserting those positions he abandoned or gave up and this applies to amendments made to overcome objections by the Patent Office as well as arguments made by the the [sic] applicant and later abandoned during the application process.

A person may infringe a patent without any attempt to do so if the above-stated elements that I've described are proven by the plaintiff by a fair preponderance of the evidence.

If you decide that plaintiffs have not proven an infringement as to the three claims, that is the end of your deliberations. The case is over. You are discharged and the defendant wins. You would answer "No" to the questions that are submitted to you and you'd notify the clerk and you'd come in and we'd take your verdict.

If you answer "Yes" to one or more of the questions, we will resume the trial and hear the evidence on the remaining issues as to the validity of the patent as well as the issue of the amount of plaintiff's damages and we will hear counsel's arguments and whatever evidence they wish to present on those remaining issues in the case.

Jurors sometimes wonder about how long they're required to deliberate. The answer is that you may take as much time as you need in order to reach a unanimous [20] verdict considering the evidence and the reasonable inferences from the evidence. On the other hand, if you know what your answer is, if you're satisfied from having heard the trial, it isn't necessary to put on a show and take an lot of time. If you know the answer is "Yes", you answer "Yes". If you

know the answer is "No", you answer "No" and we'll take your verdict.

You as members of the jury may not reach a decision based upon speculation, conjecture or guess but may find for a proposition only if there is evidence of that fact or proposition.

In deciding this case, base your verdict solely on the evidence before you and the law as I have given it to you. The law as I have given it to you is binding. You must follow it whether you agree with me or not. But the facts are solely up to you and I have nothing to say to you with regard to the facts. I've tried as best I can not to give you any indication of my view of the facts and you are not the [sic] take any indication about how I think about the facts because they are solely for your determination. I have nothing to say about that.

Discuss and respect each other's views. Your verdict must be unanimous. You would then when you reach a unanimous verdict, yes or no, you see the eight blank lines, you all sign that. You are never to reveal to any [21] person, not even to the Court how you stand numerically before you have reached a unanimous verdict so if you will remain seated for just a moment, I'll see counsel at side bar.

(At side bar.)

THE COURT: Okay. First, the plaintiff, any objections to the charge?

MR. MALLIN: Yes, Your Honor.

THE COURT: Okay.

MR. MALLIN: First of all, we renew our objection to the point being submitted not being granted.

THE COURT: Well, if there's anything specific where I'm dead wrong, just call it to my attention and I'll try to correct it.

MR. MALLIN: The charge indicated in describing Claim 1 that the description, the articles had to stay in the memory throughout the system and the claim doesn't so provide.

THE COURT: What part of the claim are we referring to? Perhaps you can help me. Either side can help me on that issue.

MR. RYAN: Your Honor read verbatim I believe a portion of the instruction which was submitted by defendants this morning.

THE COURT: But where is that issue in the [22] claim, either side?

MR. RYAN: It's in the first element, Your Honor.

THE COURT: If you could just point it out to me --

MR. RYAN: Information --

THE COURT: Data processing --

MR. RYAN: -- including memory operable to record a means to maintain --

I believe the Court's instruction left the impression as defendants requested this morning that articles' descriptions must be maintained in inventory or maintained in memory rather than merely recorded.

THE COURT: (To the jury) Members of the jury, if you'll look at the Plaintiff's [sic] Exhibit 1, you'll see that one of the elements of the inventory control and reporting system comprises a data processor including memory operable to record said information and means to maintain an inventory total, and said information refers back to the earlier part of the claim which is a data input device to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions.

[23] That's what the claim means.

(Continued at side bar)

MR. RYAN: The Court also instructed the jury with respect to the commercial embodiment issue that the jury cannot -- "simply" is the word the Court used -- cannot simply base its decision on comparison between the accused device and the patent language, Your Honor.

Your Honor, a commercial or preferred embodiment is all irrelevant in the determination and shouldn't even be part of the jury's deliberation.

MR. GRIFFIN: I think the Court's charge was clear and accurate.

MR. RYAN: There are things clear in the patent law the inappropriateness of doing that.

THE COURT: (To the jury) I tried to make it as clear as I could and considering my own limitations as an expert in the patent field, I don't know if I did. If I didn't say this, let me try one more time.

In deciding the issue of infringement, you do not base your decision on a comparison of Westview's system with the plaintiff's commercial embodiment, rather, your decision of infringement is to be made on the basis of comparing the patent claims which measure the invention with the accused Westview's system.

Now if the patent claims that I have tried to [24] explain as best I can don't cover the accused Westview system as I have explained in more detail, then there's obviously no infringement and your answer is no.

(Continued at side bar.)

THE COURT: Yes.

MR. RYAN: The Court also gave a very, very lengthy and repeated instruction on the doctrine of equivalents -- excuse me; I'll take that back -- on the doctrine of file wrapper estoppel which is not even a part of this case. There has never been any evidence that anything was surrendered during the prosecution of this patent.

THE COURT: Let me hear the other side if I may.

MR. GRIFFIN: There is in the case statements made to the Patent Office and there's evidence of the addition of the language claim after the first patent was rejected. The statements about that are relevant and should be considered.

MR. RYAN: We agree that the file history with all these other items can in fact be used. That's not the objection. I believe that the Court repeated the doctrine of file wrapper estoppel about four times about the effects of it when it's not part of the case.

MR. MALLIN: Your Honor --

THE COURT: I've got to have one lawyer on each [25] side. I'm sorry.

(To the to the [sic] jury) You may, of course, consider the history of the patent claim and how it went through the Patent Office and I gave you a rather extensive description of the effect of amendments and deletions and I told you how to apply that to interpreting the claim. If you find that is inapplicable because there's no evidence that the amendments or limitations applied to define the scope of Mr. Markman's patent in this case, obviously you don't have to apply all those complicated rules which are called file wrapper estoppel I'm told but I tried not to use the terminology in describing the claim but if you find it doesn't apply, you don't have to worry about it. You just ignore it.

(Continued at side bar)

MR. RYAN: I want to make our position clear that we believe there is absolutely no evidence on file wrapper estoppel or prosecution estoppel and that issue shouldn't be part of the case.

THE COURT: I'll hear the other side.

MR. GRIFFIN: We heard testimony about the additions to the claim which were made after the first rejection so that is -- The Court has a right to consider it in interpreting the -

THE COURT: Let's go on to the next point.

[26] MR. RYAN: The Court's comment by instructing the jury if they found no infringement, they could go home effective -- we find very prejudicial.

THE COURT: What can I do? That's the truth.

MR. RYAN: It's just unnecessary, Your Honor.

THE COURT: Well, I don't see --

MR. MALLIN: There's nothing to do to correct it now but we'd object.

THE COURRT [sic]: I don't know what there is to do except tell them the consequences of their decision if they decide that the case is over.

Let's not argue over it.

MR. RYAN: To put my position on the record, when we were conducting the voir dire, some of the jurors indicated they had some scheduling problems next week which may prevent them from serving on a long case and by offering that up you've given them an opportunity to effectively not have to come back here next week.

THE COURT: (To the jury) Members of the jury, you should not let the fact that a "No" answer will terminate this case affect your decision on whether the decision on the case is -- the answer is yes or no. You have to be intellectually honest and call it as you see it. If an intellectually honest answer is "Yes", then abide by your oaths, answer "Yes" and we'll proceed and [27] hear whatever the other evidence is if that's what your verdict is. If the intellectually honest answer is "No" then you answer "No" and we'll take your verdict "No" in that regard.

(Continued at side bar)

THE COURT: Does the plaintiff have any other points?

MR. MALLIN: No, Your Honor.

THE COURT: Okay. Defendant.

MR. GRIFFIN: Only two, Your Honor.

When you read the Claim 14 to them, you only covered the last paragraph or the last point of it and it would be sufficient I think to point out that Claim 14 has that language in it and they can read it when they get it if necessary.

THE COURT: Okay.

MR. GRIFFIN: And the second point is we want to preserve on the record our objection to proceeding where instead of allowing the jury to deliberate based upon the Court's interpretation, you've asked them to determine the patent because you said to them at one point that: You must first determine the meaning of the patent.

THE COURT: (To the jury) Two points if I may, ladies and gentlemen of the jury. I gave you a very abbreviated version of Claim 14 and Claim 14 is the one in [28] the slightly different color -- not color but different type on Plaintiff's [sic] Exhibit 1 and there's -- You'll have Claim 14 in its entirety but basically it's a data input device having switch means for encoding information, each of the transactions having articles associated therewith. Data processor including memory, a printer operable under control of the data processor to generate a written record at least part of the written record bearing a portion to be attached to said articles and at least one optical scanner for data communication with the data processor and operable to detect bar codes on all articles passing a predetermined station.

Now that's what Claim 14 means and I haven't read even this time all of Claim 14. I've just told you what it means and I have also told you what Claim 1 means and what Claim 10 means and what I tell you about what those claims mean is the Court's interpretation which insofar as I've told you this is what the claim means, that's binding upon you for purposes of your deliberations.

(Continued at side bar)

THE COURT: Anything further?

(No response)

(In open court)

THE COURT: See you when you have a verdict,

* * *

Trial Testimony of September 27, 1991 -- Volume IV

* * *

[1] Has the jury reached a verdict with regard to the question that was submitted? Whichever of you is the spokesperson for the jury can tell me.

THE FOREPERSON: We have, Your Honor.

THE COURT: If you'll be good enough to show the original sheet to counsel just to reduce the anxiety levels.

(The clerk did so.)

THE COURT: Now I'll take the verdict from you if I may.

"Do the products manufactured by defendant Westview infringe any of the following claims of plaintiff Markman's patent?"

First, with regard to Claim No. 1, what is the verdict of the jury, yes or no?

THE FOREPERSON: Yes.

THE COURT: Then with regard to the Claim No. 10, what is the verdict of the jury, yes or no?

THE FOREPERSON: Yes.

THE COURT: And finally with regard to Claim No. 14, what is the verdict of the jury, yes or no?

THE FOREPERSON: No.

[2] THE COURT: Do counsel agree that the verdict of the jury be recorded on this aspect of the case?

MR. MALLIN: Yes, Your Honor.

MR. GRIFFIN: Yes, Your Honor.

THE COURT: Okay. The verdict of the jury is hereby recorded on this aspect of the case.

* * *

THE COURT: I'll hear both sides now as agreed on the motion for directed verdict as to which I deferred previously.

[3] (Jury was recessed for the evening.)

MR. GRIFFIN: Thank you, sir.

This Court earlier denied Westview's motion for summary judgment because it found there was a disputed issue of fact concerning "Datamark"'s ability to store material in memory. The evidence that has been introduced at trial has shown there is no dispute about what the "Datamark" does and its ability to store information.

THE COURT: What about --

MR. GRIFFIN: Excuse me.

THE COURT: Go ahead. I didn't mean to interrupt your sentence.

MR. GRIFFIN: Both the plaintiffs and the plaintiffs' expert and the defendant agreed on how the machine works.

THE COURT: What I was going to ask you was what about that representation in the manual that I referred to when I ruled on your motion for reconsideration? How do you deal with that?

MR. GRIFFIN: If I can --

THE COURT: I forgot what exhibit it is. Perhaps you can help me with your substantive argument in that regard. Do you know what I'm referring to?

MR. GRIFFIN: I believe it's Page --

MR. MALLIN: Plaintiff' [sic] Exhibit 4, Page 3. [4] Plaintiff' [sic] Exhibit 5, Page 7.

THE COURT: Well, I have Plaintiff' [sic] Exhibit 4 and I'm looking at Page 3 and Plaintiffs' Exhibit 5 --

MR. RYAN: Page 7, Your Honor.

THE COURT: And I'm looking at Page 7. Okay.

MR. GRIFFIN: What that --

THE COURT: What's the language? I've forgotten. Where are we on Page 3?

MR. GRIFFIN: I can tell you the one on Page 7.

THE COURT: Okay. That's good.

MR. GRIFFIN: Up at 10, "Once" -- Where it says once the garment... and price are... displayed"

THE COURT: I see that. Let me read that to myself. Okay.

MR. GRIFFIN: What that is is that short process that both Mr. -- I keep forgetting -- Mr. Mikula and Mr. Jenkins described is that before the ticket is completely printed and the bar code is put on it, there is a buffer where the descriptions in that one article are stored until the ticket is printed out. Once the ticket is printed out and the bar code on the bottom is printed, that article description is no longer in memory and there's no association between that article description and the invoice number with the exception that they're both printed on the ticket but there's nothing in the [5] system at that time which would allow anybody to run a

report which would reconcile the invoice number and the article description so there is nothing there that would get to the main purpose of the system as described in the patent which is the inventory and control system whereby they can detect and localize the spurious additions and deletions to inventory and that's --

THE COURT: Spurious additions to inventory.

MR. GRIFFIN: Where that leaves us is just on that point alone which was the point that the Court saw as there being a dispute that there really is no dispute unless you can torture the reading of this patent to say that it doesn't have to maintain the article description in memory so that it can run a report where the unique sequential indicia which would be the number, invoice number and the descriptions of the articles are reconcilable against one another. You can read that out of the patent and you can say you want to take it very literally and you don't want to interpret it in language which I believe is ambiguous at best in light of what is said about it in the specification and in the drawing. We believe that the interpretation of this claim is a question of law for the Court. It's our view of it that when you read this claim in the light of this claim and the dependent claims on it and especially Dependent [7] Claim 7, it becomes quite clear that the system which is described here is one where the extra thing that comes to the ballgame as far as the reconciliation of the unique sequential indicia and the article descriptions is the ability to store that in memory so at least as it says in here, "...to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being

reconcilable against one another" that's the end of that second paragraph in the Claim 1 --

THE COURT: Let me just get that in front of me on Claim 1.

Well, does your client's product have what one could argue to be a short memory to accomplish the --

MR. GRIFFIN: No, sir because it cannot run a report where the unique sequential indicia and the descriptions of the articles can be reconciled against one another.

THE COURT: What about the way they demonstrated it with the invoice being produced? Does that store the memory for a short time and then produces the dress and the coat and so on?

MR. GRIFFIN: What it does is it takes the information and keeps it in a buffer until the ticket is printed. It doesn't keep it there to be able to run a [7] report from it and obviously where it is there is some place where you can't reconcile it because you haven't run the ticket off of it. It's not a way to accomplish the goal of the patented system and the reason, Your Honor, that it becomes more clear when you look at the various different parts of the patent and not even going outside of the claims, when you take a look at Dependent Claim No. 7 where the dependent claim goes on and says this is the one that where they're going to have a series of optical scanners --

THE COURT: I have it in front of me. I'm just reading it to myself.

(Pause)

MR. GRIFFIN: -- that's where they say, "...the indicia and the descriptions of articles being reconcilable at each of said plurality" so instead of it being recognized at one place in Claim 1 now it's reconcilable at a lot of them and that couldn't happen with the "Datamark" system even just one time because it doesn't maintain the description and there is no capability of running the report and I think it is clear, Your Honor, when you look at the various descriptions in this specification and the description of what their particular patented system is to do and it starts off with the entire description of the field of invention where it [8] describes the field of invention is, "This invention relates to inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment."

It goes on to explain it. "... whereby the progress of articles through the laundry and drycleaning system can be completely monitored" explains that the detailed description of the preferred embodiments, what it does or the information and items uniquely positively associated with one another throughout the processing and you take that and then you take Mr. Markman's own earlier testimony where he was trying to show why the Jolicoeur system, which he had earlier developed, wasn't the same as this and he said because it doesn't -- I forget the exact language but the thrust of it was because it doesn't have the individual articles. I think I have the exact language. It's in the summary judgment motion. I'm trying to find the exact quote for you.

THE COURT: Yes.

MR. GRIFFIN: I think Mr. Vogt will pull that out for me.

THE COURT: Okay. Is it the premise of your argument that inventory means articles of clothing not just dollars?

MR. GRIFFIN: I think it means both in this [9] patent, Your Honor.

THE COURT: And that I have to interpret what is the meaning of inventory? Is that the premise on which your contention turns?

MR. GRIFFIN: Yes, sir. That is one of the things that I believe this Court must do.

The actual quotation comes from the Markman deposition of July 16, 1991 at Page 11 and it was attached to the motion for summary judgment as Exhibit "G" and what Mr. Markman was asked about his earlier system and this one question:

"In what way are they different?

"Answer: The bar code was printed on a back space strictly as a turnaround document as a later -- and specific item that are identifiable by a customer who dropped them off and who weren't owned by the customer were not tracked into the inventory control system as they were in the invention."

It becomes very clear when you look at the inventory, when you take a look at the explanation in the specification and read the claim understanding how they describe the words that the purpose of the Markman patented system is to have a computerized -- for lack of a better term -- inventory control and reporting system where they had a data input device, a place to put the [10] information in and making sure that it was able to encode the information about the transactions and it's very clear in the first section what it has to be including transaction identity and descriptions of each of said articles associated with the transaction and if all you were going to say is all you have to do is type up a ticket, that wouldn't make any sense.

And the next one is, "a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential indicia with sequential transactions with unique sequential and to generate at least one report of said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another" and you read that against the later part of that claim where they're talking about the optical scanner detecting things in the bar codes and saying whereby you can locate spurious additions to inventory and various deletions therefrom", it becomes very clear they're talking about a system that will remember something about the description of the article and be able to help track that and then you go through the dependent claims and you can see where that system is built upon and I would suggest to the Court and it is in the record so far in [11] this case even though it was on the infringement part, we did ask Mr. Mikula about the Liberty Lister machine and he said there

was no difference between that and the "Datamark" system except one used a preprinted bar code and "Datamark" used the bar code generated by the machine itself and it makes certain sense that if this patent were only to cover the preprinted bar code because there is no dispute at all about Liberty Lister that Mr. Markman wouldn't say Liberty Lister infringes, then it's clear that the "Datamark" isn't covered by this patent; doesn't read on it. It does not have that system that will keep track of the descriptions of the articles of clothing, tie that to the bar code so you can tie it to the invoice number so you can tie everything in that order together.

THE COURT: Let me hear the other side if I may. I think I understand your argument.

MR. MALLIN: May it please the Court, there is no basis for granting a judgment notwithstanding a verdict. The issue was submitted to the jury by the Court. The Court gave to the jury interpretation of the claims taken in great part from the submission of the defendant some over my objections I may say. It was presented to the jury. The jury had to apply the law as given to them from the Court to the facts they found.

A lot of what we heard just a few moments ago is [12] disagreeing with the facts that we must now take it that the jury found and it's a normal way where the jury applies the law to the facts. Mr. Griffin wasn't up here more than two minutes when he talked about Mr. Jenkins' testimony about something being held in the buffer at some point. He said that to the jury. It did not carry the day with the jury. That's why we have juries. Mr. Griffin has interpretations of Mr.

Mikula's testimony. He has interpretations of Mr. Markman's testimony. I don't accept those interpretations. I don't think that's the point. That all went to the jury. That's why we had the jury in the box to make those determinations. We had a patent expert read the claims on the accused device. We made the demonstrations before the jury. We put the operating manuals in and the brochures in that used words that the information was committed to the memory. One of it says committed to the memory. The other says saved in the memory so without belaboring the point, Your Honor, the jury has spoken. There's no basis for setting aside the verdict of the jury on infringement and I respectfully suggest that the motion should be denied and we should go on with the trial.

THE COURT: May I ask you the same question I asked the other side? In your view -- Let me put it this way. The other side, as I understand it, takes the [13] position that inventory means articles of clothing and dollars. In other words, the other side says inventory means not just dollars. Now let's just assume hypothetically that that's correct just hypothetically. I'm not asking you to agree with it. If that's correct, does your Claims 1 and 10 read on the Westview product?

MR. MALLIN: Yes.

THE COURT: Show me how.

MR. MALLIN: Because the claim says to maintain an inventory total. If the inventory total is in dollars, that's fine. If the inventory total is the listed items, that is fine. A

patent isn't read in the hypertechnical way that they want to read it. The claims are meant to cover things that--

Remember, the claim draftsman isn't sitting with somebody's particular product and describing it. He's describing a concept here. Again Mr. Jenkins testified about inventories. Their own brochure was put in and it says, "Complete cash and inventory reports" -- I'm reading from Plaintiffs' Exhibit 9 which is a "Datamark" brochure that says, "Complete cash and inventory reports production printout is by garment and department."

THE COURT: Can I just interrupt you on that particular point? Assume hypothetically that that brochure is spurious, that is, it makes a claim about [14] controlling inventory which is untrue, that the device I asked you to -- I ask you to assume hypothetically does not control articles of clothing in a drycleaning establishment's inventory. I'm not asking you to agree with those assumptions but if those assumptions are correct, does your claim read on the defendants' device?

MR. MALLIN: I'm not quite sure I follow. The first point is the jury had the right to resolve this to mean whatever they resolved it to mean to fit in the claim. That's what we submitted to them.

THE COURT: But if the device --

Does their device track articles of clothing?

MR. MALLIN: Individual articles of clothing?

THE COURT: Yes.

MR. MALLIN: No. As I said to the jury, their device does not put tags on the individual items of clothing and follow those individual articles. There's another claim that does that, you know. This claim doesn't do that. You interpret the claim and have them to apply it, the jury to apply it so it's a jury question.

THE COURT: Okay. Let me see if I can put it this way. This device of Westview's does not track individual articles of clothing. Assume hypothetically that Westview puts in its advertising the false, spurious claim that its device does track individual articles of [15] clothing. That is untrue. Ask you to assume that.

Does your -- I'm trying to put it in your vocabulary and I'm having difficulty.

Does your Claim 1 read on that falsely advertised device?

MR. MALLIN: I'm still having some difficulty because the claim reads on a device that does what the claim says. I think your question is if they said it put individual article tags on individual items of clothing --

THE COURT: And that was false --

MR. MALLIN: -- and it did, could they be patent infringing? I'm afraid I'd have to hit the law books. I've never had that question before.

THE COURT: It's an open question you say?

MR. MALLIN: I'd have to hit the law books because I haven't dealt with an accuser who tells the world that his product does something and it doesn't. He's getting the benefit of selling what appears to be a patent device in the marketplace but, Your Honor, I've never looked up that legal question and I would not make a representation to the Court as to what the law is on that subject. I would have to search the law and think about it further.

THE COURT: Well, could I impose on you and the [16] other side to focus on that question and just give me what authority you can on it? I'd like to educate myself as best I can. In this field, as you know, I'm no expert in this field and I'd would [sic] very much appreciate both your advices on that.

MR. MALLIN: I'll be happy to do that, Your Honor. I want to emphasize that quite apart from that issue, an appropriate issue was submitted to the jury under the interpretation of the Court on the testimony to determine whether the accused device is explained by the witnesses, our witnesses, his witnesses. It was for the jury and they have spoken and there's no basis for a judgment notwithstanding a verdict to take it away from the jury.

THE COURT: I guess it's really a motion for a directed verdict which if granted would apply to both defendants. I take it that's the posture because there's no judgment.

MR. MALLIN: I think under the rules if there's a motion notwithstanding the verdict -- Because the rule says if you make a directed verdict and it's either denied or not granted,

then you can go ahead with the judgment notwithstanding the verdict.

THE COURT: But there's no judgment yet. You don't have a judgment. You just have a verdict on one [17] phase of the case.

MR. MALLIN: Yes, I understand.

THE COURT: In any event, if I grant the motion, it will apply to both defendants Westview and Althon.

MR. MALLIN: There wouldn't be any -- I take it if you don't think there's an infringement case, if you think that there should be a determination notwithstanding the verdict that there should not be infringement that the accused system does not infringe Claims 1 and 10, that would apply to both defendants. I don't think that's the problem.

THE COURT: On the part of the claim that talks about the optical scanner if I could ask you to take a peek at that with me and help me, "At least one optical scanner operable to detect bar codes on all articles passing a predetermined station."

How does this Westview device do that? Do you say --

MR. MALLIN: They go out with their "Datascan". First of all, they can take out of inventory when a customer comes. They can do that and, therefore, that's one point they can do it. Since it's a portable scanner, they can do it at any point they want to check it at any predetermined point they want to check it. They can do it as the witnesses explained

and Mr. Jenkins had a contrary [18] view and they both had the statements for the jury and that's exactly the kind of issue for a jury to resolve.

THE COURT: Your view of inventory is what? What do you say inventoryy [sic] means?

MR. MALLIN: You've got to look at a particular place. An inventory can be depending on the circumstances of a particular establishment, a business, an inventory in common parlance can be a dollar amount to say I have a million dollars in inventory of widgets or it could be I have a thousand items or a hundred thousand of this or ten thousand of another. You can't read a patent claim -- If one operator has an inventory report that shows items, that's an inventory, another one has dollars, that's an inventory and we saw various reports where they had invoice numbers as well as dollars.

THE COURT: Well, is it your position then that inventory means both articles and dollars?

MR. MALLIN: It can mean either.

THE COURT: But in this --

MR. MALLIN: In this case what it says is maintain an inventory total. A dollar total does it. Some other infringer might maintain a physical total. That would do it too. And of course the descriptions are on the tickets which are reconcilable by looking at the tickets.

[19] Your Honor, I'll be happy to look up, even though I don't think it's directly applicable, I'll be very happy to review the point of law that the Court evinced interest in.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERBERT MARKMAN and POSITEK, INC.	
v.	CIVIL ACTION
WESTVIEW INSTRUMENTS, INC. and ALTHON ENTERPRISES, INC.	No. 91-0940
	[FILED SEP 30 1991 MICHAEL E. KUNZ, Clerk By: /s/ Dep. Clerk

JURY QUESTION

1. Do the products manufactured by defendant Westview infringe any of the following claims of plaintiff Markman's patent?

Claim #1 Yes x No

Claim #10 Yes x No

Claim #14 Yes No x

PLEASE SIGN THE SHEET AND SUMMON THE
CLERK.

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

/s/ signed by juror

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERBERT MARKMAN and	:
POSITEK, INC.,	:
	:
Plaintiffs	: CIVIL ACTION
v.	: NO. 91-0940
	:
WESTVIEW INSTRUMENTS, INC.	:
And ALTHON ENTERPRISES, INC.,	:
	:
Defendants	:

SUPPLEMENTAL REQUESTED
INTERROGATORIES TO THE JURY

Defendant Westview Instruments, Inc. respectfully suggests that the interpretation of the patent in suit is a question of law for the Court. The question of infringement can involve questions of fact. Under those circumstances the Court should have the issue of infringement determined through the use of special interrogatories which ask specific questions about the accused device. Westview requests that the Court utilize the attached interrogatories.

/s/Frank H. Griffin, III
Frank H. Griffin, III
Peter A. Vogt
Gollatz, Griffin, Ewing

& McCarthy
Sixth Floor
Two Penn Center Plaza
Philadelphia, PA 19102
(215) 563-9400

Attorneys for Defendant
Westview Instruments,
Inc.

Dated: September 27, 1991

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs

v.

WESTVIEW INSTRUMENTS, INC.
And ALTHON ENTERPRISES, INC.,

Defendants

Defendant Westview Instruments, Inc.'s
Supplemental Requested Instruction

Defendant Westview Instruments, Inc. respectfully
requests the Court instruct the jury as follows:

You have heard testimony concerning the meaning of the patent claim language involved in this case. The interpretation of a patent, however, is a question which is decided by the Court, as an issue of law. I have reviewed the patent involved in this suit including the claim language, specifications and drawings and the prosecution history of the patent. This patent, the invention, relates to inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment, here dry cleaning and laundry establishments. Claim 1 of the patent in suit reads as follows:

an inventory control and reporting system,
comprising;

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions;

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least on report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefore.

That language, is, in places, subject to different interpretation. I instruct you that when you consider whether the Westview Instruments, Inc. Datamark system infringes you should understand that Claim 1, as stated, defines a system that includes a data processor, or computer, which has sufficient memory to record information about sequential transactions, including the identity and descriptions of the articles of clothing involved, and which also has the means or ability to generate at least one report of inventory total and transaction totals in which the unique sequential indicia, or invoice number, and the description of the articles in the transaction can be reconciled against one another. A system which does not have memory operable to record and store and later use information about or including the descriptions of articles does not infringe the patent in suit.

The claim also defines a system in which the data processor, or computer, has both the memory which I just referred to and the means to maintain an inventory total. A system which does not have both that memory and means to maintain an inventory total does not infringe the patent in suit.

Further, the claim defines a system which has at least one optical scanner connected to the data processor operable to detect bar codes on all articles of clothing which pass a predetermined, or fixed station. A system which does not have that does not infringe this patent.

The claim is of an inventory and control system which must be able to detect and localize spurious, that illegitimate, additions to inventory as well as deletions from

inventory. As used in Claim 1, inventory refers to both cash inventory and the actual physical inventory, that is articles of clothing. A system which does not have that does not infringe this patent.

You must determine whether the Westview Instruments, Inc. Datamark system reads on Claim 1. That is, does the Datamark system have all of the elements described in Claim 1.

/s/ Frank H. Griffin, III
 Frank H. Griffin, III
 Peter A. Vogt
 Gollatz, Griffin, Ewing &
 McCarthy
 Sixth Floor
 Two Penn Center Plaza
 Philadelphia, PA 19102
 (215) 563-9400

Attorneys for Defendant
 Westview Instruments, Inc.

Date: September 27, 1991

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs

v.

WESTVIEW INSTRUMENTS, INC.
And ALTHON ENTERPRISES, INC.,

Defendants

:
:
:
: CIVIL ACTION
: NO. 91-0940
:
:
:
:

MOTION OF DEFENDANT WESTVIEW
INSTRUMENTS, INC. FOR DIRECTED VERDICT
PURSUANT TO RULE 50 OF THE FEDERAL
RULES OF CIVIL PROCEDURE

Pursuant to Fed.R.Civ.P. 50, defendant Westview Instruments, Inc. ("Westview"), respectfully moves this Court for a directed verdict at the close of the evidence offered by plaintiffs.

As a matter of law, plaintiffs have failed to show by a preponderance of the evidence that Westview's DATAMARK or DATASCAN or the combination of the two have infringed the patent-in-suit.

/s/ Frank H. Griffin, III

Frank H. Griffin, III

Peter A. Vogt

Gollatz, Griffin, Ewing &
McCarthy
Sixth Floor
Two Penn Center Plaza
Philadelphia, PA 19102
(215) 563-9400

Attorneys for Defendant
Westview Instruments, Inc.

Dated: September 26, 1991

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERBERT MARKMAN and
POSITEK, INC.,

Plaintiffs

v.

WESTVIEW INSTRUMENTS, INC.
And ALTHON ENTERPRISES, INC.,

Defendants

:
:
:
: CIVIL ACTION
: NO. 91-0940
:
:

ORDER

AND NOW, this 20th day of September, 1991, upon consideration of the Motion of Defendant Westview Instruments, Inc. for Reconsideration of this Court's Order Denying Westview's Motion for Summary Judgment, it is hereby ORDERED that this Court's Order dated September 17, 1991 denying Westview's motion be and hereby is not VACATED. There is a genuine issue of material fact as to whether defendant's product stores in memory individual articles. Compare Jenkins Dep. p. 108 (Exh. B Motion) with Operator's Manual p. 6 attached to plaintiff's Memo in Opposition.

BY THE COURT:

/s/ Marvin Katz J.

[ENTERED: 9/23/91
CLERK OF COURT]

23

Supreme Court, U.S.

FILED

NOV 9 1995

OFFICE OF THE CLERK

No. 95-26

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

JOINT APPENDIX - VOLUME II

WILLIAM B. MALLIN*
LEWIS F. GOULD, JR.
TIMOTHY P. RYAN
STEPHAN P. GRIBOK
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
Telephone: (412) 566-6000
Attorneys for Petitioners

FRANK H. GRIFFIN, III*
PETER A. VOGT
POLLY M. SHAFFER
GOLLATZ, GRIFFIN & EWING
Two Penn Center Plaza
Sixteenth Floor
Philadelphia, PA 19102
Telephone: (215) 563-9400
Attorneys for Respondents

*Counsel of Record

PETITION FOR CERTIORARI FILED JULY 3, 1995
CERTIORARI GRANTED SEPTEMBER 27, 1995

43 pp
8/10

EDITOR'S NOTE

THE FOLLOWING PAGES WERE POOR HARD COPY
AT THE TIME OF FILMING. IF AND WHEN A
BETTER COPY CAN BE OBTAINED, A NEW FICHE
WILL BE ISSUED.

TABLE OF CONTENTS

Page

VOLUME I

Docket Entries	1
District Court for the Eastern District of Pennsylvania, No. 91-CV-940	1
United States Court of Appeals for the Federal Circuit, No. 92-1049	5
Trial Transcript	8
Jury Question/Verdict	282
Defendant Westview Instruments, Inc.'s Supplemental Requested Interrogatories to the Jury	284
Defendant Westview Instruments, Inc.'s Supplemental Requested Instruction	286
Motion of Defendant Westview Instruments, Inc. for Directed Verdict Pursuant to Rule 50 of the Federal Rules of Civil Procedure	290
Order Dated September 20, 1991, Entered September 23, 1991, Not Vacating Order of September 17, 1991 Denying Defendants' Motion for Summary Judgment	292

VOLUME II

United States Patent No. Re. 33,054	293
Respondent Westview Instruments, Inc.'s Advertising Brochure for Datascan	302
Respondent Westview Instruments, Inc.'s Advertising Brochure for Datamark	304
Respondent Westview Instruments, Inc.'s Equipment Price List for Datamark and Datascan dated December 1989	306
Respondent Westview Instruments, Inc.'s Equipment Price List for Datamark and Datascan dated July 1, 1985	307
Excerpt of File Wrapper of United States Patent Re. No. 33,054	308

The following opinions, orders, judgments and memorandum have been omitted in printing this Joint Appendix because they appear on the following pages in the Appendix to the printed Petition for Writ of Certiorari:

Opinions of United States Court of Appeals for the Federal Circuit, filed April 5, 1995	1a
Judgment, United States Court of Appeals for the Federal Circuit, filed April 5, 1995	160a

Order, Ordering, <i>sua sponte</i> , that the Appeal be heard <i>en banc</i> , filed November 5, 1993	162a
Order Providing for Additional Briefing and Other Matters for Rehearing <i>en banc</i> , filed January 7, 1994	164a
Judgment of United States District Court for the Eastern District of Pennsylvania in Favor of Defendants and Against Plaintiffs, filed October 1, 1991	168a
Order of United States District Court for the Eastern District of Pennsylvania in Favor of Defendants and Against Plaintiffs, filed September 30, 1991	169a
Memorandum of United States District Court for the Eastern District of Pennsylvania Granting Motion for Directed Verdict, filed September 30, 1991	170a

United States Patent (19) **Markham**

(11) E **Patent Number: Re. 33,054**
(45) **Reissued Date of Patent: Sep. 12, 1989**

[54] INVENTORY CONTROL AND REPORTING SYSTEM FOR DRYCLEANING STORES

[76] Inventor: Herbert Markham, 631 Farison Dr., Wynnewood, Pa. 19096

[21] Appl. No.: 90,697

[22] Filed: Aug. 28, 1987

Related U.S. Patent Documents

Reissue of:

[64] Patent No.: 4,590,346

Issued: Oct. 29, 1983

Appl. No.: 999,948

Filed: Apr. 13, 1984

[31] Int. Cl.: G06F 15/24; G06F 15/26

[32] U.S. Cl.: 235/385; 235/383;

[38] Field of Search: 235/487; G06F/15/24, G06F/15/26

235/385, 383, 487

[36] References Cited

U.S. PATENT DOCUMENTS

2,881,106 4/1959 Cornwall et al.
3,336,589 6/1962 Smith et al.
3,478,316 11/1969 Block et al.
3,665,164 5/1972 Beveridge et al.
3,876,073 4/1975 Wenzel
4,025,766 5/1977 Ng et al.
4,108,362 8/1978 Tramm et al.
4,135,341 1/1979 Stash et al.
4,141,078 2/1979 Bridgman, Jr. et al.
4,176,260 11/1979 Ward et al.
4,364,396 4/1981 Stewart
4,360,810 7/1982 Chien

OTHER PUBLICATIONS

Computerized Labeling Systems Print Labels As They're Needed, "Modern Materials Handling", Apr. 84.

The Latest Trends in Automatic Identification, "Modern Materials Handling", Dec. 6, 1983.

How We Know Our Customers Receive What They Ordered, "Modern Materials Handling, Mar. 21, 1983.

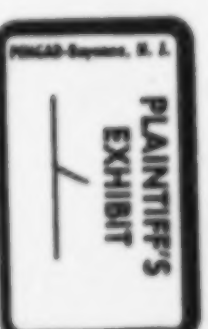
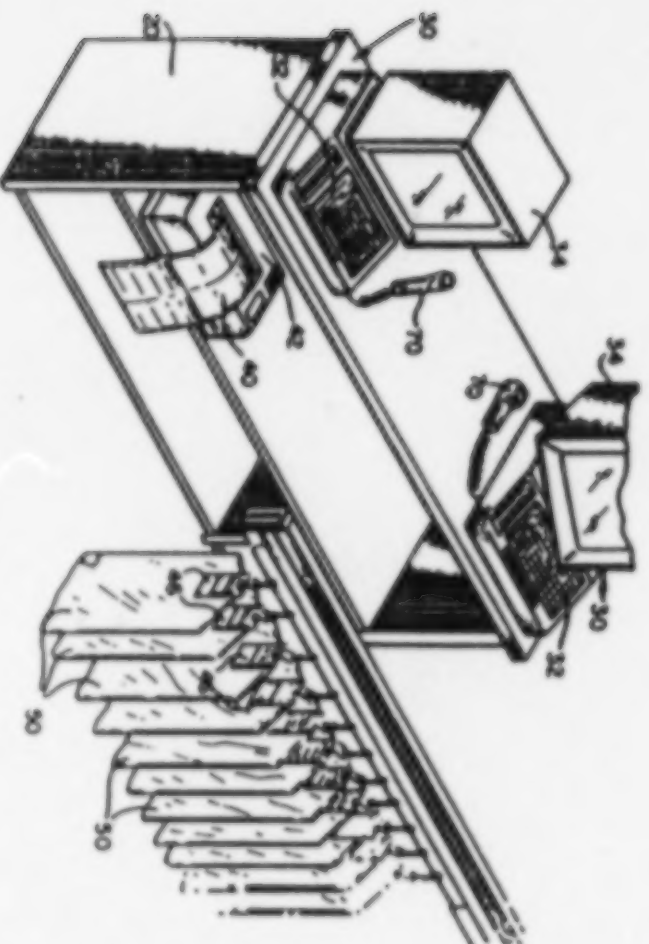
Primary Examiner—Harold L. Pitts

Attorney, Agent, or Firm—Stetle, Gould & Fried

[57] ABSTRACT

An inventory control and reporting system especially for retail drycleaners includes a data input keyboard having key blocks corresponding to information for identification and calculation of processing costs of laundry articles to be cleaned, a data processor adapted to calculate pricing information and to generate reports based upon such data input, the processor being connected to a printer and the processor and printer producing sequential multiple part bar code records and tags for attachment to the laundry articles in sequential transactions, and also as hard copies for the customer and for the establishment. The bar code portions of the records are generated by a dot matrix printer operating in a high resolution mode, the bar code portions being generated for a transaction contemporaneously with the transaction. The bar code tags are attached to articles of clothing and are used with scanning apparatus to facilitate generation of reports according to various management needs.

15 Claims, 2 Drawing Sheets



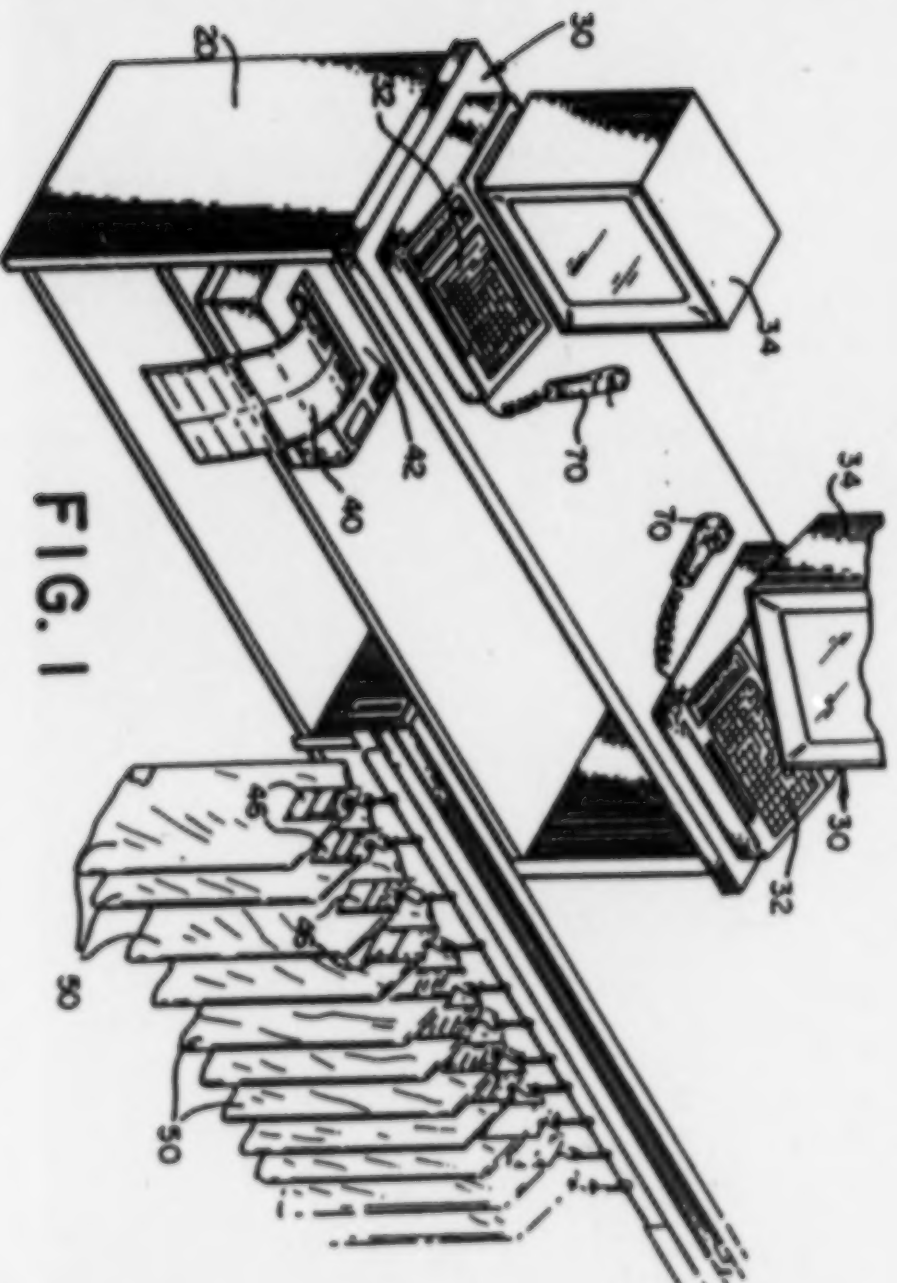


FIG. 1

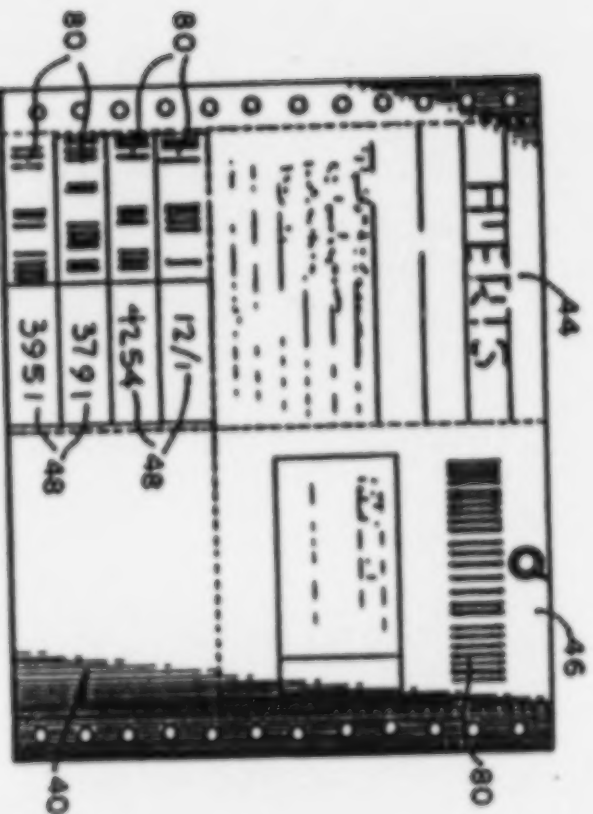


FIG. 2

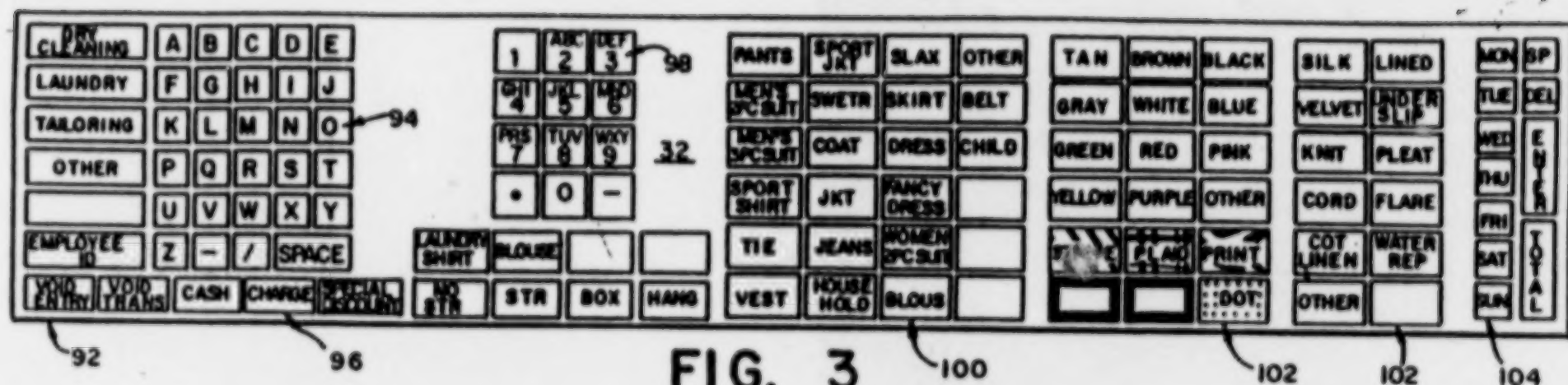
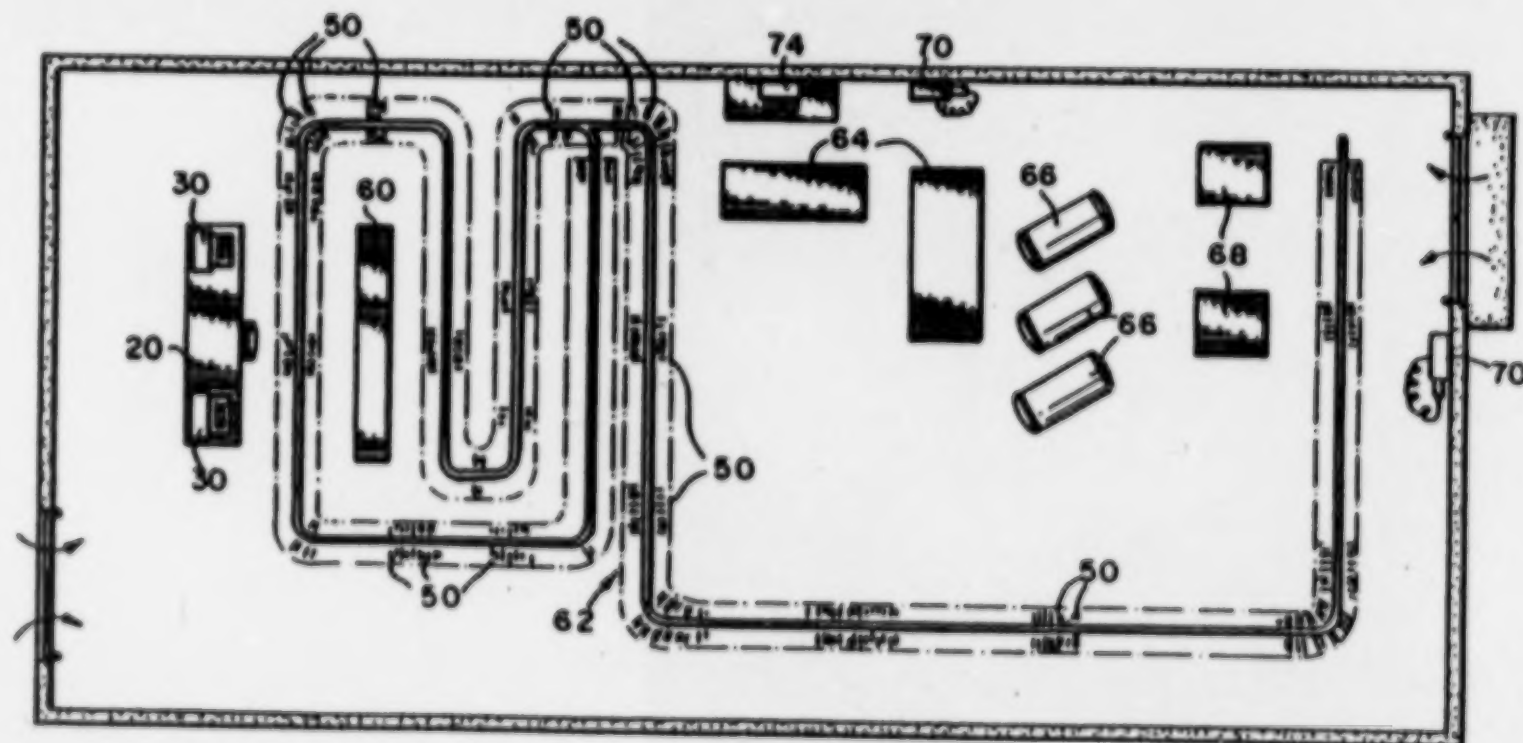


FIG. 3

FIG. 4



INVENTORY CONTROL AND REPORTING SYSTEM FOR DRYCLEANING STORES

Matter enclosed in heavy brackets [] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue.

BACKGROUND OF THE INVENTION

1. Field of the Invention

This invention relates to inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in an establishment. More particularly, the invention relates to such a system especially adapted to the peculiar needs of dry-cleaning establishments.

2. Description of the Prior Art

A basic function of inventory control is the counting of incoming and outgoing materials, and keeping a running total. In some situations, the identity of specific articles must be monitored, making inventory control somewhat more complicated. Automations in marking, sensing and routing can present enormous cost savings over manual operations for such establishments. Although the user is always subject to equipment failure, every step at which manual functioning and decision making can be eliminated likewise avoids time loss, errors and various losses associated with human operation.

An inventory control system particularly adapted for a drycleaning store has many needs in common with the usual merchandising distribution warehouse system. Furthermore, the relatively low cost of individual transactions and cleaning operations aggravates the need to cut costs. In general, the possible revenue to be gained by processing a single article is quite small in comparison to the possible dissatisfaction which could be generated with consumers by even small percentage losses of articles and the like.

The usefulness of automated apparatus for information and process control has further benefits. Most efficient operation of a drycleaning store may require that the articles be optimally divided into batches of similar attributes which may be processed as units. For example, all articles of a given type of fabric may be best processed under certain conditions of cleaning fluid type, temperature, and the like. The operator (or his supplier) can clean the largest number of articles at the least expense by most efficiently allocating his machines and materials to reflect the particular mix of supplies being presented by the customer.

Various systems of lot accumulation, inventory reporting and other such inventory control and operation systems are known in the art. Automated systems in which digital computers are employed for counting purposes are known in connection with laundry systems. An example of such a system is shown in *Wesner U.S. Pat. No. 3,876,075*. In that device, customer identification and sorted article counts are processed by computer in order to assist in the allocation of lots to machines. The *Wesner* patent is primarily concerned with counting the articles.

In more general inventory control systems, further sophistication is known. In *Block, et al., U.S. Pat. No. 3,478,316* inventory control in connection with a laundry or retail establishment is assisted by use of automatically-scannable tags attached to articles of clothing.

The tags are scanned upon delivery of articles, whereupon the inventory count is adjusted. *Block, et al.*, teach the usefulness of automation in laundry systems to assist in detecting dishonest clerks.

In connection with laundry systems, it has been common practice to apply a unique tag to a unit of laundry. The tag may have an alpha numeric (person-readable) indication and be merely stapled to a hem of an article of clothing. A different or more complicated indicia may also be attached to a hanger or the like, upon which the article of clothing is suspended. In any event, some form of code is needed for each article. The aforementioned patent to *Block, et al.*, appears to involve magnetically-readable indicia.

In *Glass U.S. Pat. No. 4,340,810* optically-readable indicia and alpha numeric indicia are combined in a single tag or unit for a general warehouse inventory control system. Automatic optical scanning equipment can be employed to form at least a part of the data input apparatus and, persons can verify the accuracy of processing by reviewing the alpha numeric data. Similarly, machine-readable information can be placed on the same tag with information to be read during manual distribution, for example, by the ultimate delivery person or the like. Such warehouse control systems are used to assign and operate upon article identifiers such as delivery route, day, stop, man and article number.

As disclosed in the patent to *Glass*, a number of printing and optical detection systems have been developed. Some systems have been developed for automatic recognition of alpha numeric characters, but it has been found that the most dependable of automatic scanning devices are not systems which rely on conventional alpha numeric characters. Instead, the least error prone and fastest automatic scanners rely upon codes generated from a coded sequence of parallel bars ("bar codes"). The bar codes are not easily decoded by humans.

The present invention is adapted to most efficiently apply a minimum of manual data input to an inventory control system especially adapted to a retail (i.e., customer-interfacing) drycleaning operation. A minimum of data is manually entered by an attendant via a keyboard having a series of keys which are uniquely intended to encode information which is peculiar to laundry operations, using a prescribed sequence and a minimum of keystrokes. The necessary data for reconciling the intake of articles and cash against inventory is provided using a particular input protocol. Article identification, customer identification, and descriptions needed for generation of cost and pricing reports are entered, and the articles to be cleaned are associated with a unique bar code indicia for later automatic or semi-automatic optical scanning and data input, whereby the progress of articles through the laundry and drycleaning system can be completely monitored.

Positive cross reference of bar codes and articles upon entry into the system, under machine control, provides optimum capability of reconciling articles, cash and inventory.

The use of written indicia bearing an automatically-scannable bar code has been known in the art, and in connection with laundries. Companies producing business forms are currently supplying forms provided with a pre-printed bar code which may be optically scanned. These supplied multiple part forms, for example a three-part receipt form having carbon paper or other multi-

part impression material, are sold in sequentially-numbered supplies with a pre-printed bar code such that one or more of the forms may be associated with the laundry for later scanning.

Parts of multiple-part forms, for example, those saved for hard copies for the laundry management and the copy given to the customer as a receipt, need not be provided with bar codes. In order to identify a single customer or transaction with a single bar code, however, all the articles which that customer presents at the laundry must be somehow associated together, using an automatically optically scannable code to facilitate automatic reconciliation.

Inasmuch as the known pre-printed bar-coded forms are supplied rather than produced internally, the bar code itself must be read into the system, or a sequence number entered manually. The use of pre-printed bar code indicia can become somewhat expensive, in cost of pre-printed forms as well as time spent in using them.

Many product labels bear bar codes for product identification, which codes are predetermined for the product, and do not change from label to label. Production of unique codes for each successive label is much more difficult. A custom pre-printed bar coded form may appear to be a simple printed indicia, but the bar code is unique. While the forms may be simply printed except for the bar code, the bar code must be printed by a sophisticated automatically-advancing type printing press, generating unique bar codes. Therefore, unique printed bar codes are expensive.

In a situation in which a certain number of bar coded form parts are required, for example, one each for management, the customer and a batch container for a customer's laundry articles, the cost of pre-printed bar code labels increases. The increase may be less than proportional, but even given the relatively smaller cost per bar code of pre-printing a label having a number of bar code repetitions, the present invention reduces the cost of such pre-printed indicia even further, and allows use of a variable number of bar code repetitions. One of the greatest savings of the invention is not the cost of the indicia but the fact that the indicia cannot be lost. The automatic production of labels at the point of sale precludes the possibility that even the most automatic of inventory control systems will be defeated by unaccountable loss of pre-printed labels.

The present invention concerns a way of printing a set of bar code labels coincidentally with the individual transaction. Accordingly, there is no possible loss of labels, and therefore a much smaller possibility that unrecorded and unaccountable transactions can be performed by an attendant. The throughput and the inventory can always be reconciled with the cash. The system is programmed such that data is entered for a given unique transaction, and a unique code is produced concurrently. Only a preferred terminal can void a transaction or otherwise disregard a unique identifying code. Therefore, the possibility of pilferage is minimized.

The system of the invention uses a dot matrix printer to generate bar codes. The processor controls the code produced and the reconciliation thereof. High-quality bar codes are preferably generated in a high resolution mode of printing using the dot matrix printer. Inasmuch as preparation of truly high resolution bar codes may require several seconds using even a relatively high-speed dot matrix printer, according to the system of the invention, printing of bar codes for a transaction commences on the first keystroke, whereby the unique indi-

cia and the articles become closely associated. The indicia may also be printed following the completion of a preceding transaction.

According to the invention, the optical scanning dependability of a bar code system is achieved in the same system which avoids the usual expense of multiple repetitions of such bar code tags. Moreover, the system and its operators are made truly accountable for each transaction and the indicia thereof. The added advantages do not impede the system. Data entry, article marking, optical detection of bar codes associated with articles, reconciliation capabilities, and all the benefits of fully automated inventory control and report generation are realized.

SUMMARY OF THE INVENTION

It is an object of the invention to specifically adapt an automated inventory control system to the particular needs of a retail drycleaning establishment.

It is also an object of the invention to employ automatically scanned bar code labels in a drycleaning establishment, the bar code labels being produced only under machine control and only upon need thereof.

It is another object of the invention to maximize accountability and automated control of inventory and management reporting capability, while minimizing the expense of supporting the system.

It is yet another object of the invention to facilitate data entry, inventory control and reporting by providing the greatest capability at the least cost.

These and other objects are accomplished by an inventory control and reporting system for drycleaners which includes a data input keyboard having key blocks corresponding to certain information needed for identification and calculation of processing costs of articles, a data processor adapted to calculate pricing information and to generate reports based upon such data input, the processor being connected to a printer for producing multiple part bar code records and tags to be associated with the laundry articles, and also as hard copies for the customer and for the establishment. The bar code portions of the records are generated by a dot matrix printer operating in a high resolution mode, the bar code portions being generated for a successive transaction immediately upon completion of a preceding transaction. The bar code tags may be attached to articles of clothing and/or batches thereof, for use with scanning apparatus to facilitate generation of reports according to various management needs.

BRIEF DESCRIPTION OF THE DRAWINGS

There are shown in the drawings the embodiment which are presently preferred. It should be understood, however, that the invention is not limited to the precise arrangements and instrumentalities shown in the drawings, wherein:

FIG. 1 is a schematic elevation view of a customer data entry station according to the invention.

FIG. 2 is an illustration of a sequential custom-printed, bar-coded tag and receipt set according to the invention.

FIG. 3 is an elevation view of the blocked customer keyboard of the invention.

FIG. 4 is a schematic plan view showing steps in a typical drycleaning operation according to the invention.

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS

The inventory control system of the invention requires the input of information together with the input of items to be placed in inventory, the information and the items to be uniquely positively associated with one another throughout processing. Every transaction is recorded, including identification of the articles placed in inventory. The more complete the information input and associated with each article, the better the possible reporting power of the system.

The present system is applicable to a range of embodiments of varying complexity. The best inventory control and management information reporting systems has the ability to determine and report the current location of any given article in inventory. The system should also be able to reconcile the inventory against the cash on hand, or as having finished processing through a certain area of the plant. According to the present invention, initial data input is minimized, and later logging of inventory articles, for example, passing stations within the system, or passing out of the system, is accomplished by means of an automatic optical scanner.

The optical scanning reads unique bar codes associated with articles or batches thereof. It is possible to have a full supply of sequentially numbered bar code tags available for use, but such a system cannot be fully reconciled due to the unaccountable loss of any of the pre-prepared tags. A lost tag, without any means of determining how the tag was lost, whether the tag had represented a transaction, or who was responsible, presents the possibility of proceeds diverted or articles lost. In connection with laundry and drycleaning establishments, in which relatively unskilled personnel having little commitment to the business are employed as attendants, it has been an occasional problem that attendant personnel will service a customer's requirements and pocket the proceeds. The customer may receive his cleaning without complaint, and all paperwork being unaccountably lost, it is difficult or impossible to locate the loss of profits or to meaningfully deter such activities.

Cost saving opportunities upon full data entry may be found at virtually all stages of processing throughout the business to be monitored by the data processing system. Given the relevant data, management information can be developed in the form of statistics about various sub-operations within the overall system. These statistics reveal opportunities for cost-savings or improvements in efficiency. For example, with minimal input and attention to the processing and location of specific articles, it may be possible to determine whether cyclical variations in throughput can be balanced to enable operation with less equipment or personnel. It may also be possible to determine whether a problem which appears to occur randomly in the inventory (e.g., damage to garments) can be uniquely associated with a certain piece of equipment or the like, which piece of equipment may need repair. There are only a few of many possible gains from full data input and reporting. The present system facilitates both accountability and ease of data input, and uses hardware capable of sophisticated reports as well.

By generating the unique indicia associated with transactions, the invention removes the control step of associating a sequentially-numbered ticket with a trans-

action. The possibility of phantom transactions in which the attendant processes articles without tickets, or uses a ticket without entering data, is precluded. Accordingly, article identification, accumulating lost for processing, and the general ability to reconcile system operations, are improved and made dependable.

In FIG. 1, incoming articles to be placed in inventory are accumulated over a counter 20, having one or more data input and display terminals 30. Written records 40 are produced, and may be attached to garments 50 as they move through the processing system. At a plurality of locations throughout the system, optical scanning devices automatically, or semi-automatically read codes placed on the written records attached to laundry articles in the area, whereby reports of desired complexity may be generated.

When a customer brings incoming laundry to counter 20, an attendant enters identifying information on terminal 30 by means of keyboard 32. The keyboard is designed more fully hereinafter. At least information as to the customer's identity is required, together with information as to the type of articles being deposited and the particular operations, such as drycleaning, to be performed on the articles. This information is manually entered on a data input device especially adapted for drycleaning operations, and is stored in the system memory.

A data processing device such as a digital computer processes and stores the data entered by keystrokes at keyboard 32, and displays information as required on CRT terminal 34. The processor is programmed to associate sequential customers and/or transactions with a unique indicia, generally a number, whereby the customer and/or transaction number can later be used to call up information associated with it. This information is used to generate management information reports, or at the least to accumulate and report transactions and/or totals such as the proceeds collected by the attendant.

The data processor may be located under the counter, or otherwise conveniently located throughout the establishment and connected to the remaining system elements by means of any convenient data link. In close physical proximity to the attendant's station is a printer 42, for generating a hard copy 40. The printer is operable under control of the data processing device to generate written records reflecting the stored records entered on the input device and associated with particular customers and transactions. The written records have several uses, including providing a receipt for the customer, providing a hard copy for use by management and providing a mark for attachment to individual articles in inventory, or for a group of articles in inventory. In this manner, the articles can be associated with the customers and with the transactions as well.

The written record includes a plurality of optically detectable bar codes, each having a series of contrasting spaced bands in different widths, which bands may be decoded as a unique indicia. The bar codes are themselves printed directly by the printer, rather than being provided as an element in a supply of pre-printed forms. The bar code records are printed sequentially as sequential customer transactions occur. Therefore, forms cannot be unaccountably lost. The transaction is necessarily entered. The processing system is adapted such that transactions cannot proceed until dispositive action is taken with each customer and with the written record generated by the system.

Coincident printing of bar codes on the written records with the appearance of each customer and transaction, as required by the invention, presents certain time constraints to operation of the system. If a customer has a simple transaction such as a single article to be cleaned in a standard way, the time during which the customer is serviced may approach the time required to produce a bar code record of sufficient resolution to be dependably read by conventional optical readers. In any event, the customer need not be required to wait until a preceding customer's paperwork is completed before his transaction can be processed.

According to the invention, a printer capable of dot matrix printing in two modes is used. The printer is adapted for alpha numeric printing at high speed and relatively low resolution in one mode, and also adapted for printing in a "graphics" mode at much lower speeds but higher resolution. Of course, the difference in modes can be a matter of processor "mode" as well. An example of a dual mode printer is identified as model 82A Microline 82A produced by the Obitata Company of Mount Laurel, N.J.

Operating the printer in the high resolution graphics mode, the system according to the invention is adapted to commence printing all the high resolution bar code characters required for a transaction immediately upon the first keystroke thereof. Alternatively, the code can be printed at the conclusion of a preceding transaction. By this method, time spent before or during customer contact is used to prepare the necessary bar graphed code tags. The customer never perceives any great delay, and high resolution bar code characters are generated without resort to expensive (and often unacceptable) bar coded stationary supplies.

Unlike the conventional laundry operating system in which pre-printed alpha numeric character labels (i.e., using Arabic numerals and letters) are attached to articles or containers for articles in inventory, according to the invention custom-printed bar code labels are used. Automatic scanning devices can be used to directly read the bar codes from items in inventory. An example of a preferred transaction label is shown in FIG. 2. With reference to FIG. 2, a multi-part form 40 preferably comprises a customer's ticket copy 44, an establishment ticket copy 46, including a bar code and a plurality of article tags 48, each article tag including both a bar code and a person-discernable alpha numeric character.

The layout of a hypothetical retail drycleaners is shown in FIG. 4. It will be appreciated that a variety of possible business structures and physical layouts will benefit from the system of the invention. For purposes of discussion, an establishment is shown having a customer service counter 20, separated from the article-processing area by wall 60. A track 62 stores and transports packages of articles, and may define a closed circuit. Article presorting stations 64, cleaning apparatus 66 and assembly stations 68 are sequentially passed by articles processed.

In many drycleaning businesses, the customer service areas are remote from the article processing areas, the service areas being only for collection and delivery of articles. The invention is applicable in either local or remote processing systems.

The system relies upon the bar code indicia 80, attached to or associated with articles or batches, and "read" using optical detector devices 70. Detectors 70 are located at various points in the system, including at least the customer service stations. The attendant need

only scan the tags 48 bearing bar codes 80 to dependably and quickly log an article or batch through a station. The tags 48 and bar codes 80 are originally generated together with the customer ticket 44 and established hand copy ticket 46, upon receiving the article from the customer.

The alpha numeric tags 48 are detached from form 40, printed on the spot, and attached to drycleaning items 50, as shown in FIG. 1. Individual article tags 48 may be attached to items in inventory, as is known in connection with pre-printed alpha numeric labels. In addition, a copy of the customer's ticket, for example the establishment ticket copy 46, can be attached to the bag or batch bundle or other unitary package containing a plurality of individual articles. The machine control of bar code generation can be further used to handle batch coding of packages containing article from multiple customers and the like.

The association of a bar code and an article or group of articles is only one portion of the larger inventory control system. The garment tags and customer ticket associate a unique indicia with transactions, persons and physical items in inventory; however, an inventory control system may also require a great deal of additional information to be associated with the articles, in order to provide all the possible savings of costs and all the appropriate information and reports. The data entry keyboard 32 of the invention, as shown in FIG. 3, is specifically adapted for entering information relating to retail drycleaning establishments. The specific adaptations is based upon groupings of switch pads, each grouping relating to a specific and important piece of information.

Keyboard 32 is laid out such that the operator can progress from left to right (or top to bottom, etc.) making one or more selections from each of the grouped blocks of switch pads. The switches themselves may be pushbuttons, for example, of the type used for typewriters and the like, or alternatively, a switch membrane can be advantageously used. If desired, data entry can be prompted by back-lighting the next sequential block (or blocks) of switch pads, under processor control. According to the preferred layout, as shown in FIG. 3 the attendant progresses from left to right, entering in order: the type of laundry (at area 92); one or more words or names to be associated with the customer (a letter block 94); the type of transaction (block 96); the number (block 98) and type (block 100) of articles and descriptions (blocks 102) the colors and fabrics thereof and, the date of required completion (block 104). These pieces of information are used not only to record the transaction, but also to immediately calculate the price to be charged the customer, and also to feed forward information to assist in planning the scheduling or batching to be processed in various laundry handling machines.

The price to be charged can be calculated based upon a calculation using relative cost factors such as the fabric type, color and delivery requirements, or a complete look-up table of particular prices can be stored in the data processor's memory for consultation based upon a matrix defined by the particular switches operated.

The keyboard includes buttons for at least several of the most common choices in each category. Preferably the most common choices within any keyboard is such that the layout of choices within are the most accessible, for example the upper left. A miscellaneous key for choice which are not found may also be included. The miscel

laneous key calls up a menu for the attendant to select further choices via programmed data entry rather than by choice of key. For example, upon the attendant's entry of a "fancy dress" selection, a menu is output to the CRT for further identification, e.g., "wedding". In the event that no appropriate selection can be found, a default entry of text may be made via the letter section of the keyboard.

Having entered a complete series of selections corresponding to the customer, article and job description, the attendant signals completion by operating the "Enter" or "Total" keys, whereupon the data processing system summarizes, prints or otherwise makes use of the information, as required for example to calculate pricing. The summarized customer or transaction information is printed on the hard copy tablet, the system printing in a high-speed low resolution mode, instead of the high resolution mode adapted for printing bar codes.

It will be appreciated that the uses to be made of the information, and also the reports which can be generated by taking further information regarding the current locations of articles within the system, will vary as widely as the physical descriptions and desired of dry-cleaning establishments. An example of a typical establishment, for purposes of discussion, is illustrated in plan in FIG. 4. The establishment includes the counter at which customers are serviced, the counter having an article transportation mechanism 70 associated therewith. The customer service station is known in more detail in FIG. 1; however, the details are there given, and associated with articles which may be sorted, cleaned in batches, and re-sorted into individual customer packages in the same establishment. Alternatively, as is perhaps more common, the individual retail drycleaning establishments are merely collection points for articles to be actually processed at a larger establishment. Remote processing systems have an even greater need for inventory control and automatic scanning of article containers and the like. The various areas shown in FIG. 4 could be near or far apart. At some point before processing, the articles to be cleaned must be sorted into groups of articles which may be appropriately processed together. After processing the articles are unsorted back into single customer or transaction packages. Both upon sorting, upon unsorting, and at any point in the actual cleaning process, it may be necessary or desirable to determine what particular articles or number of articles are located at a particular processing point. In this respect, each unique number or code or other indicia associated with an article, or with a transaction, remains "alive" until processing of all the articles is completed, and delivered to the customer together. Therefore, the inventory can be reconciled at any point in the sequence.

Upon sorting or unsorting the batches, for example at sorting stations 74, optical scanning apparatus 76 inputs data to reconcile the inventory with the expected inventory. Any loss of articles or errors in entering data can be immediately reported, before the physical association of articles from a given customer is lost. Also at this time, any physical damage which is noticed by the sorter can be entered on the system, for example by prohibition, against the possibility that the establishment will be held responsible for articles which arrive damaged. A complete description of the damage may be entered using a more sophisticated station 74, for example including a blocked-switchpad (not shown) having a

plurality of possible descriptions of a sort similar to the customer terminal keyboard 32.

After processing, optical detection of bar codes is again useful to permit the reorganization of articles into customer packages. Further programming may also be used in order to assist in sorting, for example, upon optical detection of a bar code, the data processing system could be adapted to indicate which of a plurality of packages was to include that article. Similarly, reconciliation of a customer package contents can be promptly indicated. In any event, the automatic association of articles within a transaction is one possible form of management information report. Alternative reports may include reports relating to through-put, machine loads, operator efficiencies, and the like.

Optical scanners capable of discerning bar codes are available from various companies. A popular device employing such apparatus is known as a "wand". Although various such devices for hand-held operation are usable, examples are the "Laser Scanner" portable bar code scanning system marketed by MSI Data Corporation, and the "Datawand," also marketed by that corporation. These devices may be peripheral data input devices, or may include local storage for later downloading to the central processor.

The apparatus according to the invention is preferably outfitted with various additional hardware elements adapted to point-of-sale terminals and the like. Processor-interfaced cash drawers, CRT monitors and the like are all appropriate for the general system disclosed.

The possibilities for management information reporting according to the present system are substantial. Of course, the full capabilities need not be provided for all establishments, and if provided need not be consulted at all times. Should the user so desire, the basic capabilities of inventory input and output logging, together with price calculation can be used constantly. Full management information can be supported, with added data entry, only when need is perceived to isolate a problem or to attempt an improvement in overall efficiency.

The invention having been disclosed, a number of further variations will now be apparent to persons skilled in the art. Reference should be made to the appended claims rather than the foregoing specification as indicating the true scope of the subject invention.

What is claimed is:

1. The inventory control and reporting system, comprising:
 - a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions;
 - a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;
 - a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar

11

codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

2. The system of claim 1, wherein the written record comprises further indicia in addition to the bar codes, wherein the bar codes for a given transaction are automatically generated by the data processor and printer immediately upon commencement of an entry for the given transaction, and all unique sequential indicia generated are associated with sequential transactions, thereby preventing entry of unaccountable articles into inventory due to association of said unaccountable articles with spurious written records.

3. The system of claim 2, wherein the further indicia comprises alpha-numeric indicia also reflecting information, the information relating to the sequential transactions, for verifying system operations.

4. The system of claim 3, wherein the printer is adapted to print in a higher resolution mode for printing the bar codes upon said commencement, and in a higher speed mode, for printing the further indicia upon completion of said manual operation.

5. The system of claim 1, wherein the written record has multiple separable parts printed concurrently, including a customer ticket, an establishment ticket and a plurality of article tags, at least one of the tickets and tags having a bar code printed thereon, and each tag being detachable from the written record for direct association with at least one of the customer articles.

6. The system of claim 1, wherein the data input device is a keyboard and the printer is operable to generate tags for direct attachment to articles comprising usable material, the articles being pieces of drycleaning.

7. The system of claim 1 adapted for specific use in a retail drycleaning establishment, the articles being articles to be cleaned, and comprising additional optical scanners at a plurality of stations along a sequence of retail drycleaning operations including sorting, cleaning and delivery, the indicia and the descriptions of articles being reconcilable at each of said plurality stations for localizing said spurious additions and deletions.

8. The system of claim 1, further comprising a preferred input means connected to the data processor, the preferred input means and the data processor interacting for preparation of the reports.

9. The system of claim 8, wherein only the preferred input means is capable of voiding a transaction having a

12

unique sequential indicia associated therewith, and cancelling a written record thereof.

10. The system of claim 1, wherein the input device is a keyboard having alpha-numeric keys, and also having keys specific to a plurality of common attributes of the articles and common optional attributes of the sequential transactions, said common attributes being recorded using single key strokes.

11. The system of claim 10, adapted for use in a retail drycleaning operation, the articles being articles to be cleaned and the common attributes including articles types, colors, patterns, fabrics, special requirements and delivery requirements.

12. The system of claim 11, wherein a plurality of the keys correspond to attributes of the articles affecting the costs of processing thereof, the data processor being adapted to calculate pricing information based upon input from the keys.

13. The system of claim 12, wherein the input device further comprises keys specific to customer timing requirements affecting the cost of processing the articles, the data processor calculating costs based upon input from the keys.

14. An inventory control and reporting system, comprising:

a data input device having switch means for encoding information related to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity data and data relating to the transactions;

a data processor including memory operable for recording said information, means for generating an inventory report and means for associating sequential transactions with unique indicia sequentially assigned to the transactions and for generating at least one report of said transactions, the unique indicia and the data relating to the transactions being reconcilable against one another;

a printer operable under control of the data processor to generate a written record for each of the sequential transactions, the written record including optically-detectable bar codes printed only in substantial coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner for data communication with the data processor and operable to detect said bar codes on all articles passing a predetermined station.

15. The system of claim 14, adapted for specific use in a retail drycleaning establishment, the articles being articles to be cleaned, and comprising additional optical scanners at a plurality of stations along a sequence of retail drycleaning operations including sorting, cleaning and delivery, the indicia and the data relating to the articles being reconcilable at each of said plurality of stations for localizing spurious additions and deletions to and from inventory.

60

65

AMERICA'S FIRST CHOICE FOR INVENTORY CONTROL

DATAScan
FROM THE
MAKERS OF **DATAMARK**

DATAScan
INVENTORY CONTROL SYSTEM

INVENTORY LIST

ITEM NO.	DESCRIPTION	QTY.	UNIT PRICE	TOTAL
101	101-101-101	10	1.00	10.00
102	102-102-102	20	2.00	40.00
103	103-103-103	30	3.00	90.00
104	104-104-104	40	4.00	160.00
105	105-105-105	50	5.00	250.00
106	106-106-106	60	6.00	360.00
107	107-107-107	70	7.00	490.00
108	108-108-108	80	8.00	640.00
109	109-109-109	90	9.00	810.00
110	110-110-110	100	10.00	1000.00
TOTAL				3350.00

WESTVIEW INSTRUMENTS, INC.
INDUSTRIAL CONTROLS DIVISION • 6723 STELLA LINK • HOUSTON, TX 77005

PERGAD-Bayano, R. J.

PLAINTIFF'S
EXHIBIT

Operating your Laundry/Drycleaning business without a good cash management and inventory control system can be expensive. The International Fabricare Institute and other industry authorities estimate that the amount of money lost through inventory shrinkage can vary from 3% to 6% of your annual gross dollars. That can be quite a bit of money. Westview Instruments developed the DATASCAN® Portable Bar Code Reader as the complete answer to inventory control. When used with the Datamark® Lister, Datascan® provides the strongest cash control system available today.

HERE IS HOW THE DATASCAN® SYSTEM WORKS:

The Datamark® Lister prints an invoice number and a bar code on each laundry dryclean ticket processed. The Lister then stores in its computer memory the invoice number and the ticket cash total (up to 500 invoices). When this memory is full (or on a daily basis), all invoices are transferred to Datascan® memory, which can hold an incredible 8000 invoices. After a customer pays for his order, his paid invoice can then be removed from the Datascan® record by simply "wandering" the bar code on the paid invoice. Any invoices that are left in the Datascan® record are unpaid and, therefore, must be in inventory. After a physical inventory is taken, by simply "wandering" the bar codes on each invoice hanging on line, Datascan® will find all "extra" invoices and "missing" invoices, compute the inventory cash total, and provide a printed record.

INVOICES REPORTED

000130	6.90
000131	7.20
000132	4.50
000133	1.50
000134	20.44
000135	NO RECORD
000136	8.87
000137	3.87
000138	4.50
000139	NO RECORD
000140	NO RECORD
000141	NO RECORD
000142	NO RECORD
000143	NO RECORD
000144	NO RECORD
000145	NO RECORD
000146	NO RECORD
000147	NO RECORD
000148	NO RECORD
000149	NO RECORD
000150	NO RECORD
000151	NO RECORD
000152	NO RECORD
000153	NO RECORD
000154	NO RECORD
000155	NO RECORD
000156	NO RECORD
000157	NO RECORD
000158	NO RECORD
000159	NO RECORD
000160	NO RECORD
000161	NO RECORD
000162	NO RECORD
000163	NO RECORD
000164	NO RECORD
000165	NO RECORD
000166	NO RECORD
000167	NO RECORD
000168	NO RECORD
000169	NO RECORD
000170	NO RECORD
000171	NO RECORD
000172	NO RECORD
000173	NO RECORD
000174	NO RECORD
000175	NO RECORD
000176	NO RECORD
000177	NO RECORD
000178	NO RECORD
000179	NO RECORD
000180	NO RECORD
000181	NO RECORD
000182	NO RECORD
000183	NO RECORD
000184	NO RECORD
000185	NO RECORD
000186	NO RECORD
000187	NO RECORD
000188	NO RECORD
000189	NO RECORD
000190	NO RECORD
000191	NO RECORD
000192	NO RECORD
000193	NO RECORD
000194	NO RECORD
000195	NO RECORD
000196	NO RECORD
000197	NO RECORD
000198	NO RECORD
000199	NO RECORD
000200	NO RECORD
TOTAL	189.87

INVOICE LISTING

000130	3.50
000131	3.50
000132	3.50
000133	3.50
000134	3.50
000135	3.50
000136	3.50
000137	3.50
000138	3.50
000139	3.50
000140	3.50
000141	3.50
000142	3.50
000143	3.50
000144	3.50
000145	3.50
000146	3.50
000147	3.50
000148	3.50
000149	3.50
000150	3.50
000151	3.50
000152	3.50
000153	3.50
000154	3.50
000155	3.50
000156	3.50
000157	3.50
000158	3.50
000159	3.50
000160	3.50
000161	3.50
000162	3.50
000163	3.50
000164	3.50
000165	3.50
000166	3.50
000167	3.50
000168	3.50
000169	3.50
000170	3.50
000171	3.50
000172	3.50
000173	3.50
000174	3.50
000175	3.50
000176	3.50
000177	3.50
000178	3.50
000179	3.50
000180	3.50
000181	3.50
000182	3.50
000183	3.50
000184	3.50
000185	3.50
000186	3.50
000187	3.50
000188	3.50
000189	3.50
000190	3.50
000191	3.50
000192	3.50
000193	3.50
000194	3.50
000195	3.50
000196	3.50
000197	3.50
000198	3.50
000199	3.50
000200	3.50
TOTAL	189.87

LISTED INVOICES

000130	3.50
000131	3.50
000132	3.50
000133	3.50
000134	3.50
000135	3.50
000136	3.50
000137	3.50
000138	3.50
000139	3.50
000140	3.50
000141	3.50
000142	3.50
000143	3.50
000144	3.50
000145	3.50
000146	3.50
000147	3.50
000148	3.50
000149	3.50
000150	3.50
000151	3.50
000152	3.50
000153	3.50
000154	3.50
000155	3.50
000156	3.50
000157	3.50
000158	3.50
000159	3.50
000160	3.50
000161	3.50
000162	3.50
000163	3.50
000164	3.50
000165	3.50
000166	3.50
000167	3.50
000168	3.50
000169	3.50
000170	3.50
000171	3.50
000172	3.50
000173	3.50
000174	3.50
000175	3.50
000176	3.50
000177	3.50
000178	3.50
000179	3.50
000180	3.50
000181	3.50
000182	3.50
000183	3.50
000184	3.50
000185	3.50
000186	3.50
000187	3.50
000188	3.50
000189	3.50
000190	3.50
000191	3.50
000192	3.50
000193	3.50
000194	3.50
000195	3.50
000196	3.50
000197	3.50
000198	3.50
000199	3.50
000200	3.50
TOTAL	189.87

THE DATASCAN® SYSTEM STREAMLINES YOUR BUSINESS.

- Tracks 8000 invoices from up to 10 Datamark® Listers
- Speeds-up and simplifies the process of taking a physical inventory
- Identifies old or "dead" stock in inventory
- Provides a printed record of all paid invoices
- Gives complete cash control using just a simple cash register

The Datascan® Reader is fully portable: you charge its batteries with an AC adapter. It can be held in one hand or carried on its belt clip. Datascan® also has an easy-to-read 32-character display and a stainless-steel bar code wand. It is simple and very easy to use. And best of all, behind every Westview Instruments product stands our reputation for quality and customer satisfaction.

WV

WESTVIEW INSTRUMENTS, INC.

INDUSTRIAL CONTROLS DIVISION

6723 STELLA LANE

HOUSTON, TEXAS 77005

(713) 666-2326

Stop Upcharge Losses

\$3.95? LAST TIME YOU CLEANED THESE
SILK PANTS I PAID \$2.95.



Eliminate your losses by letting **DATA~~MARK~~ XI** print your invoices neatly, legibly, and precisely. With over 65,000 automatic pricing combinations, **DATA~~MARK~~** gives you all the upcharges you deserve without the math errors. More importantly, you give your customers the consistent pricing they demand without the hand-written scribble.

DATA~~MARK~~ automatically:

- Records all incoming orders
- Tracks all unpaid orders
- Balances to the cash drawer and,
- Lists every missing invoice.

THAT'S CASH CONTROL!

When pricing is done by hand, who is in charge of the price — you or your employee? Considering what you're losing, **DATA~~MARK~~** might just be less expensive than your next box of ball point pens.

CALL US TODAY . . . (713) 668-2326



With over 14 million hours of operation,
DATA~~MARK~~ 3 set the standard. Now . . .
DATA~~MARK~~ XI sets the pace.

DATA~~MARK~~

America's First Choice

WIZ

WESTVIEW INSTRUMENTS, INC.

INDUSTRIAL CONTROLS DIVISION

6723 STELLA LINK

HOUSTON, TEXAS 77005-4391

(713) 668-2326

PLAINTIFF'S
EXHIBIT

9

DATA MARK

AMERICA'S FIRST CHOICE

THE MOST POPULAR PRICING MACHINE IN THE INDUSTRY ... FOR SOME VERY POWERFUL REASONS.

Automatically prices, multiplies,
discounts, taxes, and totals ...
accurately

Complete cash and inventory
reports; production print-outs
by garment and department

High-speed, double-dot printing
for neat, legible tickets

Communications link to
computer or
DATA-SCAN
bar code reader

Saves and recalls
over 6500 invoices
in inventory

Rugged ... designed to withstand
the heat, lint, and chemical vapors
found in every plant.
No hard disks, disk drives, or diskettes

Preset pricing with multiple upcharges ...
Over 65,000 pricing combinations
assures correct upcharging for all garments.

100% Programmable keys for up to
84 descriptors
2-Level keyboard design doubles the
upcharge possibilities

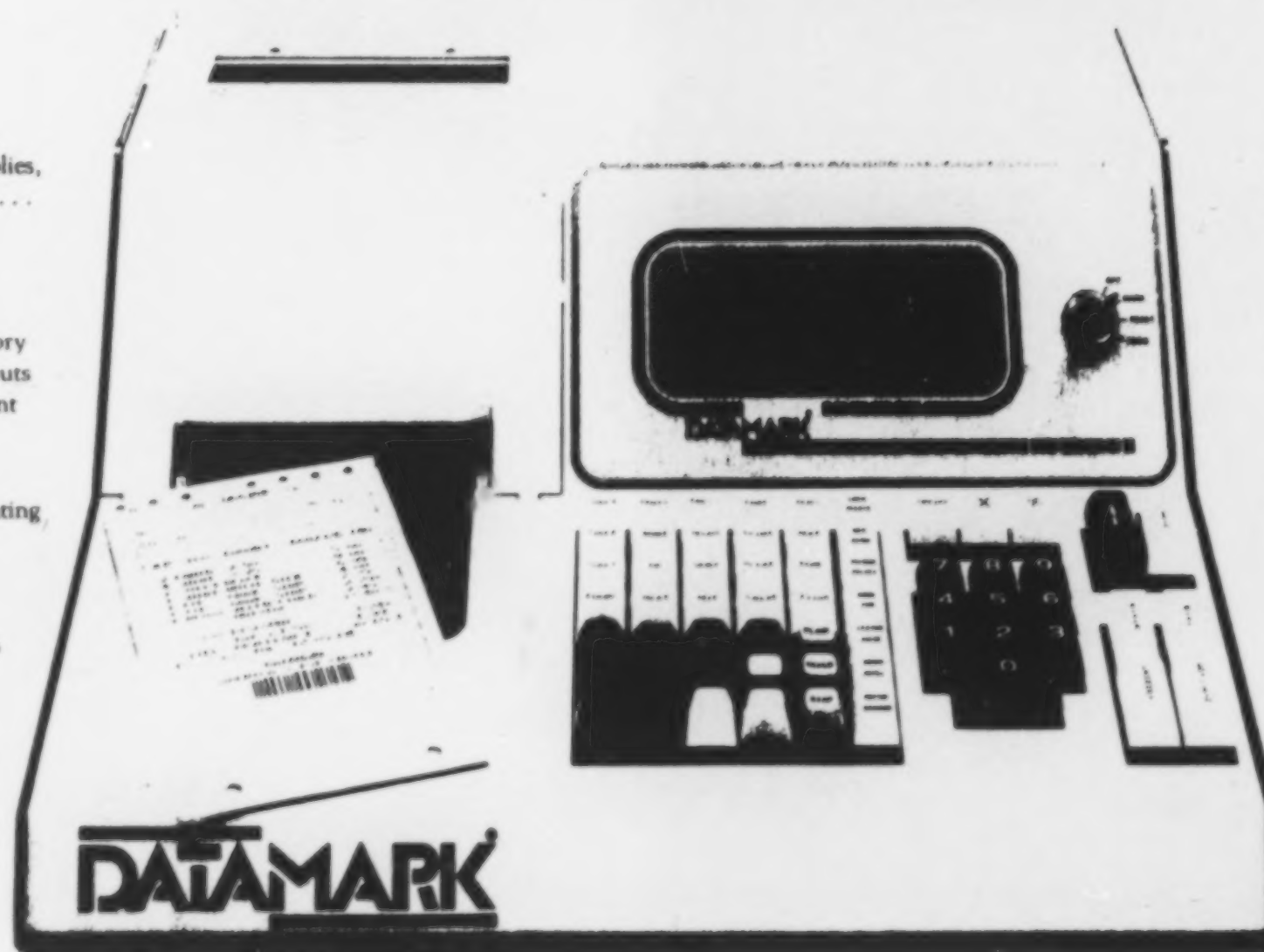
Simple and reliable, fast and
accurate ... as easy to use
as a calculator

Time clock and automatic
date advance

% Discount/coupon key
for special pricing

4 Department totals,
tracking up to
36 stores, operators,
or routes

Full-travel keyboard
featuring gold
crossbar contacts



WIZ WESTVIEW INSTRUMENTS, INC.
Industrial Controls Division (713) 668-2326

DATA-MARK

AMERICA'S FIRST CHOICE

DATA-SCAN

EQUIPMENT PRICE LIST

DATAMARK® XI 3,295.00

These are only some of the features that make Datamark America's #1 selling listing machine:

- **Simple and reliable, fast and accurate** ... as easy to use as a calculator
- **Eliminates costly mistakes** made while marking in and adding up tickets
- **Automatically prices, multiplies, discounts, taxes, and totals** ... accurately
- Provides neat, legible tickets with **consistent pricing** for you and your customers
- 100% programmable item keys for up to **84 descriptors** • **2-level keyboard** doubles the upcharge possibilities
- **3 preset pricing levels** (with manual override) and **multiple upcharges** for each garment
- **Over 65,000 pricing combinations** assures correct upcharging for all garments
- **Complete ticket review** for up to 15 garment lines
- **Multiply/void key** and variable % discount/coupon key (under owner control)
- **4 programmable department keys**, tracking up to 36 stores, operators, or routes
 - Automatically advances the date, day, and time
- **Automatically increments** the invoice number
 - Automatically advances the date, day, and time
- Prints the ticket piece count and the operator, store, and marking tag number and color
 - Simple interface to the **Datascan® Bar Code Reader**
- Provides basic and necessary cash management for a laundry/drycleaning operation
- **Forces every sale through the cash register**
 - Saves and recalls **over 6500 invoices**
- **Complete invoice listings** and cash reports, including **non-clearing and closing readings** by department and route
- **Production reports by department**, including **average price/garment**, **average discount**, and **average ticket sale**
- **Rugged** ... designed to withstand the heat, lint, and chemicals found in every plant
- No hard disks, no disk drives, no diskettes, and no cooling fans
 - Fast, bi-directional printing and **bold, high-quality print**
- **Full-travel keyboard** featuring gold crossbar contacts
 - 5 year battery backup memory protection
- Self-diagnostics and self-testing
- **Full one year manufacturer's warranty**

DATAMARK® PLUS 3,995.00

- Includes all **DATAMARK XI** features
 - Saves and recalls **over 3000 invoices**
- **Invoice search** by date, invoice number, customer number, or department
- Communicates with a personal computer (either locally or through a **standard telephone line**)

DATAMARK® CONNECTION Software 495.00

- Contains all the personal computer software necessary to communicate with your **Datamark Lister**
- Allows all **Datamark** management and inventory data to be transferred directly to your home or office
- Allows remote pricing/upcharge changes and inventory adjustments
- Handles up to 100 **Datamark** Lists

DATASCAN® Bar Code Reader 1,995.00

- Tracks 8,000 invoices from up to 4 **DATAMARK XI** or **DATAMARK PLUS** Lists
 - Identifies "extra" invoices and "missing" invoices
- Speeds up the process of taking a physical inventory
 - Stainless-steel bar code wand
- Includes a 40-column printer and connecting cables
 - Can be held in one hand
- 32-character alphanumeric display
 - 2-tier battery backup memory protection
- Fully portable with belt clip
- Convenient AC adapter for recharging long-life batteries
- **Full one year manufacturer's warranty**

ALL PRICES F.O.B. HOUSTON AND SUBJECT TO CHANGE WITHOUT NOTICE

WIZ

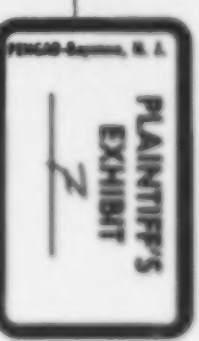
WESTVIEW INSTRUMENTS, INC.

Industrial Controls Division

6723 Stella Link

Houston, TX 77005-4397

(713) 869-2326



(713) 668-2326

EQUIPMENT PRICE LIST

DATA-MARK® SYSTEM 12495.00

- Provides the basics for managing cash in a laundry/drycleaning operation
- Eliminates costly mistakes made marking-in and adding-up tickets
- Automatic printing of invoice, operator and store numbers
- Offers greater upcharge and pricing revenues
- 3 Preset Pricing Levels with Manual Override
- 20 Item Keys, 12 Color Keys, 4 Pattern Keys
- Non-Clearing and Closing Cash Readings with 2 Group Cash Totals
- Easily expandable to any other DATA-MARK® System
- Bold, High-Quality Print
- 20-Character Alphanumeric Display
- Message Printing
- Complete Preset Price Print-Out
- Easy to operate, simple to program
- Self-Diagnostics and Self-Testing
- Fast, Bi-Directional Printing
- Modular Full-Travel Keyboard
- Complete Ticket Review
- 8 Garment Print Lines
- Machine Prompting
- Memory Protection

DATA-MARK® SYSTEM 22995.00

- Includes all System 1 Features
- Non-Clearing and Closing Cash Readings with 10 Group Cash Totals
- Central Marking Capability for up to 10 Stores (or Routes)
- Accumulative and Resettable Production Report for all Items
- Complete Daily Invoice Listings for up to 500 Tickets
- 20 Programmable Item Keys, 12 Color Keys, 4 Pattern Keys
- 2 Programmable Total Keys
- Multiply Key, % Discount Key
- Easily Expandable
- 12 Garment Print Lines
- Piece Count

DATA-MARK® SYSTEM 33295.00

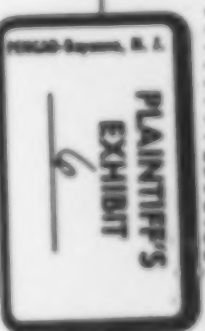
- Includes all Systems 1 and 2 Features
- Production Report, including Average Price/Item, Average Discount, Average Ticket Amount, and Percent of Sales by Item
- % Discount and Dollar Discount (Under Owner Control)
- Automatic Tax Calculation and Printing
- Complete 8000 Invoice Tracking (with Optional Datascan Bar Code Reader)
- Full RS-232C Interface
- Void Key
- Automatic Bar Code Printing

DATASCAN® BAR CODE READER1995.00

- Tracks 8000 Invoices from up to 10 DATA-MARK® System 3 Listers
- Speeds-up the process of taking a Physical Inventory
- Identifies "Extra" Invoices and "Missing" Invoices
- Includes 40-Column Printer and Connecting Cables
- Fully Portable with Belt Clip
- Uses AC Adapter
- 32-Character Alphanumeric Display
- Can be held in one hand
- Memory Protection
- Stainless-Steel Bar Code Wand

DATA-MARK® SYSTEM 3 and DATASCAN® READER PACKAGE4995.00

ALL PRICES F.O.B. HOUSTON AND SUBJECT TO CHANGE WITHOUT NOTICE 7/1/85





UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ADDRESS COMMISSION OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER FILING DATE PUBLICATION FIRST NAMED APPLICANT ATTORNEY DOCKET NO.
06599, V40 0-1/13/84 PHILIPSON 11 1-14-84

STEELE, CONLID & FRIED
3232 IVE LDC.
1700 MARKET ST.
PHILADELPHIA, PA 19103

EXAMINER	
TECHNICAL	PAPER NUMBER
237	3

DATE MAILED:

0-3/23/84

You are recommended to pay the balance in charge of your application
COMMISSION OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Response to communication filed on _____ ☐ This action is made final.
A shortened statutory period for response to this action is set by statute 3 months, _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-891. 2. ☐ Notice to Patent Drawing, PTO-904.
3. ☐ Notice of Action Cited by Applicant, PTO-100 4. ☐ Notice of Informal Patent Application, Form PTO-151
5. ☐ Information on How to Effect Drawing Changes, PTO-1416 6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-14 _____ are pending in the application.
Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been examined.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-14 _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirements.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as appropriate subject matter is submitted.

8. ☐ Alternative subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substituted drawings have been received on _____. These drawings are ☐ accepted.
☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed addition or substitution thereto of drawings, filed on _____, has (have) been ☐ approved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ Disapproved (see explanation). However, the Patent and Trademark Office may require further drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached form "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1416.

12. ☐ Acknowledgment is made of the claim the priority under 35 U.S.C. 119. The verified copy has ☐ been received ☐ has been received

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under 35 USC 227c, 1995 C.D. 11, 431 O.G. 212.

14. ☐ Other _____

PTO-133a (Rev. 7-83)

EXAMINER'S ACTION

001655

599,948
233

-2-

1. File PTO 1449 with copies of prior art discussed on pages 2 and 3 of specification.
2. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103 as being unpatentable over Stewart taken with the prior art discussed on pages 2 and 3 of specification.

Stewart, in column 4, line 57 and in column 6 discusses a dot matrix printer for the bar code (column 2, line 41) and selection of any desired information for the label. It would be obvious to employ these concepts with the prior art inventory systems.

4. Any inquiry concerning this communication should be directed to Examiner Harold Pitts at telephone number 703-

310

557-9626.

Pitts/karen

8/9/84

/s/
HAROLD L. PITTS
EXAMINER

311

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE

In re: Application of HERBERT MARKMAN

Serial No.: 599,948 Examiner:

Filed: April 13, 1984 Group Art Unit:

For: INVENTORY CONTROL AND REPORTING
SYSTEM FOR DRYCLEANING STORES

AMENDMENT

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Responsive to the Official Action mailed August 23,
1984, the period for response being extended concurrently
herewith, please amend the above-identified patent
application as follows:

[CERTIFICATION EXECUTED BY
STEPHAN P. GRIBOK, ESQ.]

IN THE CLAIMS

1 (amended). An inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said [a plurality of] articles associated with the transactions [a transaction];

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another; [and,]

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including [comprising a plurality of] optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to [directly associated with] said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

Cancel claim 2, without prejudice.

2.3 (amended). The system of claim 1 [2], wherein the written record comprises further indicia in addition to the bar codes, wherein the bar codes for a given transaction [and] are automatically generated by the data processor and printer immediately upon commencement of an entry for the given [a] transaction, and all unique sequential indicia generated are associated with sequential transactions, thereby preventing entry of unaccountable articles into inventory due to association of said unaccountable articles with spurious written records.

3.4 (amended). The system of claim 32, wherein the further indicia comprises alpha-numeric indicia also reflecting information, the information relating to the sequential transactions, for verifying system operations.

4.5 (amended). The system of claim 43, wherein the printer is adapted to print [operable] in a higher resolution mode[,] for printing the bar codes upon said commencement, and in a higher speed mode, for printing the further indicia upon completion of said manual operation.

REMARKS

The Amendment is submitted in response to the Official Action of August 23, 1984, wherein the Examiner rejected the claims under 35 USC 103 over U.S. Patent 4,264,396 - Stewart, in combination with the prior art discussed on pages 2 and 3 of the specification. Applicant hereby amends the claims to more particularly point out and distinctly claim the subject matter regarded as the invention, and to more clearly distinguish the invention over the cited disclosures. Every effort has been made to avoid the introduction of new matter. The number of claims is reduced, and no fee is required. The claims as amended are believed to be in condition for allowance and allowance is respectfully requested.

In support of the rejection under Section 103, the Examiner states:

Stewart, in column 4, line 57 and in column 6, discusses a dot matrix printer for the bar code (column 2, line 41) and selection of any desired information for the label. It would be obvious to employ these concepts with the prior art inventory systems.

Applicant interprets the Examiner's position as an assertion that a reasonably-routine combination of Stewart and the references cited on page 2 and 3 of the specification would reach the invention. Although applicant agrees that Stewart teaches a unit for printing of bar code indicia on labels concurrently with the use of the labels, Stewart's

disclosure taken in combination with all or any part of the references mentioned in the specification still fails to disclose or suggest the claimed invention to a person of ordinary skill in the art. The specification mentions Patent 3,876,075 - Wesner, 3,478,316 - Block et al and 4,340,810 - Glass. Wesner teaches a means of keeping a running inventory total, Block teaches use of scannable tags for laundry items and Glass teaches scannable tags for general warehouse use. Applicant's claimed invention involves more.

According to the claimed invention, the generation of concurrent, unique, transaction-identifying indicia in the form of optically-scannable bar codes is part of a specific system that is characterized by increased security over the usual invention system. Unlike the usual system in which apparatus generates non-unique indicia (e.g., Stewart's price indicia) and/or indicia that is not produced concurrently with the commencement of a transaction (e.g., pre-printed tags), applicant's system is operable to keep a running reconcilable inventory total by adding input articles and subtracting output articles, and also protects against the possibility of undocumented or spuriously-documented articles entering the system. Accordingly, the claimed system is particularly applicable to retail drycleaning establishments.

Applicant respectfully requests that the Examiner note that there are features present in applicant's independent claim 1 that relate not only to means for production of bar code indicia, but also to uniqueness of indicia and recited means operable to prevent indicia becoming available except upon commencement of a transaction. Means are also provided for reconciling the very same unique and

concurrently-generated indicia at later points during processing whereby the entry or exit of inventory articles in irregular ways can be localized.

In the prior art inventory system, totals are maintained but no effort or apparatus is devoted to detecting spurious transactions. As described in the specification, some basic difficulties with retail drycleaning establishments relate to the fact that attendants sometimes process undocumented articles through the system and pocket the proceeds. Another difficulty is that the loss, misplacement or separation in process of even a single article of even relatively-minor value will have a major impact on the customer's estimation of the quality of the establishment. These features distinguish drycleaning-type applications of inventory control from the usual warehouse application. In a warehouse application, retail sales application or the like, the problems are entirely different. In these situations, the objective is to keep a running total (for re-ordering, etc.) and to collect non-unique materials into a batch (for shipping and billing). Use of bar code indicia in these applications does not disclose or suggest to a person of ordinary skill that it would be advisable, or possible, or how any inventory or marking apparatus might be advantageously used in a laundry and drycleaning situation.

The Examiner cited Stewart in combination with the usual inventory control system, asserting that Stewart makes it obvious to print bar codes reflecting "any information". Applicant respectfully requests that this position be reconsidered in view of the claims as amended. Stewart fails to disclose or suggest a code printing system to concurrently

generate unique indicia for tracking a transaction. At column 2, lines 39-40, the Stewart label is printed with the name of the store as well as the article price. These indicia will be identical for all articles of the same type. Similarly, at column 5, lines 27-37, Stewart specifically teaches that the microprocessor is programmed for printing price information for automatic scanning.

There is no disclosure or suggestion in Stewart that there would be any benefit whatsoever to using concurrently-generated unique bar code indicia as a means of increasing the securing of transaction-identifying tags. Stewart ignores the entire concept of security and uniqueness of transactions or articles. In view of the benefits in security to be obtained according to the claimed invention, any general statements in Stewart about the information to be printed fail to disclose applicant's invention. Stewart's examples, and Stewart's disclosure, teach only printing of no-unique indicia such as price.

The claims as amended are not directed to a basic printer of bar code indicia per se, nor to devices for printing transaction-identifying indicia per se. Instead, as taught [sic] and claimed only by applicant, there is a specific benefit in the security of inventory control systems, and especially such systems characterized by a plurality of articles associated with unique transactions, that the system be operable with unique bar code indicia, generated only in coincidence with (e.g., upon commencement of) the transaction. In this manner, as fully described in the specification, it is not possible to take advantage of pre-printed bar code tags. The attendant cannot unaccountably

discard the tags (because they are uniquely associated with the sequential transactions), and cannot add or subtract any article from inventory without that article being reconcilable at at [sic] least one optical scanning station.

Other benefits also accrue. The concurrently-printed codes are substantially cheaper than multi-part pre-printed forms. The generation of identifying indicia upon commencement handles data entry and marking in a convenient and nearly-foolproof way.

Assuming arguendo that a person of ordinary skill in the art was to attempt a combination of the teachings of Stewart, Block et al and Wesner, he would combine the references consistently with their teachings. The skilled person might generate price labels for a transaction to be read upon delivery of the goods to the customer; keep a master record of the number of transactions in progress by adding and subtracting the input and output items respectfully as in Wesner and Block et al. These references, however, lack any disclosure or suggestion that the further features of a means for associating transactions with unique indicia that limits the production of indicia. Only applicant's equipment is operable to produce unique transaction-identifying indicia upon commencement of a transaction and not otherwise. Together with optical scanning means for later processing, applicant's device substantially increases the accuracy of inventory control by effectively eliminating the possibility of spurious transactions by misuse of unique indicia labels.

The claims as amended particularly point out and

distinctly claim the subject matter required to reach these benefits. In independent claim 1, the system is recited as not only including an input and printing device as in Stewart, but also totalizing, reporting and optical scanning means as well. Furthermore, claim 1 recites features relating to the uniqueness of the indicia produced by said means and the printing of the unique indicia only in coincidence with transactions. In claim 2, the printed bar codes are indeed dot-matrix bar codes, but unlike the teaching of the references, the bar codes produced represent unique sequential indicia. Claim 3 specifically recites the interaction of the data entry, totalizing and scanning elements that together with unique generation of indicia upon commencement of a transaction preclude unaccountable entry of articles into inventory as well as unaccountable exit.

Further refinements of the invention which are recited in the claims and are likewise missing in the references relate to the mixture of optically-scannable and alphanumeric indicia, generated at different print speeds, the multi-part nature of the printed media, the reconcilable nature of the system at any of various stations besides the initial receipt or ultimate delivery, and a unique keyboard data entry device that ties the package together. The subject matter in these claims as well as in independent claim 1 relate not only to general purpose inventory control or general purpose totalizing, but also the specific usefulness of concurrently-generated unique bar code indicia in a laundry and drycleaning establishment, together with the integration of such a system into the pricing, marking and actual article [sic], processing to improve the entire operation.

Every effort has been made to amend the claims to distinguish over the references cited by both the Examiner and by the applicant. The claims as amended are believed to patentably distinguish over the references whether taken along or in any combination of features that might reasonably be undertaken by a person of ordinary skill aware of the disclosures. The claims are believed to be in condition for allowance and prompt allowance is respectfully requested.

Respectfully submitted,

Date: 22 Feb 1985

/s/
 Stephan P. Gribok
 Reg. No. 29,643
 STEELE, GOULD & FRIED
 3232 IVB Building
 1700 Market Street
 Philadelphia, PA 19103
 (215) 563-8020

Docket: 1062-1

Reissue Litigation

IN THE UNITED STATES PATENT AND
 TRADEMARK OFFICE

In Re: Application of Herbert Markman

Serial No.:

Examiner:

Filed:

Group Art Unit:

For Reissue of Patent No.: 4,550,246

Issued: October 29, 1985

For: INVENTORY CONTROL AND REPORTING
 SYSTEM FOR DRYCLEANING STORES

REISSUE DECLARATION AND POWER OF
 ATTORNEY BY INVENTOR

Hon. Commissioner of Patents and Trademarks
 Washington, D.C. 20231

Sir:

As a below named inventor, I hereby declare that: My residence and post office address are 631 Fariston Drive, Wynnewood, PA 19096. I am a U.S. citizen. I believe I am the original, first and sole inventor of the subject matter which is described and claimed in Letters Patent No. 4,550,246 granted on October 29, 1985 and in the attached

specification and claims, and for which invention I solicit a reissue patent.

I have reviewed and understand the contents of the above-identified specification, including the claims.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 CFR 1.56(a).

No applications for patent or inventor's certificate have been filed by me or on my behalf at any time prior to the filing date of application SN 599,948 resulting in Letters Patent 4,550,246. An application for patent in Canada, SN 494,168 was filed on October 29, 1985.

I believe that original Patent No. 4,550,246 is partly invalid or inoperative because of error without any deceptive intent on my part, by virtue of my claiming less than I had a right to claim in the patent, and by virtue of an inadvertent failure to comply with the examiner's requirement for submission of copies of prior art which was otherwise identified in the specification, except for two references as noted below.

The following discussion of limitations in the claims as issued show that I claimed less than I had a right to claim. In each case, the unnecessary limitations were discovered during the initial stages of litigation instituted by Max Business Systems, Inc. ("Max"), plaintiff in Civil Action No. C87-927A filed on or about May 8, 1987 in the U.S. District Court for the Northern District of Georgia, for

declaratory judgment of non-infringement and invalidity of U.S. Pat. 4,550,246. Max asserts that an inventory control and reporting system believed by me to fall within the fair scope of my invention does not infringe the claims thereof.

The limitations which render the claims unnecessarily narrow over all known prior art, are:

1. Tracking of Individual Articles

It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing brought by a single consumer to a drycleaning establishment or the like. I believe that tracking of a transaction whether it involves one article or several is properly disclosed and allowable. The claim language recites entry of "descriptions of each of said articles associated with the transactions". This passage is more limited than I had a right to claim because, although individual articles, e.g. a pair of pants, could be accounted for by individual marking, scanning and reconciliation in reports, the grouping of such articles into sets for tracking (e.g., a suit comprising pants under jacket and/or a suit and a Dress or other spearable [sic] articles grouped together) is reasonably disclosed as forming part of the invention and is allowable over the prior art. Accordingly, I seek to correct the patent by inserting claims describing the information entered more broadly as --data relating to the transactions-- rather than "descriptions of each of said articles".

2. Continuously-Numbered Indicia

It may be argued that my patent claims are limited in scope to indicia which must be sequential, continuously-numbered indicia; and not merely unique indicia assigned sequentially to the transactions. The invention is fairly defined as requiring only that an indicia be uniquely associated with individual transactions, such that the transactions can be thereafter tracked or traced. However, the security, benefits and operability of the system according to the invention are achieved as a result of the uniqueness of the indicia and the coincidence of a unique indicia with each transaction. These result from unique indicia being assigned sequentially to sequential transactions; and not from continuous-numbering indicia used. The point at which a "transaction" is born could be defined as the point of arrival, bundling, etc.; however, according to my invention a unique indicia is associated with each transaction, in substantial coincidence with each transaction reaching some defined point at which the unique indicia is assigned, tracking is thereafter possible. Continuously sequential numbering is not required to accomplish tracking in my computerized system, nor is it necessary to distinguish over the prior art. Accordingly, I seek to correct this possibly misleading interpretation [sic] my invention by securing broader claims without the term "sequential" as a modifier of indicia alone, reciting instead that unique indicia are --sequentially assigned to the transactions--.

3. Continuously-Reported Inventory

It may be argued that my patent claims are limited in scope to systems only in which an inventory total is "maintained" by being incremented every time a new transaction is added to inventory and decremented [sic] every time a completed transaction is removed from inventory. The invention is fairly defined, however, as also encompassing a system in which the information needed for generating the inventory total is maintained and reflects the additions and deletions, but no particular register is actually counted up and down until this information is used for generating an inventory report, i.e., when such information is called for by an operator. I regard the difference between constantly maintaining an inventory total, on the one hand, and maintaining the information by which the total is generated periodically or intermittently on command, on the other, as fully equivalent. Therefore, any claims limitation requiring continuing inventory totals is unnecessary to distinguish over the prior art. I seek to prevent this interpretation and correct the error, by reciting means for generating an inventory report, rather than necessarily means to "maintain" a total.

4. Dot Matrix Printer

I was mistaken in believing that a dot matrix printer is required to print bar codes. I now know that other types of printers will print bar codes. I

seek to correct this error by deleting "dot matrix" in broader claims.

5. Connection of Optical Scanner and Data Processor

It may be argued my patent claims are limited in scope to at least one optical scanner which is at all times "connected" to the data processor, being operable to detect the bar codes on all articles passing a predetermined station. The invention is fairly defined as including an arrangement in which an optical scanner is used to generate and temporarily store a list of scanned bar codes, which are thereafter downloaded from the optical scanner to the data processor during a temporary connection. Such a limitation is not necessary to distinguish over the prior art. I seek to correct this incorrect interpretation, and accordingly seek broader claims changing the recited relationship of the optical scanner and data processor from "connected to" to -- for data communication with--.

6. Grammatical Form of Means Clauses

Correction of the above-noted matters in the new broad claim requires that a number of "means" clauses be rewritten in the more classical form of "means for [verb in gerund form]". The claims have been amended to avoid such errors in grammar and consistency. The foregoing errors occurred innocently and with deceptive intention.

In addition to the foregoing unnecessary limitations found in the claims as issued, reissue is requested to correct an inadvertent error wherein prior art known to applicant and his attorneys, and identified in the specification, was nevertheless inadvertently not filed responsive to the examiner's requirement that copies of the prior art be filed. In the single official action in the application, the examiner required that applicant file copies of the references mentioned in the Prior Art section of the specification. Although I believed that the reference copies had been filed, in fact they had not. (See Declaration of Stephan Gribok, submitted concurrently).

None of these were described in the unfiled Information Disclosure Statement except to note that some were discussed in the specification and the remainder were of "general interest".

Notwithstanding the inadvertent failure to comply with the examiner's requirement for copies of references from the specification, the references were at most cumulative with those already cited by the examiner. The examiner cited Block, U.S. Pat. 3,478,316, which concerns inventory control in connection with a laundry or retail establishment including automatically-scannable tags. The examiner also cited U.S. Pat. 4,264,396 - Stewart, which concerns a general purpose bar code printing machine. I had stated in the specification that bar codes were known, and inventory control systems were known. The claimed invention, however, which is not found in, disclosed or suggested by any of the references, concerns a specific inventory control system in which bar codes are generated in

coincidence with initiation of transactions brought into inventory such that the transactions and the generation of bar codes are [sic] have a one-for-one relationship. This makes it impossible to have an undocumented transaction in inventory (because no bar code would be attached to any undocumented transaction) or to surreptitiously remove a transaction having a bar code associated therewith (because manual correction of the data processor's memory file would be necessary to delete the record of this documented transaction and thereby avoid detection).

The three references that were required, but inadvertently not supplied to the examiner, were described in the specification. One of these, Block, et al, U.S. Patent 3,478,316, was supplied by the examiner. Therefore, two references namely Wesner, U.S. Pat. 3,876,075, and Glass, U.S. Pat. 4,340,810 were not submitted in full text. Wesner teaches an automated laundry counting system based on a computer, and accordingly is cumulative with Block, of record. Glass, Pat. 4,340,810 teaches bar code printing in connection with a general warehouse inventory control system. However, the bar code is pre-printed on tags according to Glass, and is used to label outgoing packed boxes. The bar code is not generated in coincidence with the addition of a new traceable transactions to inventory. Glass teaches that machine readable codes are useful because they cannot be hand altered. A plurality of pre-printed labels for individual items, cartons and distribution lists are produced ahead of time. When the items are loaded in a carton or the like, the pre-printed label applicable to the carton is selected and attached to the carton. Therefore, this reference also lacks coincidence between receipt of items for

a transaction and generation of the machine-readable code.

The references mentioned in the Information Disclosure Statement that was prepared but inadvertently not filed are all filed in the Information Disclosure Statement submitted concurrently herewith. It is believed that the invention is patentable over the references mentioned, particularly because the subject references are cumulative, at most, with those cited by the examiner.

Max Business Systems, plaintiff in the declaratory judgment action seeking invalidity of my patent, has included in its complaint three published articles which are asserted to establish that my invention is not patentable. I was not aware of the articles until Max filed its complaints. The three articles are from Modern Materials Handling. They include examples of inventory control systems based upon preprinted bar codes, and general purpose bar code printers. These references are therefore also cumulative with those already of record in the application. Nowhere in the references, nor in their combination, is there any teaching that security is improved by specifically generating the bar code in coincidence with initiation of transactions into inventory such that undocumented transactions can be detected either by their missing a machine-generated code or by their unofficial removal from inventory after generation of a machine readable code indicates that they have been received.

In summary, patent 4,550,246 is wholly or partly inoperative or invalid due to my claiming less than I had a right to claim and due to the inadvertent noncompliance

with the examiner's requirement for copies of the prior art mentioned in the specification. The claims presented herewith are amended to remove limitations that were unnecessary to distinguish the invention over the prior art. The claims have also been amended to better comply with 35 USC 112, second paragraph.

POWER OF ATTORNEY

I hereby appoint the following persons as my attorneys to transact all business in the Patent and Trademark Office in connection with this application, with full power of revocation and substitution, and to receive the Letters Patent, and request that correspondence be held with said attorneys at the address shown:

J. Rodman Steele, Jr.	-	Reg. No. 25,931
Lewis F. Gould, Jr.	-	Reg. No. 25,057
Harvey D. Fried	-	Reg. No. 28,298
Stephan P. Gribok	-	Reg. No. 29,643
Karl L. Spivak	-	Reg. No. 18,934
Gregory A. Nelson	-	Reg. No. 30,577
John Lezdey	-	Reg. No. 22,735

Steele, Gould & Fried
1700 Market Street, Suite 3232
Philadelphia, PA 19103
Telephone (215) 563-8020.

And, I declare further that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true, and further

that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC 1001, and may jeopardize the validity of the application or any patent which may issue thereon.

Date: 8/27/87

/s/

Herbert L. Markman

FILE COPY

8
No. 95-26

Supreme Court, U.
FILED

NOV 9 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF FOR PETITIONERS

Of Counsel

LEWIS F. GOULD, JR.
STEPHAN P. GRIBOK
ECKERT SEAMANS CHERIN
& MELLOTT
1700 Market Square
Suite 3232
Philadelphia, PA 19103
(215) 575-6000

WILLIAM B. MALLIN
Counsel of Record
TIMOTHY P. RYAN
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
(412) 566-6000

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

(i)

QUESTION PRESENTED FOR REVIEW

In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning of a patent?

(ii)

**LIST OF PARTIES TO THE PROCEEDING
PURSUANT TO RULES 24.1(b) AND 29.6**

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief for Petitioners.

LIST OF PARTIES PURSUANT TO RULE 29.6

Petitioner Positek, Inc. does not have any parent companies or subsidiaries.

(iii)

TABLE OF CONTENTS

QUESTION PRESENTED FOR REVIEW	(i)
LIST OF PARTIES TO THE PROCEEDING PURSUANT TO RULES 24.1(b) AND 29.6	(ii)
LIST OF PARTIES PURSUANT TO RULE 29.6	(ii)
TABLE OF AUTHORITIES	(iv)
OPINIONS BELOW	1
JURISDICTION	1
CONSTITUTIONAL PROVISION	2
STATEMENT OF THE CASE	2
1. The Patent and The Accused System	2
2. The Lawsuit and the Trial	4
3. The Trial Court's Opinion	9
4. Proceedings Before the Federal Circuit	10
5. The Opinions of the Federal Circuit	10
SUMMARY OF THE ARGUMENT	14
ARGUMENT	17

(iv)

I.	THE DECISION OF THE FEDERAL CIRCUIT DENIES THE RIGHT TO A JURY TRIAL IN PATENT INFRINGE- MENT CASES IN CONTRAVENTION OF THE SEVENTH AMENDMENT	17
A.	The Constitutional Right To Trial By Jury Cannot Be Extinguished By Semantical Labels. . .	20
B.	The Holding Below Is Contrary To The Historical Record.	22
C.	The Holding Below Is Inconsistent With Precedent From This Court. . . .	31
II.	THE ADDITIONAL ARGUMENTS ADVANCED BELOW ARE CONSTITUTION- ALLY IRRELEVANT AND UNSOUND . . .	37
A.	The Holding Below Will Not Promote Predictability Or Accuracy In The Patent Law.	37
B.	The Majority's Analogy To Statutory Construction Is Inappropriate.	42
C.	The Federal Circuit's Decision Will Disrupt Settled Areas Of Patent Law.	46
	CONCLUSION	50

(v)

TABLE OF AUTHORITIES

Cases	Page
<i>Arachnid Inc. v. Medalist Mktg. Corp.</i> , 972 F.2d 1300 (Fed. Cir. 1992)	19
<i>Associated Equipment Corp. v. Authorized Motor Parts Corp.</i> , 27 USPQ2d 1784 (Fed. Cir. 1993)	36
<i>Awkwright v. Nightingale</i> , DAVIES PATENT CASES, 37 (Common Pleas 1785)	24
<i>Baltimore & Carolina Line, Inc. v. Redmond</i> , 295 U.S. 654 (1935)	31
<i>Bata Systems, Inc. v. United States</i> , 838 F.2d 1179 (Fed. Cir. 1988)	42
<i>Bates v. Coe</i> , 98 U.S. 31 (1878)	36
<i>Beacon Theaters, Inc. v. Westover</i> , 359 U.S. 500 (1959)	21
<i>Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.</i> , 739 F.2d 604 (Fed. Cir.) <i>cert. denied</i> , 409 U.S. 1038 (1984)	20, 42
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall) 812 (1869)	31, 32

(vi)

<i>Blonder-Tongue Labs. v. University of Ill. Found.</i> , 402 U.S. 313 (1971)	38, 41
<i>Bovill v. Moore</i> , DAVIES PATENT CASES, 361 (Common Pleas 1816)	26, 27
<i>Capital Traction Co. v. Hof</i> , 174 U.S. 1 (1898)	31
<i>Collins v. Sawrey</i> , 4 Bro. P.C. 692 (H.L. 1772)	25
<i>Connell v. Sears, Roebuck & Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)	22
<i>Control Components, Inc. v. Valiek, Inc.</i> , 609 F.2d 763 (5th Cir.), cert. denied, 449 U.S. 1072 (1980)	28, 29
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	35
<i>Dairy Queen, Inc. v. Wood</i> , 369 U.S. 469 (1962)	21
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	21, 37
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942)	36
<i>Elf Atochem North America, Inc. v. Libbey-Owens-Ford Co.</i> , 891 F. Supp. 844 (D. Del. 1995)	48, 49

(vii)

<i>Fidelity & Deposit Co. v. United States</i> , 187 U.S. 315 (1902)	35
<i>Galloway v. United States</i> , 319 U.S. 372, reh'g denied 320 U.S. 214 (1943)	35
<i>Goddard v. Foster</i> , 84 U.S. (17 Wall) 123 (1872)	43
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 224 (1880)	36, 44
<i>Granfinanciera S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	29
<i>Great Northern Railway Co. v. Merchants Elevator Co.</i> , 259 U.S. 285 (1922)	43, 44
<i>H.H. Robertson Co. v. United Steel Deck Inc.</i> , 820 F.2d 384 (Fed. Cir. 1987)	19
<i>Harries v. Air King Products Co.</i> , 183 F.2d 158 (2d Cir. 1950)	28
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	34
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995)	28

(viii)

<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	34
<i>Hornblower v. Boulton</i> , DAVIES PATENT CASES, 221 (K.B. 1799)	26
<i>Howes v. Medical Components Inc.</i> , 814 F.2d 638 (Fed. Cir. 1987)	20
<i>Huddart v. Grinshaw</i> , DAVIES PATENT CASES 265 (K.B. 1803)	26
<i>Hurin v. Electric Vacuum Cleaner Co.</i> , 298 F. 76 (6th Cir. 1924)	29
<i>Intervet America, Inc. v. Kee-Vet Lab.</i> , <i>Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	33
<i>Jacob v. City of New York</i> , 315 U.S. 752 (1942)	21
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989)	19
<i>Keystone Bridge Co. v. Phoenix Iron</i> <i>Co.</i> , 95 U.S. 274 (1877)	34, 45
<i>Laitrum Corp. v. NEC Corp.</i> , 62 F.3d 1388 (Fed. Cir. 1995)	38, 39
<i>Lemelson v. General Mills Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992)	19

(ix)

<i>Liardet v. Johnson</i> (K.B. 1778)	23, 24
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1881)	36
<i>Lucas Aero., Ltd. v. Unison Indus.</i> , <i>L.P.</i> , 1995 U.S. Dist. LEXIS 8414 (D. Del. June 2, 1995)	45, 48
<i>Lytle v. Household Mfg., Inc.</i> , 494 U.S. 545 (1990)	23
<i>Market Street Cable Ry. Co. v. Rowley</i> , 155 U.S. 621 (1895)	34
<i>Markman v. Westview Instruments, Inc.</i> 772 F. Supp. 1535 (E.D. Pa. 1991), <i>aff'd</i> , 52 F.3d 967 (Fed. Cir. 1995)	passim
<i>Mason v. Tampa G Mfg. Co.</i> , 1995 U.S. App. LEXIS 28368 (Fed. Cir. Oct. 12, 1995)	46, 47
<i>Mayor of Kingston Upon Hull v. Horner</i> , 1 Cowp. 102 (K.B. 1774)	25
<i>McGill, Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir.), <i>cert. denied</i> , 469 U.S. 1037 (1984)	20, 42
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1876)	36

(x)

<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986)	20
<i>Motion Picture Patent Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	44
<i>Neilson v. Harford</i> , WEBSTER PATENT CASES, 295 (1841)	27
<i>North American Vaccine, Inc. v. American Cyanamid Co.</i> , 7 F.3d 1571 (Fed. Cir. 1993)	42
<i>Pall Corp. v. Micron Separations, Inc.</i> 66 F.3d 1211 (Fed. Cir. 1995)	42
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	20
<i>Parklane Hosiery Co. v. Shore</i> , 439 U.S. 322 (1979)	40
<i>Parsons v. Bedford</i> , 28 U.S. (3 Pet.) 433 (1830)	31
<i>Perini America, Inc. v. Paper Converting Machine Co.</i> , 832 F.2d 581 (Fed. Cir. 1987)	18, 19
<i>Pierce v. Underwood</i> , 487 U.S. 552 (1988)	41, 42

(xi)

<i>Ramos v. Boehringer Mannheim Corp.</i> , 1995 U.S. App. LEXIS 25870 (Fed. Cir. Sept. 8, 1995)	38
<i>Ransom v. Mayor of New York</i> , 1 Fisher 252 (S.D.N.Y. 1856)	28
<i>Regent Lighting Corp. v. FL Industries, Inc.</i> , 60 F.3d 840 (Fed. Cir. 1995)	47
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970)	23
<i>Seymour v. Osborne</i> , 78 U.S. (11 Wall.) 516 (1870)	36
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1852)	35, 36
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	34, 36
<i>Slocum v. New York Life Ins. Co.</i> , 228 U.S. 364 (1913)	40
<i>SmithKline Diagnostics Inc. v. Helena Lab. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988)	19, 33
<i>Tandon Corp. v. U.S. Int'l Trade Comm'n</i> , 831 F.2d 1017 (Fed. Cir. 1987)	19

(xii)

<i>Tillotson Ltd. v. Walbro Corp.</i> , 831 F.2d 1033 (Fed. Cir. 1987)	19
<i>Tol-O-Matic Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed. Cir. 1991)	19
<i>Tucker v. Spaulding</i> , 80 U.S. (13 Wall.) 453 (1872)	32, 34
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	20, 37
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	24, 25
<i>In re U.S. Fin. Sec. Litig.</i> , 609 F.2d 411 (9th Cir. 1979), <i>cert. denied</i> , 446 U.S. 929 (1980)	41
<i>United States v. Gaudin</i> , _____ U.S. _____, 115 S. Ct. 2310 (1995)	23
<i>United States v. Torniero</i> , 735 F.2d 725 (2d Cir. 1984), <i>cert. denied</i> , 469 U.S. 1110 (1985)	41
<i>Walker v. New Mexico & S. Pac. R.R. Co.</i> , 165 U.S. 593 (1897)	18, 21, 31
<i>Washburn v. Gould</i> , 29 F. Cas. 312 (C.C.D. Mass. 1844)	27

(xiii)

<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	35
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1858)	34
Constitution	
U.S. Const. amend. VII	passim
Statutes	
28 U.S.C. § 1254(1)	1
35 U.S.C. § 112	30
35 U.S.C. § 281	4
35 U.S.C. § 284	5
Statute of Monopolies, 21 Jac. 1, ch. 3, § 2 (1623)	
25	
Other Sources	
<i>Restatement (Second) of Contracts</i> , §§ 200, 212(2) (1981)	43
E. W. HULME, <i>On the History of the Patent Law in the 17th and 18 Century</i> , 18 Law Q. REV. 280 (1902)	24

(xiv)

A. CORBIN, CORBIN ON CONTRACTS, §§ 534, 554	43
A. MILLER & M. DAVIS, INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT (2d ed. 1990)	35
F. BULLER, AN INTRODUCTION TO THE LAW RELATIVE TO TRIALS AT NISI PRIUS ch. VII (6th ed. 1791)	25
JOHN DAVIES, DAVIES PATENT CASES, (London, 1816)	44
WILLIAM HANDS, THE LAW AND PRACTICE OF PATENTS FOR INVENTIONS, (London, 1808)	25
I, J. OLDHAM, THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY (Chapel Hill & London, 1992)	24, 30
S. WILLISTON, WILLISTON ON CONTRACTS, §§ 602, 616	43
XII W. HOLDSWORTH, A HISTORY OF ENGLISH LAW (1938)	25

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
PETITIONERS,
v.
WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
RESPONDENTS.

BRIEF FOR PETITIONERS

Herbert Markman and Positek, Inc. respectfully submit this Brief for Petitioners seeking reversal of the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinions of the Court of Appeals are reported at 52 F.3d 967 (Fed. Cir. 1995), and are reproduced beginning at Appendix page 1a of the Appendix to Petitioners' Petition for a Writ of *Certiorari*. The opinion of the district court is reported at 772 F. Supp. 1535 (E.D. Pa. 1991) and is reproduced beginning at Appendix page 170a of the Appendix to Petitioners' Petition for a Writ of *Certiorari*.

JURISDICTION

The judgment of the Court of Appeals was entered on April 5, 1995. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Petition for Writ of *Certiorari* was granted on September 27, 1995.

CONSTITUTIONAL PROVISION

The Seventh Amendment of the United States Constitution provides:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

STATEMENT OF THE CASE

1. The Patent and The Accused System

Petitioner, Herbert Markman ("Markman"), is the inventor and owner of United States Reissue Patent No. 33,054 ("the patent" or "'054 patent") for an inventory control and reporting system.¹ Petitioner, Positek, Inc. ("Positek"), holds the exclusive license under the patent for the drycleaning industry. Respondent, Westview Instruments, Inc. ("Westview"), manufactures and sells and respondent, Althon Enterprises, Inc. ("Althon"), uses an inventory control and reporting system which infringes the '054 patent.

The '054 patent claims an inventory control and reporting system. As relevant here, the claims of the '054 patent include a data input device for entering data concerning the subject of each of sequentially entered transactions. This data is recorded by a data processor which will associate unique indicia (*e.g.*, a unique number) with each transaction. For each transaction, the data processor directs a printer to generate a printed record (*e.g.*, a ticket) which includes optically detectable bar codes representing the unique identifier of the transaction. These bar codes can be read by

¹The patent is included in the Joint Appendix at App. 293-301.

an optical scanner which is part of the system. The bar coded records can relate to an individual article or a batch of articles. Accordingly, when the object of a transaction is retrieved from inventory (be it an article or batch of articles), the scanner can be used to read the unique bar code identifier to indicate to the system that the object is being removed from inventory, without the effort or risk of error involved in manually keying the number.

The specification of the patent discloses a preferred embodiment in a drycleaning operation and the patent claims a number of embodiments in fourteen claims.² An element of the independent claim here at issue is the requirement that the invention include a data processor with "means to maintain an inventory total." The term "inventory" is not defined in the patent. The evidence at trial was undisputed that, as used in the drycleaning industry, "inventory" may refer to an inventory of clothing or an inventory of invoices with associated dollar amounts. The language of the patent, the prosecution history and the evidence at trial showed that "inventory" is not limited to descriptions of articles of clothing, but may include other types of inventory such as an inventory of invoices and associated dollar amounts.

Petitioners allege, and at trial the jury so found, that Westview's accused inventory control and reporting system infringes two claims of the '054 patent. App. 282-83. The accused system is a sophisticated inventory control and reporting system which includes a data processor with a memory operable to record descriptions of articles of clothing and a means to maintain an inventory of invoices

²Some of the patent claims are not limited to drycleaning so that articles can refer to articles other than clothing.

and their associated dollar amounts. The evidence at trial concerning the features and capabilities of the accused system was extensive and included several demonstrations of the system, App. 22-36; 206-209; as well as the testimony of Westview's president, App. 197-223; the testimony of petitioners' technical expert, App. 15-36; and the accused system's operating manuals, Record, Petitioners' Exhibits 4 and 5, brochures, App. 302-07, and computer programs, Record, Petitioners' Exhibits 10 and 11. What emerged from the evidence is a portrait of an inventory control and reporting system which infringes the literal language of the patent.

As relevant here, Westview's infringing inventory control and reporting system can be described as follows. The system includes data entry means, a data processor, a printer and an optical scanner. App. 21. At trial, there was no dispute but that the Westview system stores in its memory descriptions of articles of clothing which are maintained in the system's memory until a bar coded record containing such descriptions is printed. App. 27-30. In addition, the evidence was uncontested that the Westview system maintains indefinitely in its memory a listing of all invoices with customer numbers and corresponding dollar totals and can generate operational and management reports from this information. App. 30-32; 208; 212-14. Thus, the accused system has means to maintain a cash inventory total for each customer's order, but not a listing of individual garments. *Id.*

2. The Lawsuit and the Trial

On February 12, 1991, petitioners commenced a civil action under 35 U.S.C. § 281 in the United States District Court for the Eastern District of Pennsylvania wherein they accused respondents of infringing the patent and sought,

inter alia, money damages under 35 U.S.C. § 284. On September 24, 1991, a jury was empaneled and trial was commenced before the Honorable Marvin Katz. Partway through trial, the district judge decided to trifurcate the trial, trying infringement first and taking a verdict on infringement before continuing with the trial of the defense of invalidity.

On the issue of infringement, petitioners presented to the jury the testimony of four witnesses: an expert on computer equipment, computer matters and bar code technology, who testified concerning the operation, capacity and function of the accused system and demonstrated Westview's system to the jury, App. 9-46; an expert on patents, who explained patents and patent practice, interpreted the claims of the patent and testified on how the claims of the patent read on the accused system, App. 46-145; the inventor of the '054 Patent and himself one skilled in the art who testified, *inter alia*, about the substance of the invention and prior art, App. 160-195; and an expert on the analysis of business and financial records, App. 153-160. The testimony of these witnesses, voluminous documents (including the accused system's operating manuals, brochures and computer program) and the accused system itself were presented to the jury and received into evidence. On cross examination, Westview attacked the credibility of petitioners' witnesses and sought to suggest different versions of the facts.

The evidence at trial demonstrated, *inter alia*, that a skilled artisan would understand that, because the patent permits inventory to be controlled by batches of articles (as does the accused system), an inventory total could be in dollars associated with the batches without keeping a permanent listing of the individual articles of clothing in the system's memory. App. 30-31; 38; 56; 69-70; 74; 77-82; 97; 108;

141; 145; 169; 172-74; 194; 293-301. Westview's president -- the designer of the accused system and also one skilled in the art -- conceded during cross examination that Westview's brochures (which he had approved) described the accused system as an inventory control system, thereby recognizing that in the industry the usage of the term "inventory" includes cash totals as well as physical totals. App. 210; 302; 305; 306; 307.³ He further testified that one type of inventory a drycleaner is concerned about is cash inventory and that the accused system was designed to account for that type of "inventory." App. 212. He described the list of invoices generated by the accused system as the "dollar inventory." *Id.* In his deposition testimony read to the jury, Westview's president had also described the accused system as an "inventory control system." App. 210-211.

The evidence explained to the jury that the claims were not limited to the preferred embodiment in the specification and that, since the independent claims are satisfied by "at least one optical scanner", App. 56; 73, it covered an embodiment with one optical scanner which, unlike the preferred embodiment, did not read the bar coded record at multiple points, as one skilled in the art or in the reading of patents would understand. App. 138-140. There was evidence about prior art inventory systems and the patent was evaluated in light of those systems. App. 39-41; 175-176; 293-301. There was documentary evidence and testimony about events before the Patent Office as bearing on the meaning of the patent. App. 183-84; Record, Respondents' Exhibit 4. On the evidence, one skilled in the art would recognize that the accused

³Westview's literature described the accused system: "AMERICA'S FIRST CHOICE FOR INVENTORY CONTROL." App. 302.

system was within the scope of the two infringed claims. At least, on the trial record, inferences of fact would need to be drawn about the meaning of the patent and its application to the accused system. During the trial, the trial judge recognized the existence of evidentiary disputes and made evidentiary rulings concerning the factual disputes. *See, e.g.*, App. 39; 63; 66; 78; 169.

After the close of petitioners' infringement case in chief, respondents filed a motion for a directed verdict pursuant to Rule 50 of the Federal Rules of Civil Procedure. The trial judge deferred ruling on the motion. App. 196.

Respondents called but a single witness during the infringement portion of the trial, the president of Westview. His testimony was limited to a description of the features of the accused system. App. 197-204. On cross examination, he made the critical admissions noted above about the meaning of the term "inventory" and usage of that term in the industry and in Westview's literature, *supra* p. 6. Respondents did not offer to the jury any evidence regarding the meaning of the patent claims and the fact that the patent claims read literally on the accused device.

After the conclusion of the testimony of their single witness, respondents renewed their motion for a directed verdict. App. 224. Again, the trial judge deferred ruling on that motion, leaving the factual disputes and credibility to the jury. *Id.* Thereafter, counsel gave their closing statements. App. 227-241. Counsel for the parties vigorously argued credibility and debated the facts and the factual inferences to be drawn from the evidence. Credibility issues and factual disputes were put to the jury in a spirited, adversarial way.

The court then charged the jury on infringement. App. 246-257. The charge instructed on the burden of proof and the requirements of infringement. The district judge recognized the existence of evidentiary disputes by instructing the jury "to determine the meaning" of the disputed claim terms, taking into account not only the patent itself, but also all "other considerations" that bear on how the text "would normally be understood by those of ordinary skill in the art." App. 253. The court then instructed the jury to:

determine the meaning of the claims taking the interpretation as I've explained it to you using the relevant patent documents including the specifications, the drawings and the file histories. . . . Also relevant are other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art.

The meaning must be of an ordinary and of a custom [sic, customary] meaning unless it appears from the file history that the inventory [sic, inventor] used the terms differently. I have interpreted those terms for you. After you've decided what the claims mean, you apply the claims as interpreted to the Westview productions, [sic, products] in question to determine if the claims read on them. App. 253.

After its deliberations, the jury returned a general verdict finding that the accused system infringes two claims of the '054 patent. App. 282-83. The jury verdict, which was consistent with the district judge's instructions, impliedly accepted the interpretation of the patent urged by petitioners. The district judge did not pose interrogatories to the jury requiring the jury to indicate expressly the interpretation which it had found. However, as the parties were preparing to move into the next phase of the trifurcated trial, the

district judge granted respondents' motion for a directed verdict.

3. The Trial Court's Opinion

The district judge held, on the deferred ruling on respondents' motion for directed verdict, that "claim construction was a matter of law for the court." 171a. Thus, the district judge reinterpreted the patent *de novo*, affording *no* deference to the interpretation found by the jury.

The district judge's opinion setting aside the jury's infringement verdict was predicated on the substitution of his erroneous interpretation of the meaning of the term "inventory" as used in the claims of the patent and his mistaken understanding of the accused device. Contrary to the language of the patent and the evidence introduced at trial, the trial judge found that the patent claims described an inventory control and reporting system that maintains throughout in its memory, indefinitely, a listing of descriptions of articles of clothing. The trial judge concluded that because the accused system does not maintain such a listing of the description of each article of clothing, it did not infringe the patent, because only a physical inventory could comport with that meaning of the patent which could not be satisfied by maintaining a cash inventory.

In reaching that interpretation, the district judge weighed the evidence, evaluated credibility, rejected evidence and purported to explain away admissions by Westview.⁴ In short, he found facts. The district judge did not purport to

⁴In one notable instance the trial judge found that Westview's own brochure was inaccurate since it belied his interpretation of the term "inventory", even though Westview had not suggested that its brochure was incorrect or misleading. 176a.

determine that the evidence was insufficient to support the jury verdict. Instead, he expressly decided that the meaning of the terms of the patent was an issue of law exclusively for him which he proceeded to decide by weighing and evaluating the evidence. 13a-14a.

4. Proceedings Before the Federal Circuit

On October 24, 1991, petitioners filed a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. Petitioners submitted briefs demonstrating that the trial court failed to apply the appropriate standard of review to the jury verdict and thereby violated petitioners' Seventh Amendment right to a jury trial. Oral argument was held before a panel of the Federal Circuit on May 8, 1992. No opinion or decision was issued by the panel. Rather, on November 5, 1993, the Federal Circuit, *sua sponte*, ordered that the appeal be heard by the court *en banc*. On January 7, 1994, the Federal Circuit entered an Order noting that the appeal raised "significant issues relating to interpretation of a claim in a patent" and requested additional briefing for rehearing *en banc* with respect to four questions relating to the respective roles of the judge and jury on issues of patent claim interpretation. Oral argument was heard before the Federal Circuit *en banc* on May 4, 1994. On April 5, 1995, the Federal Circuit issued its Opinions.

5. The Opinions of the Federal Circuit

The majority affirmed. It held that interpretation and construction of patent claims which, by necessity, define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court without any role for or deference to the jury, ("[t]he court has the power and obligation to construe as a matter of law the meaning of language used

in the patent claim"). 30a. Since it labelled the dispute as a question of law, the majority also held that on appeal interpretation of the patent was a matter for *de novo* review ("[W]e review district court determinations on questions of claim construction under a *de novo* standard of review, like other legal questions."). 44a n.13.⁵

While the majority spoke of "claim construction," it repudiated the traditional distinction between "construction," which involves determining the legal effect of a written document, and "interpretation," which involves determining its meaning. 21a n.6. ("[W]e conclude that the *interpretation and construction* of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." (emphasis added)). 5a.

The majority made clear that its holding applied even if "[e]xtrinsic evidence" -- including live "expert and inventor testimony" -- is necessary to determine the meaning of the patent.⁶ 33a. This means that, whatever formula is used to describe the consideration of this evidence, the district judge

⁵The majority opinion also controls bench trials. The findings of a judge in a bench trial about the meaning of a patent term will be reviewed on appeal *de novo* as a matter of law, rather than under the usual clearly erroneous standard. Whether in a bench trial or in a jury trial, the new rule of the majority exalts review of a cold record over the give and take of the trial which cannot be fully captured in a written record. The massive scope of the task assigned by the majority to the Federal Circuit in patent cases is matched only by the limitless reach of the power it has assumed in those cases.

⁶The court reaffirmed the traditional rule that "extrinsic evidence," including live testimony, is appropriate to determine the "true meaning of the language employed" in the patent." 34a. Without that evidence the trier often would have no idea of the meaning of the patent or particular terms to those skilled in the art.

actually will decide the weight of evidence and credibility and demeanor of witnesses in resolving this supposed issue of law. The holding also expressly means that the district judge's decision, depending at least in part on weighing evidence and credibility, is to be reviewed *de novo* by the Federal Circuit as a matter of law, without any deference to the findings of the jury or judge. This result flows from a change of labels divorced from substance: the factual dispute merely is relabelled a question of law. After holding that the jury had no role in finding the meaning of the patent, the majority then interpreted the patent *de novo* by weighing evidence and deciding credibility, 43a, labelling that fact finding process as deciding a legal issue.⁷

The majority acknowledged that the Seventh Amendment applies to infringement actions for damages, but found no authority supporting "the proposition that claim construction was a question of fact or involved triable issues of fact to a jury in or prior to 1791." 45a. In reaching its decision, the court also acknowledged "inconsistencies" between the decision below and its prior decisions, 25a, at least seven of which it explicitly disapproved. 23a-24a.

Finally, the majority advanced several policy and theoretical arguments. It asserted that judges must interpret patents to ensure both predictability and accuracy. 28a-29a. It argued that jury determinations were inappropriate because "extrinsic evidence" could not enlarge, diminish or vary the text of the patent. 35a. And, it contended that patents are more analogous to statutes than to contracts. 51a-52a.

⁷The majority did not hold that the evidence was insufficient to support the jury verdict, or even analyze that issue. There was ample evidence to support the jury verdict.

Judge Mayer concurred but strongly criticized the majority's reasoning and characterized the majority's holding as a "sea change" in the law. 57a. He reasoned that if "extrinsic evidence" results in a "genuine dispute" over the meaning of a patent term, it "falls to the finder of fact to settle it." 64a. He was blunt that removing these disputes from the jury was "unconstitutional." 58a. Moreover, he emphasized that because infringement often turns on how the patent is interpreted, the classification of all interpretive questions as legal ones "eviscerates" both the role of the jury and the Seventh Amendment. 57a-58a. Judge Mayer's views on the majority's conclusions are well summarized in the opening paragraph of his opinion:

Today the court jettisons more than 200 years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment of the Constitution of the United States; it marks a sea change in the course of patent law that is nothing short of bizarre. Sadly, this decision represents a secession from the mainstream of the law. It portends turbulence and cynicism in patent litigation. For this is not just about claim language, it is about ejecting juries from infringement cases. All these pages and all these words cannot camouflage what the court well knows: To decide what the claims mean is nearly always to decide the case. 57a.

Judge Rader concurred, but did not address the Seventh Amendment issue. 81a-82a.

Judge Newman dissented. 83a. She concluded that disputes about the meaning of patents are factual ones, informed as they are by live testimony about the scope and content of prior art, events that occurred during the prosecution history, and the usages and customs of the relevant

scientific community. 83a-92a. On the Seventh Amendment question, she set forth extensive historical evidence that infringement cases in general, and patent interpretation issues in particular, were tried to juries in England beginning at least as early as 1623. 118a-129a. She characterized the majority's treatment of the Seventh Amendment as nothing short of "egregious."

The most egregious lapse in the majority's ruling is its discard of the jury right in patent cases. As I said at the outset, patent infringement has been tried to a jury in the United States for two hundred years, and in England since at least 1623. . . . Patent infringement trials at common law included determination of validity as well as infringement. Whatever version of "law/fact" this court now chooses to adopt, it cannot redact the history of jury trials. The judicial obligation to safeguard the constitutional rights is not defeasible by calling a patent a "statute" or otherwise diminishing the vitality of the Seventh Amendment.

115a. She would have reversed and remanded.

SUMMARY OF THE ARGUMENT

The majority holding deprived petitioners of their constitutional right to jury trial under the Seventh Amendment. More importantly, it uprooted the landscape of the trial of patent infringement cases for damages and generally rejected the constitutional right to jury trial concerning the meaning of patents without citing or considering the historical record in England as of 1791.

The Seventh Amendment, which concededly applies to patent infringement actions for damages, preserves the right to jury trial as it existed in England in 1791 when the Bill of Rights was adopted. This constitutional right extends to

statutory and other claims which are analogous to claims that existed at common law. The right cannot be abridged by changes in form or labels; otherwise the Seventh Amendment would be an empty historical relic.

Patents are interpreted to determine their meaning to those skilled in the art, to whom the patent disclosures are directed. That determination -- what does a patent term mean to one skilled in the art -- is on its face a factual issue. Significantly, it is settled that extrinsic evidence, including documentary evidence, testimony, expert opinions and evidence about the prior art, may be considered in interpreting a patent to determine what it means to one skilled in the art. No formula or label can obscure the reality that, when such evidence is considered, it is weighed, credibility is assessed and demeanor is evaluated -- and facts are found. Such a dispute is a classic factual issue which must be submitted to the jury under the Seventh Amendment.

The historical record is clearcut that in England as of 1791 disputes regarding the meaning of patents including patent specifications were decided by juries. This is demonstrated in clear precedent including instructions given to juries and opinions evaluating jury verdicts. It was clear that juries determined the "meaning of the specification" of patents. This approach was not questioned before 1791.

After 1791, the courts in England and then in America continued the pre-1791 practice. Interpretative disputes were treated as factual disputes for the jury in a jury trial. This was confirmed by Justice Story, the leading intellectual property scholar of his time, in a seminal case where he summarized English law. It was also confirmed much later by Judge Learned Hand who expressly recognized that the interpretation of patents is a factual issue.

The jettisoning by the majority of the constitutional right to jury trial in patent infringement cases is also inconsistent with a long line of precedent from this Court which the majority misreads. Seventh Amendment jurisprudence is not a search for loopholes or a manipulation of labels. It jealously guards and preserves the right to jury trial.

The majority seeks to escape the Seventh Amendment by relabelling the factual dispute as an issue of law to be reviewed *de novo* on appeal. Significantly, the majority then interpreted the patent by weighing evidence and assessing credibility and demeanor, 43a, insisting that its factfinding process is the decision of a legal issue. No fiction or formula can blur the distinction between factual disputes and legal disagreements. The Seventh Amendment and 1791 English practice cannot be so easily circumvented.

The majority attempts to justify its holding by a number of policy considerations and analogies not grounded in the Seventh Amendment. These arguments are misguided and, more importantly, are beside the point because the Seventh Amendment turns on history and substance and cannot be undermined by new labels or 1995 perceived policy. The majority's belief that it can do a better job of interpreting patents has no bearing on the Seventh Amendment question and cannot rewrite the binding historical record. Actually, the majority's new approach including *de novo* appellate review is unworkable and has and will create havoc in patent infringement litigation.

Patents are not statutes, and there is not a hint that this farfetched notion ever occurred to English common law courts in 1791. The majority's search for elusive predictability and accuracy in patent interpretation is futile and only serves to illustrate the mischief of attempting to pierce

bedrock constitutional principle by relying on passing fancies and fashions in policies. All relevant policy and other issues were decided in 1791 when the Seventh Amendment was adopted as part of the Bill of Rights. The decision of the Federal Circuit should be reversed.

ARGUMENT

I. THE DECISION OF THE FEDERAL CIRCUIT DENIES THE RIGHT TO A JURY TRIAL IN PATENT INFRINGEMENT CASES IN CONTRAVENTION OF THE SEVENTH AMENDMENT.

The issue presented involves the fundamental role of the jury in patent infringement cases. In holding that the interpretation of disputed claim terms is a matter of law, the majority eliminated, or at least sharply curtailed, the role of the jury in determining infringement.⁸ This conclusion deprives patentees and accused infringers of the right to a jury trial in a patent infringement action in violation of the Seventh Amendment. Moreover, the majority opinion of the Federal Circuit is predicated upon a misapprehension and misapplication of prior decisions of this Court.

Patents are directed to those skilled in the art. They contain technological disclosures and are written by and for the technologically experienced. The meaning and scope of the terms that define the patented invention are often in dispute in infringement litigation, as the scope of the meaning assigned to a particular term will often decide the

⁸The interpretation of patent claim language is vital, indeed usually dispositive, on infringement and is also critical and frequently dispositive on validity. In patent cases arising after the decision below, the jury will often be a futility and, in any event, will have only a secondary role. The main event will be the decision of a panel of the Federal Circuit.

issue of infringement. The task of determining what the claims mean to one "of skill in the art" is a factual inquiry. If there is a genuine dispute after consideration of the available documentation (*i.e.*, the patent specification, drawings and prosecution history), resort must be had to extrinsic evidence to ascertain the proper meaning of the claim. Such extrinsic evidence, in the form of documentary evidence or expert testimony, will seek to demonstrate what the claims mean to those skilled in the art. The prior art and the testimony of technical experts may reveal how others use and understand technical terms. In addition, the testimony of patent law experts may shed light on the proper interpretation of claims. In our adversary system there usually will be conflicting evidence bearing on the issue. It is unrealistic to think in terms of one expert simply informing or educating the judge as though there were no dispute.

Of course, when a tribunal -- judge or jury -- resolves issues by considering testimony and evidence, it must weigh conflicting evidence, make credibility determinations and judge the demeanor of witnesses. In the final analysis, it must find facts to resolve that dispute. Thus, this is a classic issue -- a factual dispute -- to be submitted to the jury as required by the Seventh Amendment. *See, e.g., Walker v. New Mexico & S. Pac. R.R.*, 165 U.S. 593, 596 (1897) ("questions of fact in common law actions shall be settled by a jury").

This inescapable reality and analysis has long been understood and recognized. For example, in *Perini America, Inc. v. Paper Converting Mach. Co.*, 832 F.2d 581 (Fed. Cir. 1987), former Chief Judge Markey expressly acknowledged the proper analytical framework when there exists a genuine factual dispute concerning the meaning of claim terms.

Perini involved an appeal from a bench trial where the court recognized that "[i]t is axiomatic, however, that this court does not undertake to retry the entire case on appeal." *Id.* at 584. While observing that the interpretation of claim terms can at times present an issue of law when there is no genuine dispute as to the interpretation of those terms, the court nonetheless emphasized that in a bench trial "[f]indings on disputed meanings of terms in the claims and on the infringement issue must be shown to have been clearly erroneous." *Id.* Judge Markey further explained that "[i]f the meaning of terms in the claim, the specification, other claims, or other prosecution history is disputed, that dispute must be resolved as a question of fact before interpretation can begin." *Id.*

Until the majority opinion below, the Federal Circuit has consistently held that claim interpretation depends on underlying factual inquiries. In a long line of cases, the Federal Circuit has held that, while the ultimate issue of claim construction is a matter of law, the resolution of that issue may depend upon contested issues of fact which are properly resolved by the jury in a jury trial or the trial judge in a bench trial.⁹ By its decision here, the majority of the

⁹*See, e.g., Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992); *Lemelson v. General Mills Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989); *see also Tol-O-Matic Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1552 (Fed. Cir. 1991); *SmithKline Diagnostics Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 885 (Fed. Cir. 1988); *Perini America v. Paper Converting Mach. Co.*, 832 F.2d 581, 586 (Fed. Cir. 1987); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1039 (Fed. Cir. 1987); *Tandon Corp. v. U.S. Int'l. Trade Comm'n.*, 831 F.2d 1017, 1021 (Fed. Cir. 1987); *H.H. Robertson Co. v. United Steel* (continued...)

Federal Circuit has in wholesale fashion rejected this entire line of precedent which is premised on litigants' fundamental Seventh Amendment rights, which in turn, are defined by English common law as of 1791. The majority did not assert that it had relied on newly discovered evidence of that governing 1791 law. Thus, it is hard to fathom how this constitutional right could be abrogated in 1995. Policy preferences in 1995 and 1995 perceptions that judges could better do this job cannot abrogate the constitutional right to jury trials.

A. The Constitutional Right To Trial By Jury Cannot Be Extinguished By Semantical Labels.

The Seventh Amendment bestows upon a litigant in civil cases the right to a jury trial equivalent in scope to the right which existed at common law in England in 1791, the date when the Bill of Rights was ratified. *Tull v. United States*, 481 U.S. 412, 417 (1987). The Seventh Amendment right extends to statutory actions created by Congress subsequent to 1791 so long as such actions are analogous to those decided in the law courts of 18th century England. *Id.* This Court has previously taught that where the resolution of a particular question goes to the "fundamental elements" or the "substance of the common-law right of trial by jury," no court may constitutionally remove it from the jury. *See*

⁹(...continued)

Deck, Inc., 820 F.2d 384, 389 (Fed. Cir. 1987); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 646 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 976 (Fed. Cir. 1985); *Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 614 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *McGill Inc. v. John Zink Co.*, 736 F.2d 666, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

Walker, 165 U.S. at 596. (Seventh Amendment "requires that questions of fact and common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative."). Consequently, it is not the Federal Circuit's prerogative to take from a party the right to jury trial because it may deem itself better suited to find technological facts in patent cases, nor is it the prerogative of the Federal Circuit to relabel the issue to defeat the right to jury trial.

This Court has made clear in its Seventh Amendment jurisprudence that the right to a trial by jury is sacred and should be carefully guarded by the courts. As the Court observed in *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935), "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care." *See also Jacob v. City of New York*, 315 U.S. 752, 752-53 (1942) ("The right of trial jury in civil cases at common law is a basic and fundamental feature of our system of federal jurisprudence which is protected by the Seventh Amendment. A right so fundamental and sacred to the citizen, whether guaranteed by the Constitution or provided by statute, should be jealously guarded by the courts.").

By sleight of hand, the majority recharacterizes factual issues properly triable to the jury as matters involving strictly legal questions. 44a. The majority's recharacterization of these issues is in direct conflict with the teachings of *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 470 (1962) and *Beacon Theaters, Inc. v. Westover*, 359 U.S. 500, 511-12 (1959), which unequivocally held that an otherwise applicable right to jury trial is not forfeited merely because

some issues otherwise triable to a jury are intertwined with legal questions reserved for the court.¹⁰

The majority's analysis is wrong for a number of independent reasons. The majority ignored clear historical evidence that juries, not judges, interpreted patents in England in 1791 and thereafter in England and the United States. It also misread a series of related decisions in which this Court addressed whether patent interpretation questions should be classified as legal or factual. In the final analysis, the majority rested primarily on a series of policy-based and theoretical arguments that have no place in this Court's Seventh Amendment jurisprudence, and are unconvincing even on their own terms. Relabelling in 1995 a factual dispute as a legal question cannot escape the Seventh Amendment.

B. The Holding Below Is Contrary To The Historical Record.

The majority's assertion that interpretive disputes present legal questions cannot foreclose constitutional analysis, for the Seventh Amendment would be meaningless if courts could evade it simply by re-classifying factual questions as legal ones. The appropriate analysis turns on substance and history, not labels. If the Seventh Amendment could be avoided by a change of label or form, it would become a dead parchment. After all, the abolition of common law

¹⁰The Federal Circuit has itself pledged its allegiance to the basic tenets of the Seventh Amendment despite its current ruling. In *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983), the court stated that, "[s]o long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues and particular types of cases be treated differently from similar issues in other types of cases."

forms of action has not abrogated the right to jury trial for their modern counterparts.

Thus, the Seventh Amendment applies not only to *claims* tried by juries at common law, but also to *issues* decided by juries at common law. See, e.g., *Ross v. Bernhard*, 396 U.S. 531, 538 (1970) ("The Seventh Amendment question depends on the nature of the issue to be tried rather than the character of the overall action."). For example, when legal and equitable claims are tried together, the Seventh Amendment attaches not only to the legal claim as a whole, but also to "'all issues common to both claims.'" *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 550 (1990) (quoting *Curtis v. Loether*, 415 U.S. 189, 196 n.11) (emphasis added)). See also, *United States v. Gaudin*, ___ U.S. ___, 115 S. Ct. 2310 (1995) (Sixth Amendment requires jury determinations of all "mixed" questions of law and fact that have "typically been resolved by juries").

The majority below conducted no historical analysis to determine whether the relevant issue -- interpretation of the patent -- was triable to a jury at common law. 45a. It made no effort to refute the scholarly summary and analysis of the historical record presented by Judge Newman. 118a-129a. The majority side-stepped the Constitutional standard appearing on the face of the Seventh Amendment and as authoritatively reinforced by this Court's clear mandate.

In fact, the historical record shows that the issue here was a jury issue in 1791. In infringement cases decided before 1791, English juries were instructed to decide questions that required them to interpret terms of art in patents. For example, in *Liardet v. Johnson* (K.B. 1778), a leading King's Bench decision, a defendant asserted that a patent was invalid because its specification had not adequately described

how to make the invention. Lord Mansfield instructed the jury to determine not only whether the device could be made, but also "all objections made to exactness, certainty and propriety of the specification." See I. J. OLDHAM, *THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY* 756 (1992) (printing previously unpublished jury instructions from manuscript sources).¹¹

This same conclusion was reached in *Arkwright v. Nightingale*, DAVIES PATENT CASES 37 (Common Pleas 1785). This was an action alleging the infringement of a patent for a silk and wool spinning machine. The defendant challenged the validity of the patent on the ground that the specification did not adequately disclose the alleged invention. The judge instructed the jury to weigh the credibility of the witnesses who testified at trial in determining whether the specification adequately disclosed the invention. This required the jury to evaluate testimony about the meaning, understanding and application of the patent specification. The disputed meaning of the patent was for the jury.

Similarly, in *Turner v. Winter*, 1 T.R. 602, 605 (K.B. 1787), the Court of King's Bench (the principal common law court of the time) set aside an infringement judgment because the jury had not "fully and fairly examined" whether

¹¹Because of the incomplete and unofficial nature of court reporting in England in the late 18th century and because of the passage of years before case reports were published, it was common for manuscripts of noteworthy cases to be circulated among the judges and lawyers. OLDHAM, *supra* at 104. Other sources confirm the particular significance of the *Liardet* case. See E. W. Hulme, *On the History of the Patent Law in the 17th and 18th Century*, 18 LAW Q. REV. 280, 317-18 (1902).

the patent was vague or misleading. Rather than make those determinations itself, the court remanded the case for a new trial. An influential 1791 authority confirmed that juries, in determining the validity of a patent, also must determine "[t]he meaning of the specification." F. BULLER, *AN INTRODUCTION TO THE LAW RELATIVE TO TRIALS AT NISI PRIUS*, ch. VII, at 76 (6th ed. 1791).¹² See also WILLIAM HANDS, *THE LAW AND PRACTICE OF PATENTS FOR INVENTIONS*, London (1808) (in a proceeding attacking a patent where legal objections are asserted "the record is sent into the Court of the King's Bench, to be tried by a Jury, who decide on the facts put in issue; . . ."). *Id.* at 17.

It therefore is clear that 18th century English juries were required to interpret disputed patent terms in bringing in general verdicts.¹³ Thus, a case requiring interpretation of a patent specification was, to use Chief Judge Archer's words, "an action [that] could be tried to a jury in 1791. . . ." 43a. This was the unequivocal state of the law as of the

¹²Francis Buller was a Justice on the King's Bench between 1778 and 1794. His work on trial practice, *Nisi Prius*, was widely used and respected. See, e.g., XII W. HOLDSWORTH, *A HISTORY OF ENGLISH LAW* 354 (1938) ("a good deal more than a book of practice").

¹³This conclusion finds further support in cases involving other grants under the Statute of Monopolies, 21 Jac. 1, ch. 3, § 2 (1623), which held explicitly, before 1791, that juries must resolve relevant interpretive disputes. For example, in *Collins v. Sawrey*, 4 Bro. P.C. 692, 699 (H.L. 1772), the House of Lords rejected an argument that the "construction" of a charter, because it depended on "written evidence," should not have been "tried . . . by a jury" (emphasis in original). Similarly, in *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102, 108 (K.B. 1774), the court held that a dispute about the interpretation of a charter "is a question of fact" and "therefore most proper to be left to the decision of the jury."

date of adoption of the Seventh Amendment preserving the right to jury trial.

English cases decided after 1791 reiterated that this settled practice applies to patents. In *Hornblower v. Boulton*, DAVIES PATENT CASES 221 (K.B. 1799), an action was brought for the alleged infringement of a patent granted to James Watt for "a method of lessening the consumption of steam and fuel in fire-engines." The defendant contended that the specification was inadequate. In affirming the jury finding that the specification was sufficiently specific, Justice Lawrence stated that, "[w]hether those directions [to enable a workman to execute the invention] were or were not sufficient, is not now a question for our decision; it was a question for the determination of the jury, and they have decided it." Thus, the court recognized that a jury should determine on the evidence whether the language and terms of the specification sufficiently described the invention so it could be understood and used by a skilled artisan.

Similarly, in *Huddart v. Grinshaw*, DAVIES PATENT CASES 265 (K.B. 1803), suit was brought for the infringement of a patent for a method of making cables. The defendant challenged the validity of the patent claiming that the alleged invention disclosed in the patent was not new. Lord Ellenborough instructed the jury that it was their duty to construe the specification to determine if what was disclosed constituted a "new invention." Similarly, in modern patent law in the United States, it is necessary to interpret the patent to decide whether it discloses a new invention.

The jury was similarly instructed in *Bovill v. Moore*, DAVIES PATENT CASES 361 (Common Pleas 1816), where the plaintiff brought an action for the infringement of a patent for a machine for manufacturing lace. The alleged

infringer claimed that the described invention was not new. The jury interpreted the specification and found that the invention was not new.

Finally, in *Neilson v. Harford*, WEBSTER PATENT CASES 295, 370 (1841), the Court of Exchequer (also a common law court) explained that while a judge must "construe all written instruments," the "true meaning of the words in which they are couched, and the surrounding circumstances, if any," must be "ascertained by the jury." The *Neilson* court agreed that it was "peculiarly the province of a jury" to construe "as matters of fact" patent terms that might constitute "words of art, words of commerce, [and] words which are used in some sense different from their ordinary sense. . . ." *Id.* at 367.

In the United States, the role of the jury in interpreting patents in accordance with English practice is illustrated by the case of *Washburn v. Gould*, 29 F. Cas. 312 (C.C.D. Mass. 1844). Summarizing the English practice and citing *Neilson*, Judge Story explained that, while courts would construe the legal effect of patents, juries would determine their meaning:

[T]he jury are judge of the meaning of words of art, and technical phrases, in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification.

Id. at 325.

The historical record confirms Justice Story's conclusion.¹⁴ See, e.g., *Ransom v. Mayor of New York*, 1 Fisher 252 (S.D.N.Y. 1856) (claim construction is a jury question if "there may be technical terms, or terms which need explanation by the evidence given before the jury. . . .").

The doctrine that the construction of disputed claim terms raise issues of fact to be left to the factfinder was well understood in the modern era as evidenced by decisions which predate the establishment of the Federal Circuit. For example, in *Harries v. Air King Products Co.*, 183 F.2d 158 (2d Cir. 1950), Judge Learned Hand, reviewing the decision of the district judge in a non-jury trial on the issue of claim construction, held that:

The question was of how the art understood the term, which was plainly a question of fact; and unless the finding was "clearly erroneous," we are to take this definition as controlling. . . . While Congress sees fit to set before us tasks which are so much beyond our powers, suitors must be content that we shall resort to the testimony of experts, though they are concededly advocates with the inevitable bias that advocacy engenders. We see no reason to disturb Judge Galston's acceptance of [defendant's expert witness'] testimony. . . .

Id. at 164. See also *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980) (the proper meaning of a claim term "is a factual issue to be determined by the jury with reference to the specifications in the patent, the disclosures of the prior

¹⁴In *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1516 (Fed. Cir. 1995), the Federal Circuit acknowledged that Justice Story was "the leading intellectual property scholar of that era."

art, and the testimony of experts."); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("[i]n case of a controversy as to the construction of a patent claim, it may usually be true . . . that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved.").

The force of these cases goes beyond the particular holdings and interpretative issues presented to the respective juries. In these cases, running from the late 18th century until the 1980's, the analysis does not evince any hostility towards jury trials. There is no effort to manipulate labels, terms or forms to take questions from the jury. Instead, the rich heritage of jury trial is understood and affirmed. These cases accept the commands of the Seventh Amendment. The constitutional analysis is not distorted by a search for loopholes. That rich constitutional tradition has experienced a remarkable and devastating reversal by the majority opinion below which ignores the binding past and portends mischief in the future for patent cases in particular and the Seventh Amendment in general.

Citing no contrary historical precedent, the majority below argued that all of these cases are irrelevant simply because of "manifest differences in patent law in eighteenth century England and patent law as it exists today in Title 35 of the United States Code." 45a. That reasoning is flawed on several grounds. To begin with, "manifest differences" cannot be dispositive for purposes of Seventh Amendment analysis, which requires identifying not an identical English claim or issue that was tried to a jury, but only an "analogous" one. See *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989). Moreover, the court's analysis does not address how any such "manifest differences" would affect

the specific question at issue here -- whether judges or juries should interpret patents. The majority's argument is akin to saying that, because patent infringement suits for damages no longer sound in trespass on the case - a "manifest difference" - the right to jury trial has vanished because the Seventh Amendment should be read like a tax statute rather than part of the Bill of Rights. Further, the only difference cited by the majority -- that use of the word "claim" originated in American law, 45a -- is a distinction of pure semantics, and of no substance.¹⁵ The consistent message from this Court is that the Seventh Amendment cannot be so easily and so superficially circumvented.

The historical record is uncontroverted that in England in 1791, juries interpreted patent terms in infringement cases.

¹⁵Under eighteenth-century English law, a patentee was required to enroll a "specification" that would particularly describe the nature of the invention and would enable "mechanics" to "make the machine by following the directions of the specification," J. OLDHAM, *supra*, at 732 (quoting jury instructions by Justice Buller in *Rex v. Arkwright*, as given at pp. 172-73 of the printed proceedings in the case, and as reprinted at Carpmael Patent Cases at 79, Webster Patent Cases at 66 and Davies Patent Cases at 106.) Under modern American law, a patent must contain (1) "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention"; and (2) a "specification" that describes the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112. These requirements are substantively identical, regardless of whether the relevant descriptions appear in text entirely denominated as a "specification" (as in older English law) or in text denominated in part as a "claim" and in part as a "specification" (as in modern American law). A semantic distinction unrelated to the substance of the interpretive issue in dispute cannot rewrite history or abrogate the constitutional right to jury trial.

The majority erred in holding that the Seventh Amendment does not guarantee the same jury determinations today.¹⁶

C. The Holding Below Is Inconsistent With Precedent From This Court.

Citing but not analyzing ten of this Court's decisions, the majority asserted that "construction of a patent claim is a matter of law exclusively for the court." 25a-26a. Actually, those cases establish a nearly opposite proposition -- that construction or interpretation of a patent is a *factual* question for the jury, at least if the parties introduce live testimony or other extrinsic evidence. While none of these cases addressed the Seventh Amendment explicitly, they further undercut the constitutional holding below, since the Amendment unquestionably attaches to all infringement issues properly identified as "factual." See, e.g., *Walker v. New Mexico & S. Pac. R.R.*, 165 U.S. 593, 596 (1897).

In *Bischoff v. Wethered*, 76 U.S. (9 Wall) 812 (1869), a validity determination turned on whether two patents were identical. This Court held that the jury must decide that question and in so doing, of course, must interpret both

¹⁶The "Re-examination Clause" of the Seventh Amendment also prohibits the majority's approach because, as this Court has previously held, the Seventh Amendment "not only preserves the [jury trial] right but discloses a studied purpose to protect it from *indirect impairment* through possible enlargements of the power of reexamination existing under the common law, and to that end declares that 'no fact tried by a jury shall be otherwise reexamined in any court of the United States than according to the rules of the common law.'" *Baltimore & Carolina Line, Inc. v. Redmond*, 295 U.S. 654, 657 (1935) (emphasis added). See also *Capital Traction Co. v. Hof*, 174 U.S. 1 (1898). A *de novo* reexamination by the Federal Circuit is most assuredly not a reexamination according to the rules of the common law as existing in England as of 1791. See *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433 (1830).

patents. The Court endorsed the "common practice" for making such determinations: to submit to the jury expert testimony regarding "the nature of the various mechanisms or manufactures described in the different patents produced." *Id.* at 814. Moreover, while noting that courts might set aside clearly incorrect verdicts "as against the weight of evidence," this Court stressed that the question would nonetheless be treated as a question of fact for resolution by the jury, and not as a question of law for the Court:

A case may sometimes be so clear that the Court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the Court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of the evidence. But in all such cases *the questions would still be treated as a question of fact for the jury, and not as a question of law for the court.* And under this rule of practice, counsel would not have the right to require the court, as a matter of law, to pronounce upon the identity or diversity of the several inventions described in the patents produced.

Id. (emphasis added).¹⁷

¹⁷The majority attempted to distinguish *Bischoff* as a case involving "a question of invalidity in a breach of contract action." 54a. It failed to explain why, if juries interpret patents in that context, they should not also interpret patents in the context of infringement determinations. The purported distinction made by the majority between validity and infringement determinations is especially bizarre, since the Federal

(continued...)

In *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1871), this Court applied *Bischoff* in the context of a patent claim. The Court held that an existing patent and related expert testimony regarding the issue of "diversity or identity" were improperly withheld from the jury. The Court described the issue of identity as a "mixed question of law and fact," holding that "the resemblance [of the two patents] was close enough to require the submission of the question of identity to the jury, and the admission of the testimony of experts on that subject." *Id.* at 456. The Court explained that:

Whatever may be our personal opinions of the fitness of the jury as a tribunal to determine the diversity or identity in principle of mechanical instruments, it cannot be questioned that when the plaintiff, in the exercise of the option which the law gives him, brings his suit in the law in preference to the equity side of the court, that question must be submitted to the jury, if there is so much resemblance as raises the question at all. And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may on this mixed question of law and fact, lay down to the jury the law which should govern them, so as guide them to truth, and guard them against error, and may, if they

¹⁷(...continued)

Circuit has consistently held that patents must be interpreted identically for both purposes. See, e.g., *Intervet America, Inc. v. Kee-Vet Lab., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989) ("claims must be given the same construction when considering infringement as when considering validity." (emphasis in original)); *Smithkline Diagnostics*, 859 F.2d at 882 (same).

disregard instructions, set aside their verdict, the ultimate response to the question must come from the jury.

Id. at 455.

In *Heald v. Rice*, 104 U.S. 737 (1881), a validity defense turned on whether a reissued patent and an original one were identical. This Court interpreted the two patents because their language was "clear" with respect to identity. *Id.* at 749. Moreover, the Court distinguished *Bischoff* on precisely that ground: "if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art," the Court said, construction or interpretation "consequently is [a] matter of law for the court." *Id.* (emphasis added). See also *Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (patent construction presents a "matter of law for the court" where "[n]o extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject matter") (citing *Heald*); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (construing patent as a matter of law because "it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject matter") (citing *Heald* and *Market Street Cable*).

Virtually every other case cited by the majority below is a close variant of *Heald* and its progeny. For example, in *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), this Court construed as a matter of law a patent whose "language" presented "no difficulty" with respect to the interpretive question at issue. In *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858), this Court imposed as a matter of law the "only construction" of which the patent was capable. And in *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877), this Court construed as

a matter of law a patent whose "[w]ords cannot show more plainly" which interpretation was proper.¹⁸

None of these cases undercuts the Seventh Amendment protection for patent interpretation issues that a proper historical analysis establishes. As the Federal Circuit explained, extrinsic evidence cannot "enlarge, diminish or vary" the terms of a patent, but can only aid in their interpretation. 33a. Where the terms themselves are clear without resorting to extrinsic evidence, there is simply no genuine interpretive dispute for a jury to determine. In that situation, the Seventh Amendment has never prevented courts from making the relevant determination as a matter of law. See, e.g., *Galloway v. United States*, 319 U.S. 372, 388-93, *reh'g denied*, 320 U.S. 214 (1943) (Seventh Amendment does not prevent directed verdict); *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 319-21 (1902) (Seventh Amendment does not prevent summary judgment). Howev-

¹⁸The majority below cited three cases that simply do not address the question presented here. 25a. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), this Court merely stated the hornbook rule that a combination patent cannot be infringed unless the defendant duplicates every necessary element of the combination, see, e.g., A. MILLER & M. DAVIS, *INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT* 124 (2d ed. 1990), and then remanded for a factual determination of what elements were necessary to the patent at issue. *Silsby*, 55 U.S. at 225-26. *Winans v. Denmead*, 56 U.S. (15 How.) 330, 339 (1853), involved a patent for railroad cars shaped as "a frustum of a cone." The meaning of that term was undisputed, and this Court addressed only the question of how close to a perfect cone (which exists only as an abstract mathematical concept) a car must be in order to infringe. *Id.* at 343-44. *Coupe v. Royer*, 155 U.S. 565 (1895), held that a district court had erred in failing to instruct the jury that the patent at issue encompassed only a "vertical" rotary shaft — a critical but unambiguous element of the invention at issue. *Id.* at 574-75, 579-80.

er, when there is presented a genuine factual dispute concerning the interpretation of claim terms, that dispute must be left to the factfinder for resolution.¹⁹

The fallacy of the majority's reliance on the prior opinions of this Court to support its conclusion is reflected in the contradictory interpretations employed to support opposite conclusions. In *Associated Equipment Corp. v. Authorized Motor Parts Corp.*, 27 USPQ2d 1784 (Fed. Cir. 1993) (unpublished) (concurring), Judge Archer, the author of the majority opinion below, cited *Singer Mfg. Co.*, *supra*, and *Silsby*, *supra*, to support his conclusion that:

If the Court, after consulting the recognized sources of claim construction, perceived ambiguity in the claim language or terms used which it could not resolve from the documents, then expert testimony would have been necessary for this purpose. If that extrinsic testimony produced an evidentiary conflict, then of course the jury under proper instructions was required to resolve that factual question.

Associated Equipment Corp., 27 USPQ2d at 1788.

In his decision below, Judge Archer cites the *Silsby* and *Singer* cases for the exact opposite conclusion that, "[n]otwithstanding the apparent inconsistencies in our opinions, the Supreme Court has repeatedly held that the construction of

¹⁹The majority's reliance on several other cases decided by this Court is even more curious in light of the fact that these cases were bills of equity tried to the Court and in no way implicated the issue of the right to a jury trial. See *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942); *Loom Co. v. Higgins*, 105 U.S. 580 (1881); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222 (1880); *Bates v. Coe*, 98 U.S. 31 (1878); *Merrill v. Yeomans*, 94 U.S. 568 (1876); *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516 (1870).

a patent claim is a matter of law exclusively for the Court." 25a. It is difficult to understand how reliance on these prior opinions of this Court can so fundamentally change in the course of two years. The unfortunate reality is that the majority holds a policy preference against jury decision and seeks to wish away the relevant English precedent and binding precedent from this Court.

II. THE ADDITIONAL ARGUMENTS ADVANCED BELOW ARE CONSTITUTIONALLY IRRELEVANT AND UNSOUND.

The holding below ultimately rested on a series of policy-based and theoretical arguments purportedly showing that judges should interpret patents as a matter of law. These arguments cannot succeed because all relevant Seventh Amendment considerations are historical. See, e.g., *Tull*, 481 U.S. at 417-18; *Dimick*, 293 U.S. at 476. The Seventh Amendment does not permit abridging the right to jury trial because of some perceived advantage of a decision by the judge. These considerations reflect a lack of confidence in juries not shared by the framers of the Constitution and are simply not part of a proper Seventh Amendment analysis. Even if considered on their own terms, however, the secondary considerations and "policy" arguments relied on by the majority below are without merit. Moreover, the majority rule is unsound policy because its rule is unworkable and the inevitable source of confusion.

A. The Holding Below Will Not Promote Predictability Or Accuracy In The Patent Law.

The majority first asserted that judges must interpret patents in order to ensure predictability. 28a-29a. But the court failed to explain how judicial determinations would

advance that interest to any significant degree. It is unlikely that the majority's approach will realistically enhance predictability.

To begin with, the alleged principal source of unpredictability in this context -- use of live testimony or other extrinsic evidence to augment and explain the text and prosecution history -- is a settled practice that the majority opinion below embraced, 33a, and that will continue regardless of whether interpretive authority is vested in courts or juries.²⁰ Significantly, it is entirely possible that different district courts will arrive at contradictory conclusions as to the interpretation of claim terms though confronted with an identical patent in separate infringement suits. Indeed, the Federal Circuit, in *Ramos v. Boehringer Mannheim Corp.*, 1995 U.S. App. LEXIS 25870 (Fed. Cir. Sept. 8, 1995), recently held that comity is not required between district courts with respect to their construction of claim terms of an identical patent. Therefore, the sought uniformity of claim construction of a particular patent may not be achieved until the Federal Circuit conducts its *de novo* review of the district judge's claim construction and even then different panels may disagree, perhaps leading to an *en banc* reargument.

²⁰Moreover, assessment of rights under a patent can be clarified in the context of infringement determinations that turn on factual questions of patent interpretation, whether decided by judge or jury: if a plaintiff prevails under an expansive interpretation, then prospective defendants learn about a grave risk of liability; and if a plaintiff loses under a narrow interpretation, then prospective defendants may bar the plaintiff, under ordinary principles of issue preclusion, from asserting the broad interpretation in subsequent litigation. See, e.g., *Blonder-Tongue Lab., Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971).

Similarly, different panels may arrive at variant decisions for similar patents.

Thus, *de novo* review by the Federal Circuit will hardly enhance predictability on the part of the patent practitioner or those skilled in the art. In the final analysis, predictability may be more elusive by treating factual disputes as legal questions. In any event, this search for elusive enhanced predictability is a poor excuse for turning the Seventh Amendment on its head.

Second, the majority below also asserted that judicial interpretation will ensure accuracy. 28a-29a. This assertion reflects the majority's dissatisfaction with jury decisions and its confidence that the Federal Circuit can do the job better. To the extent the majority rested on the proposition that judges "trained in the law" are expert at analyzing often scientifically complex items such as the text of a patent and its "associated public record," its analysis ignores that a factual issue exists only if these materials require explanation to determine their meaning to one with ordinary skill in the art, at which point live and extrinsic testimony becomes appropriate, and even essential.

Moreover, the premise that a judge will more accurately interpret a patent is, at best, speculative. In *Laitram Corp. v. NEC Corp.*, 62 F.3d 1388, 1394-95 (Fed. Cir. 1995), decided after the Federal Circuit's decision in *Markman*, the court reversed a post-verdict judgment entered by the trial court and ordered reinstatement of the jury's verdict of infringement, holding that the court's interpretation of the

patent was erroneous while the jury had reached a correct interpretation on special interrogatories.²¹

Alternatively, to the extent the majority rested on the proposition that judges are simply better at assessing complicated trial testimony, its reasoning is inconsistent with an additional bedrock Seventh Amendment principle -- that the amendment contains no exception for complexity. *See, e.g., Slocum v. New York Life Ins. Co.*, 228 U.S. 364, 388 (1913) (applicability of the Seventh Amendment is "not a question of whether the facts are difficult or easy of ascertainment"). This Court has repeatedly rejected this notion, remarking that the sometimes "onerous nature" of the protection provided by the Seventh Amendment is "no license for contracting the rights secured by the Amendment." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 346 (1979) (Rehnquist, J. dissenting). The dubious hope for enhanced predictability and accuracy is a weak excuse for inroads on the Seventh

²¹It is puzzling why in the interest of a search for accuracy the majority simply performed radical surgery on the institution of jury trial and the Seventh Amendment without exploring other tools readily at hand to deal with the majority's apparent dissatisfaction with jury findings. Just by way of example, special interrogatories to the jury are available to focus the jury on a particular issue and to put judges in a better position to review jury verdicts for sufficiency of evidence and possible misunderstanding of the law. Similarly, instructions to the jury could be more pointed and more clear to assure that the jury is focused on the correct issue and understands its role. The practice in instructions that the less said the better should be reformed before litigants are deprived of their right to jury trial. If there is a perceived problem with jury decisions in patent cases - and petitioners doubt that there is a real problem - it should be addressed by management of the trial rather than by a frontal assault on the constitutional right to jury trial.

Amendment which in any event are blocked by the historical record and the teachings of this Court.²²

Finally, in seeking to sidestep the Seventh Amendment by characterizing patent interpretation questions as legal, the majority undermines sound policy long governing the relationship between appellate and trial court. To achieve its goal, the majority was forced to vest ultimate interpretive authority not with the various district courts, but with itself. 44a n.13 It is perhaps debatable, at least as a policy matter, whether district judges or juries are better situated to make determinations requiring an evaluation of conflicting live testimony. It is little short of absurd, however, to imagine that the Federal Circuit is better situated than are the triers of fact (whether judge or jury) to make such determinations.

Under the majority rule, the Federal Circuit weighs evidence and assess credibility and demeanor from the cold record based on briefs and a short oral argument, in contrast to the flexible trial process where time can be budgeted as appropriate and the trier sees and hears the witnesses. The majority has taken on an enormous task and created an unworkable regime for interpreting patents. *See* pages 46-49 *infra*. Thus, the majority erred badly even assuming that this case involves nothing more than a subconstitutional question about appropriate standards of review. *See, e.g., Pierce v. Underwood*, 487 U.S. 552, 560 (1988) (standard of review turns on who is "better positioned . . . to decide

²²Attempts to create a complexity exception to the Seventh Amendment have been refused. *See, e.g., United States v. Torniero*, 735 F.2d 725, 734 (2d Cir. 1984), *cert. denied*, 469 U.S. 1110 (1985); *In re U.S. Fin. Sec. Litig.*, 609 F.2d 411, 432 (9th Cir. 1979), *cert. denied*, 446 U.S. 929 (1980). *Cf. Blonder-Tongue Lab.*, 402 U.S. at 331-32 (no complexity exception to issue preclusion in patent context).

the issue in question'" (citation omitted)). Sound policy runs counter to the new rule created by the majority.

B. The Majority's Analogy To Statutory Construction Is Inappropriate.

The interpretation of disputed patent terms is clearly a factual exercise. As conceded by the majority, often the interpretation of patent terms is resolved by a resort to the testimony of competing expert witnesses about the meaning of patent terms to those of skill in the art. 12a.²³ See also, *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995) (Mayer, J. concurring). Yet, the majority disregards what is clearly a fact-finding process by invoking the generality that "[i]t has long been and continues to be a fundamental principle of American law that 'the construction of a written evidence is exclusively with the court'", 26a, notwithstanding that the Federal Circuit has itself acknowledged that where the meaning of a term in a written document is in dispute and extrinsic evidence is introduced to aid in its interpretation, the question of its meaning is a question of fact, not a question of law. See, e.g., *Bata Sys., Inc. v. United States*, 838 F.2d 1179, 1183 (Fed. Cir. 1988).

Even apart from the historical record demonstrating that interpretation of patent terms was a jury function prior to 1791, interpretation and construction of a patent, as with any written instrument, involve different phases of analysis that

²³See, e.g., *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1573 (Fed. Cir. 1993) (immunogenic polysaccharide-protein conjugates); *Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 606 (Fed. Cir.) (interferometric optical phase discrimination) cert. denied, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 668 (Fed. Cir.) (recovered liquid hydrocarbon absorbent) cert. denied, 469 U.S. 1037 (1984).

may require that certain issues be resolved by the jury. The former involves an attempt to discern the meaning of the terms and words used in a written instrument. The latter involves a determination of the legal effect of a written instrument after the meaning of its language has been adopted by the process of interpretation.²⁴

This distinction has a significant impact upon the respective roles of the jury and the trial judge.²⁵ In *Goddard v. Foster*, 84 U.S. (17 Wall) 123, 142 (1872), this Court observed that it was well-settled that written instruments are to be construed by the court *except* when they contain technical words or terms of art whose meaning depends upon extrinsic facts and circumstances, in which case the inference to be drawn must be left to the jury. Similarly, in *Great Northern Railway Co. v. Merchants Elevator Co.*, 259 U.S. 285, 291-92 (1922), this Court again stated this settled principle in an action relating to the interpretation and construction of a tariff:

[W]ords [in a written instrument] are used sometimes in a peculiar meaning. Then extrinsic evidence may be necessary to determine the meaning of words appearing in the document. This is true where technical words or phrases

²⁴See generally A. Corbin, *Corbin on Contracts* § 534; S. Williston, *Williston on Contracts* § 602; *Restatement (Second) of Contracts* § 200.

²⁵*Corbin on Contracts* § 554. See also, *Williston on Contracts* § 616 (the jury's function in the interpretation of documents will arise whenever, in view of the circumstances and usages offered in evidence, the meaning of the writing is not so clear as to preclude doubt by a reasonable man of its meaning); *Restatement (Second) of Contracts* § 212(2) (interpretation of an integrated agreement is to be determined by the trier of fact if it depends on the credibility of extrinsic evidence or a choice among reasonable inferences to be drawn from extrinsic evidence).

not commonly understood are employed. Or extrinsic evidence may be necessary to establish a usage of trade or locality which attaches provisions not expressed in the language of the instrument. Where such a situation arises, and the peculiar meaning of words, or the existence of a usage, is proved by the evidence, the function of construction is necessarily preceded by the determination of the matter of fact. Where the controversy over the writing arises in a case which is being tried before a jury, the decision of the question of fact is left to the jury, with instructions from the court as to how the document shall be construed, if the jury finds the alleged peculiar meaning or usage is established.

The majority criticizes the concurring and dissenting opinions for relying upon cases applying these principles to contracts or deeds, even though this Court has analogized patents to such documents.²⁶ Instead, the majority asserts that a better analogy for interpreting patent claims is the statutory interpretation process. But that mistaken analogy is irrelevant for Seventh Amendment purposes. Whatever the majority sees in this analogy in 1995, it was not the law in 1791. Instead, in 1791, it was clearly recognized that the appropriate analogy was to contract.²⁷ There is no hint that

²⁶See, e.g., *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (contract); *Motion Picture Patent Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (deed).

²⁷See JOHN DAVIES, *DAVIES PATENT CASES*, 434, (London 1816) ("It was said by Lord Eldon, in *Cartwright v. Amatt*, that patents are to be considered as bargains between the inventors and the public. . .). The analogy to statutory construction has, to petitioners' knowledge, never been used by the Federal Circuit prior to this appeal.

the strained analogy to statutes was ever used or considered at common law. Thus, in applying the Seventh Amendment, the analogy used in England at the time of the Bill of Rights is controlling, and ingenious analogies conjured up in the 1990's are beside the point.

Further, at best, the purported analogy between statutory construction and patent interpretation, comparing statutory text to patent claims, and legislative history to prosecution history, is very limited. 51a-52a. The analogy breaks down when those sources are unclear, for while no court would permit legislators (or experts) to present testimony about the meaning of a statute, courts routinely permit experts and inventors to testify about the meaning of a patent, as the Federal Circuit acknowledged. 12a. In that critical respect, patents are indeed more like contracts than like statutes.

Statutes are not interpreted by a trial process where evidence is weighed and credibility and demeanor evaluated; that is an important reason why statutes can be interpreted by an appellate court as well as a district court judge. The process of weighing evidence and evaluating credibility is the method for resolving disputes of facts.²⁸ It turns jurisprudence on its head to characterize that process as the way to

²⁸After the holding below, a district judge, in struggling with the near impossible task of complying with it, emphasized: "When two experts testify differently as to the meaning of a technical term, and the court embraces the view of one, the other, or neither while construing a patent claim as a matter of law, the court has engaged in weighing evidence and making credibility determinations." *Lucas Aero., Ltd. v. Unison Indus., L.P.*, 1995 U.S. Dist. LEXIS 8414 at *8 n.7 (D. Del. June 2, 1995). When evidence is weighed and credibility is evaluated, the judge is resolving a factual dispute, not deciding an issue of law. The substance of the inquiry must control.

decide a question of law. This settled method for finding facts cannot be magically transformed into an issue of law by simply saying so. A change of label cannot change the substance. In jury trials, finding of facts on the merits is for the jury as mandated by the Seventh Amendment.

C. The Federal Circuit's Decision Will Disrupt Settled Areas Of Patent Law.

In addition to being constitutionally infirm and unsupported by the alleged policy justifications underlying its decision, the unworkable majority opinion has and will continue to result in the disruption of other settled areas of the law. Both the Federal Circuit and district courts, subsequent to the majority opinion, have struggled to follow principles that are illogical, unrealistic and impossible in application. The inevitable has resulted: confusion and constitutional error abound.

As a result of its self-proclaimed superiority in deciding issues of claim construction, the Federal Circuit in recent opinions has decided such factual questions without either the benefit of a prior district court decision or the development of an evidentiary record sufficient to make this determination. In *Mason v. Tampa G Mfg. Co.*, 1995 U.S. App. LEXIS 28368 (Fed. Cir. Oct. 12, 1995), the district court granted summary judgment on the erroneous basis that the alleged infringer had obtained a patent on its accused product and, consequently, could not infringe the plaintiff's patent. On appeal, the Federal Circuit acknowledged the error of law committed by the district court but nonetheless affirmed its decision on the basis that its *de novo* claim construction yielded a result of no infringement. There is no indication that the district court ever construed the disputed claim terms, and more importantly, there is nothing in the Federal

Circuit opinion to suggest that the parties had the opportunity to submit evidence (for example, expert testimony) in support of their respective positions on the disputed construction issue. Nonetheless, the Federal Circuit, sitting *de facto* as a trial court and without a full evidentiary record, saw fit to construe the claims and render a final decision of no infringement.²⁹

This approach is a radical departure from our law and notions of fairness. It obliterates the well-defined roles of the judge, jury and appellate court and denies litigants a fair trial. See also, *Regent Lighting Corp. v. FL Industries, Inc.*, 60 F.3d 840 (Fed. Cir. 1995) (in reviewing a bench trial, a panel of the Federal Circuit not only reinterpreted the patent claims *de novo*, but also held the patent invalid on the basis of obviousness by both deciding factual issues underlying obviousness in light of the reinterpreted claims and evaluating prior art not considered by the district judge).

Thus, the implication of *Markman* goes well beyond claim interpretation. It is an invitation and a springboard for the Federal Circuit to ignore important distinctions between fact and law and between trial courts and appellate courts and decide issues that are reserved for the trial judge or jury. The decision in *Markman* changes the landscape in patent

²⁹As the dissenting opinion of Judge Rader explains:

This court properly notes the district court's error, but then proceeds to act as a trial court and examined the summary judgment motion, rather than review the district court's decision for reversible error. Without the guidance, the context, or the full record available to the trial court, this court overlooks genuine issues of fact in its rush to reach summary judgment.

Id. at *15.

infringement litigation beyond the issue of claim construction, as critical as that is.³⁰

The majority opinion has also created confusion among the district courts regarding the permissible evidentiary basis for resolving disputed issues of claim construction. The contrasting approaches taken by two recent district court judges confronted with this issue demonstrates the confusion being created by the decision of the majority below.

In *Lucas Aero., Ltd. v. Unison Indus., L.P.*, 1995 U.S. District LEXIS 8414 (D. Del. June 2, 1995), the district court was confronted with competing expert testimony on the issue of claim construction. The court read the majority opinion below as precluding it from making credibility determinations en route to construing the claim language. The trial judge, frustrated at being forced to treat a factual inquiry involving credibility as a question of law, pointedly said: "[b]ut when the Federal Circuit Court of Appeals states that the trial court does not do something [weighing evidence and making credibility determinations] that the trial court does and must do to perform the judicial function, that court knowingly enters a land of sophistry and fiction." *Id.* at *8 n. 7. The court went on to make clear that "bound by slavish adherence to the fiction that a judge does not make credibility determinations when confronted with testimonial extrinsic evidence en route to pronouncing the 'true' meaning of the patent claim," his opinion was crafted so to omit reference

³⁰The majority's approach cannot be limited on principle to patent cases. If it prevails, the right to jury trial in civil cases will be in jeopardy in many contexts and the primacy of the 1791 English practice will be undermined.

to necessary and inevitable "credibility assessments" which he had made. *Id.*

The district judge's approach in *Lucas* should be contrasted with the approach taken by the district judge in *Elf Atochem North America, Inc. v. Libbey-Owens-Ford Co.*, 891 F. Supp. 844 (D. Del. 1995), where the district judge laid out in detail the factors which he was considering in making credibility assessments. During an evidentiary hearing (designated as a "Markman trial") the judge heard evidence from competing technical expert witnesses who testified in support of the respective positions of the parties as to the meaning of terms used in the claims. In weighing the competing evidence of these experts and deciding which to adopt, the judge considered credibility issues such as their educational backgrounds; the number and nature of the publications authored by them in the relevant field of technology; their employment backgrounds; the amount of experience each had in the technological field; the number of patents each held; awards received by them; and the amount of compensation received from the parties. *Id.* at 850-862.

The contrasting approaches adopted by these district judges demonstrates the confusion engendered by the majority opinion. The rule imposed by the majority below is not only unconstitutional -- it is unworkable and mischievous policy.

CONCLUSION

For the reasons set forth herein, petitioners respectfully urge this Court to reverse the decision of the United States Court of Appeals for the Federal Circuit and remand for further proceedings before the Court of Appeals or the district court in accordance with the decision of this Court.

Dated: November 9, 1995

Respectfully submitted,

Of Counsel

Lewis F. Gould, Jr.
Stephan P. Gribok
Eckert Seamans Cherin
& Mellott
1700 Market Street
Suite 3232
Philadelphia, PA 19103

William B. Mallin
Counsel of Record
Timothy P. Ryan
Timothy S. Coon
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

26

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

BRIEF OF RESPONDENTS

FRANK H. GRIFFIN, III
Counsel of Record

PETER A. VOGT
POLLY M. SHAFFER
GOLLATZ, GRIFFIN & EWING, P.C.
Two Penn Center Plaza
Sixteenth Floor
Philadelphia, PA 19102
(215) 563-9400

*Attorneys for Respondents
Westview Instruments, Inc. and
Althon Enterprises, Inc.*

62 p

QUESTION PRESENTED

In a patent infringement case tried to a jury, does the court have the power and obligation to construe as a matter of law the meaning of language used in the patent claim when either (a) that meaning is discernable from the patent documents or (b) extrinsic evidence is necessary as an aid to construction?

LIST OF PARTIES PURSUANT TO RULES 24.1(b) AND 29.1

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief of Respondents.

Neither Respondent Westview Instruments, Inc. nor Respondent Althon Enterprises, Inc. has any parent companies or subsidiaries.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED.....	i
LIST OF PARTIES PURSUANT TO RULES 24.1(b) AND 29.1.....	ii
TABLE OF AUTHORITIES.....	v
CONSTITUTIONAL AND STATUTORY PROVI- SIONS.....	1
STATEMENT OF THE CASE	2
SUMMARY OF ARGUMENT	16
ARGUMENT	18
A. The Trial Judge Properly Construed The Petition- ers' Patent Claims As A Matter Of Law	18
B. The Seventh Amendment Does Not Prohibit A Judge From Interpreting Patent Claims As A Mat- ter Of Law	22
1. Cases Dealing With The Distinction Between Law And Equity Are Not Helpful In Distinguish- ing Between Issues Of Law And Issues Of Fact .	23
2. The Case Law Concerning The Roles Of Judge And Jury In A Jury Trial Teaches That The Seventh Amendment Preserves The Essence Of The Jury Right, Not Matters Of Form And Procedure.....	27
3. To The Extent That The Historical Record Is Per- tinent, It Supports The Proposition That Judges, Not Juries, Construe Claim Language	31
C. The Consideration Of Extrinsic Evidence Does Not Change An Issue Of Law To An Issue Of Fact....	36
1. This Court Has Consistently Held That Claim Construction Is A Matter Of Law Even Where Extrinsic Evidence Is Used As An Aid To Con- struction	36

TABLE OF CONTENTS—(Continued)

	Page
2. The Use Of Extrinsic Evidence In The Interpretation Of Documents Other Than Patents Does Not Transform The Issue From One Of Law To One Of Fact	41
D. The Federal Circuit's Decision Advances Patent Law Policies	43
1. The Construction Of Patent Claims As A Matter Of Law Promotes Specific And Clear Claims And Consistent Interpretation	43
2. Adoption Of Petitioners' Argument Would Result In Serious Limitations On Procedures And The Evolution Of Law	46
CONCLUSION	48
APPENDIX	
35 U.S.C. § 112	1a

TABLE OF AUTHORITIES

Cases:	Page
<i>Advanced Cardiovascular Sys. v. Scimed Sys.</i> , 887 F.2d 1070 (Fed. Cir. 1989)	22
<i>American Permahedge, Inc. v. Barcana, Inc.</i> , 1995 U.S. Dist. LEXIS 15838 (S.D.N.Y. 1995)	44
<i>Arkwright v. Nightingale</i> , Davies Pat. Cas. 38 (Common Pleas 1785)	35
<i>Atlas Powder Co. v. E. I. DuPont de Nemours & Co.</i> , 750 F.2d 1569 (Fed. Cir. 1894)	43
<i>Automatic Pencil Sharpener Co. v. Boston Pencil Pointer Co.</i> , 279 F. 40 (1st Cir. 1992), <i>cert. denied</i> , 260 U.S. 728 (1922)	20
<i>Baltimore & Carolina Line v. Redman</i> , 295 U.S. 654 (1935)	27, 30
<i>Bausch & Lomb, Inc. v. Barnes-Hind/Hydrochrome</i> , 796 F.2d 443 (Fed. Cir. 1986), <i>cert. denied</i> , 404 U.S. 823 (1987)	20
<i>Bischoff v. Wethered</i> , 76 U.S. 812 (1870)	40
<i>Bose Corp. v. Consumers Union of United States, Inc.</i> , 466 U.S. 485 (1984)	46
<i>Bovill v. Moore</i> , Davies Pat. Cas. 320 (Common Pleas 1816)	35
<i>Brooks v. Steele</i> , 14 R.P.C. 73 (1896)	36
<i>Brothers v. Lidgewood Mfg. Co.</i> , 223 F. 359 (2d Cir. 1915)	20
<i>Capital Traction Co. v. Hof</i> , 174 U.S. 1 (1899)	31
<i>Century Wrecker Corp. v. E.R. Buske Mfg. Co., Inc.</i> , 898 F. Supp. 1334 (N.D. Iowa 1995)	44
<i>Choctaw Nation of Indians v. United States</i> , 318 U.S. 423 (1943)	41

TABLE OF AUTHORITIES—(Continued)

Cases:	Page
<i>Cold Metal Process Co. v. E.W. Bliss Co.</i> , 285 F.2d 231 (6th Cir. 1960), <i>cert. denied</i> , 366 U.S. 911 (1961)	20
<i>Colgrove v. Battin</i> , 413 U.S. 149 (1973)	24
<i>Collins v. Sawrey</i> , 4 Bro. P.C. 692 (H.L. 1772)	35
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	20, 37
<i>Dagnello v. Long Island R.R. Co.</i> , 289 F.2d 797 (2d Cir. 1961)	29
<i>Dakota Nat'l. Bank & Trust Co. v. First Nat'l Bank Trust Co.</i> , 554 F.2d 345 (8th Cir. 1977), <i>cert. denied</i> , 434 U.S. 877 (1977)	42
<i>Damsky v. Zavatt</i> , 289 F.2d 46 (2d Cir. 1961)	27
<i>Daubert v. Merrill Dow/Pharmaceuticals</i> , 113 S. Ct. 2786 (1993)	46
<i>Del Francia v. St-Anthony Corp.</i> , 278 F.2d 745 (9th Cir. 1960)	20
<i>Devex Corp. v. General Motors Corp.</i> , 667 F.2d 347 (3d Cir. 1981), <i>aff'd</i> , 461 U.S. 648 (1983)	20
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	26, 27
<i>Driggins v. Okla. City</i> , 954 F.2d 1511 (10th Cir. 1991), <i>cert. denied</i> , 113 S. Ct. 129 (1992)	36
<i>Earle v. Sawyer</i> , 4 Mason 1 (C.C.D. Mass. 1825)	20, 39
<i>Edward Lowe Indus., Inc. v. Oil-DRI Corp. of Am.</i> , 1995 U.S. Dist. LEXIS 15790 (N.D. Ill. 1995)	44
<i>Ex parte Fressola</i> , 1993 Pat. App. LEXIS 3 (Bd. Pat. App. & Interferences)	32
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942)	20
<i>Fleitman v. Welsbach St. Lighting Co. of Am.</i> , 240 U.S. 27 (1916)	26

TABLE OF AUTHORITIES—(Continued)

Cases:	Page
<i>Galloway v. United States</i> , 319 U.S. 372 (1943)	28
<i>General Elec. Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938)	45
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	43
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	26
<i>Harrison v. Anderson Foundry Co.</i> , 1 App. Cas. 581 (1874)	36
<i>Heald v. Rice</i> , 104 U.S. 737 (1882)	20, 38, 40
<i>Herron v. Southern Pacific Co.</i> , 283 U.S. 91 (1931)	31
<i>Hilton Davis Chem. Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995)	43
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	20, 39
<i>Hornblower v. Boulton</i> , 8 T. R. 95 (K. B. 1799)	35
<i>Huddart v. Grinshaw</i> , Davies Pat. Cas. 200 (K.B. 1803) . .	35
<i>In re Peterson</i> , 253 U.S. 300 (1920)	27, 28, 30
<i>Intellicall, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384 (Fed. Cir. 1992)	21
<i>Jacob v. City of New York</i> , 315 U.S. 752 (1942)	27
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	20, 38
<i>Kohn v. Eimer</i> , 265 F. 900 (2d Cir. 1920)	21
<i>Liardet v. Johnson</i> , (K.B. 1778)	34, 35
<i>Liverpool & G.W. Steam Co. v. Phoenix Ins. Co.</i> , 129 U.S. 397 (1889)	46
<i>Looms v. Higgins</i> , 105 U.S. 580 (1882)	20, 38, 39
<i>Lucas Aerospace, Ltd. v. Unison Indus., L.P.</i> , 890 F. Supp. 329 (D. Del. 1995)	44

TABLE OF AUTHORITIES—(Continued)

Cases:	Page
<i>Macbeath v. Haldimand</i> , 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786)	34
<i>Market St. Cable Ry. Co. v. Rowley</i> , 155 U.S. 621 (1895).....	20, 38, 40
<i>Markman v. Westview</i> , 52 F.3d 967 (Fed. Cir. 1995).....	13
<i>Mayor of Kingston Upon Hull v. Horner</i> , 1 Cowp. 102 (K.B. 1774)	35
<i>Mellon Bank, N.A. v. Aetna Business Credit</i> , 619 F.2d 1001 (3d Cir. 1980)	43
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1877)	43
<i>Miller v. Fenton</i> , 474 U.S. 104 (1985).....	46
<i>Neilson v. Harford</i> , 8 M. & W. 806 (Exch. Pleas 1841)...	35
<i>Nichols v. Universal Pictures Corp.</i> , 45 F.2d 119 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931)	21
<i>Nutrition 21 v. United States</i> , 930 F.2d 867 (Fed. Cir. 1991).....	21, 22
<i>Order of Ry. Conductors v. Swan</i> , 329 U.S. 520 (1947).....	41, 42
<i>Overseas Dev. Disc Corp. v. Sangamo Constr. Co.</i> , 840 F.2d 1319 (7th Cir. 1988).....	41, 46
<i>Pernell v. Southall Realty</i> , 416 U.S. 363 (1974).....	26
<i>Pullman-Standard v. Swint</i> , 456 U.S. 273 (1982).....	46
<i>Read Corp. v. Portec</i> , 970 F.2d 816 (Fed. Cir. 1992).....	20
<i>Rolite, Inc. v. Wheelabrator Technologies, Inc.</i> , 1995 U.S. Dist. LEXIS 16453 (E.D. Pa. 1995)	44
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970).....	26
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853).....	20, 37
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904).....	20, 38, 40

TABLE OF AUTHORITIES—(Continued)

Cases:	Page
<i>Smith v. Snow</i> , 294 U.S. 1 (1935)	20
<i>Solomon v. Renstrom</i> , 150 F.2d 805 (8th Cir. 1945)	20
<i>SSIH Equip., S.A. v. United States Int'l Trade Comm'n</i> , 718 F.2d 365 (Fed. Cir. 1983).....	20
<i>Tucker v. Spalding</i> , 80 U.S. 453 (1871)	40
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	34, 35
<i>Turrill v. Michigan So. & Northern Indiana R.R. Co.</i> , 68 U.S. 491 (1864).....	20
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	26
<i>Twining v. New Jersey</i> , 211 U.S. 78 (1908)	28
<i>United States v. Peterson</i> , 812 F.2d 486 (9th Cir. 1987) ...	46
<i>United States v. Reader's Digest Ass'n</i> , 662 F.2d 955 (3d Cir. 1891), cert. denied, 455 U.S. 908 (1982)	41
<i>United States v. Weitzenhoff</i> , 1 F.3d 1523 (9th Cir. 1993) .	41
<i>United States v. Wonson</i> , 28 F. Cas. 745 (C.C.D. Mass. 1812).....	25, 26
<i>U.S. Envtl. Prods., Inc. v. Westall</i> , 911 F.2d 713 (Fed. Cir. 1990)	43
<i>Walker v. New Mexico R.R. Co.</i> , 165 U.S. 593 (1897)	27
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854).....	20, 37, 39
<i>Winans v. New York and Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1859).....	20, 21, 39, 40
Statutes:	
35 U.S.C. § 112.....	passim, 1a
Act of 1870, ch. 230, Sec. 26, 16 Stat. 198 (July 8, 1870) .	32
Fed. R. Civ. P. 44.1.....	46

TABLE OF AUTHORITIES—(Continued)

<i>Statutes:</i>	Page
Fed. R. Civ. P. 50	10, 48
U.S. Const. Amend. VII	passim
<i>Legislative History:</i>	
H.R. No. 97-312, 97th Cong., 1st Sess.....	43
<i>Publications:</i>	
Thomas Brett, <i>Commentaries on the Present Laws of England</i> (1890)	36
F. Buller, <i>An Introduction to the Law Relative to Trials at Nisi Prius</i> (6th Ed. 1791)	34
A. Deller, <i>Patent Claims</i> (2d ed. 1971)	32
Patrick Devlin, <i>Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment</i> , 80 Colum. L. Rev. 43 (1980).....	29, 30, 33
J. Dienger, <i>Claims of Patents</i> , 18 J. Pat. Off. Soc. 389 (1936).....	32, 33
R. Ellis, <i>Patent Claims</i> (1949)	32
Edith G. Henderson, <i>The Background of the Seventh Amendment</i> , 80 Harv. L. Rev. 289 (1966)	24, 25, 30
W. S. Holdsworth, <i>History of English Law</i> (1938).....	32
Fleming James, Jr., <i>Right to a Jury Trial in Civil Actions</i> , 72 Yale L.J. 655 (1963)	26, 29
Kenneth S. Klein, <i>The Myth of How to Interpret the Seventh Amendment Right to a Civil Jury Trial</i> , 53 Ohio St. L.J. 1005 (1992)	24, 25, 26, 29
J. Oldham, <i>The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century</i> (1992).....	34
Martin H. Redish, <i>Seventh Amendment Right to Jury Trial: A Study in the Irrationality of Rational Decision Making</i> , 70 N.W.L. Rev. 486 (1975).....	27

TABLE OF AUTHORITIES—(Continued)

<i>Publications:</i>	Page
Austin W. Scott, <i>Trial by Jury and the Reform of Civil Procedure</i> , 21 Harv. L. Rev. 669 (1918)	28
Arthur H. Seidel, et al., <i>What the General Practitioner Should Know About Patent Law and Practice</i> (5th ed. 1993)	45
Henry Slocum, <i>New Trials and the Seventh Amendment</i> , 8 U. Ill. L. Rev. 292 (1913)	25
James B. Thayer, "Law and Fact" in <i>Jury Trials</i> , 4 Harv. L. Rev. 170 (1890)	29, 30
Albert Walker, <i>Textbook of the Patent Law of the United States of America</i> (3d ed. 1895).....	40
Stephen Weiner, <i>The Civil Jury Trial and the Law-Fact Distinction</i> , 54 Calif. L. Rev. 1867 (1966)	33
Charles W. Wolfram, <i>The Constitutional History of the Seventh Amendment</i> , 57 Minn. L. Rev. 639 (1973).....	23, 24, 26

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

BRIEF OF RESPONDENTS

**Constitutional and Statutory
Provisions Involved**

U.S. CONST. AMEND. VII provides:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall otherwise be re-examined in any Court of the United States, than according to the rules of the common law.

35 U.S.C. §112.

The full text of 35 U.S.C. §112 is reprinted in full in an appendix to the Brief of Respondent.

STATEMENT OF THE CASE

Nature of the Case

This is a patent infringement case that raised no issues of fact for the jury. The Petitioner's patent, described more fully below, claims a system that utilizes bar codes to track clothes or other articles in a dry cleaning establishment to allow the detection of lost, stolen or added *articles*. The Respondent's system prints bar-coded invoices, thereby allowing the detection of missing or extra *invoices*. At trial, the facts concerning the capabilities of the accused system were undisputed. The only question was whether the language of the claims could be read to cover the accused system. That language was not complex, scientific or technical. A typical issue was whether the word "inventory" meant "articles of clothing," or "cash," or "invoices." The only witness who attempted to interpret the claim language was Petitioners' expert — a patent lawyer with no skill in the dry cleaning art — whose legal conclusions were rejected by the court.

The trial court determined the meaning of the patent claims as a matter of law from the patent documents. Since no factual dispute remained, the trial court granted Respondents' Motion for Directed Verdict. The trial court's ruling was unremarkable and consistent with both standard federal practice and the requirements of the Seventh Amendment. The United States Court of Appeals for the Federal Circuit affirmed the trial court's judgment and reaffirmed the longstanding proposition that construction of patent claims is an issue of law for the court.

The heart of Petitioners' attack on the Federal Circuit's decision is their argument that the Seventh Amendment mandates that any resort to extrinsic evidence, such as expert testimony, turns claim interpretation from an issue of law to an issue of fact. The Federal Circuit ruled that neither logic nor precedent supported Petitioners' argument that the Seventh Amendment prohibits claim interpretation as a matter of law.

1. The Patent-in-Suit. The patent at issue is United States Reissue Patent No. 33, 054, which claims an inventory control

and reporting system, primarily for use in dry cleaning stores. The system enables the dry cleaner to identify, calculate and process costs of laundry articles to be cleaned, to print bar-coded records and tags for attachment to the laundry articles, to scan bar-coded tags on articles so as to monitor their location, and to generate reports based upon the information contained in the records and obtained by the scanner or scanners. J.A. 293-301. As summarized in the patent's specification, the dry cleaning process involves intermingling large numbers of clothes from different customers in one dry cleaning machine. J.A. 296, col. 1, ln. 42-45. Each article of clothing is labelled with an article tag bearing a unique, sequential number. J.A. 296, col. 2, ln. 5-9. The tags are used so that the customer's clothes can be reassembled in one batch after dry cleaning. J.A. 300, col. 9, ln. 41-46. The article tag numbers are also printed on the customer's invoice. J.A. 294, Fig. 2. Once the clothes are cleaned, individual articles are regrouped into the customer's original batch by matching the numbers on the article tags with the numbers on the invoice.

2. Prosecution History. The initial patent application was rejected for obviousness. J.A. 308-309. The original patent was issued only after amended claims were submitted to distinguish its claims over the prior art. J.A. 310-318. The amendments contain limiting language that defines the boundaries of the invention and distinguishes the patent from Respondent Westview's system. Amended claim 1 is reproduced below. Language deleted from the original claim 1 is in brackets and language added to the original claim 1 is italicized.

1. An inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, *each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said [a plurality of] articles associated with the transactions [a transaction];*

a data processor including memory operable to record said information *and means to maintain an inventory total,*

said data processor having means to associate sequential transactions with unique *sequential* indicia and to generate at least one report of *said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another*; [and,]

a *dot matrix* printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record *including* [comprising a plurality of] optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed *only* in coincidence with each said transaction and at least part of the written record bearing a portion to be *attached to* [directly associated with] said articles; *and*,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

J.A. 308-309.

After issuance of the original patent, Petitioner Markman applied for a reissue patent in which he sought to broaden the patent by adding two new claims. In the reissue application, Markman stated that the original patent was invalid because he had claimed less than he had a right to claim. J.A. 319-320. The patent examiner at first rejected the reissue application. J.A. 2292-93. Upon reconsideration, the patent examiner issued United States Reissue Patent No. 33,054, which retained all of the original claims and added two new claims, 14 and 15. J.A. 293-301. The two new claims broadened the original patent. For example, Claim 14 of the reissue patent did not require a dot matrix printer, did not require descriptions of each article to be encoded and did not require the data processor to be connected to the optical scanner.¹

1. As explained in Respondents' Brief in Opposition to the Petition for

3. The Purpose of the Invention Defined by the Patent.

The patent defines an invention intended to prevent the loss or theft of clothes or the processing of undocumented clothes. Markman's remarks to the patent examiner describe the problem that his patent was meant to solve:

As described in the specification, some basic difficulties with retail dry cleaning establishments relate to the fact that attendants sometimes process undocumented articles through the system and pocket the proceeds. Another difficulty is that the loss, misplacement or separation in process of even a single article of even relatively minor value will have a major impact on the customer's estimation of the quality of the establishment.

J.A. 314-315.

To curtail the processing of undocumented articles and the loss or theft of even a single item of clothing, Markman's system, as defined by the patent, tracks articles of clothing through the dry cleaning process. The tracking of articles is accomplished by printing bar-coded article tags, attaching the tags to articles of clothing and scanning them at predetermined stations.

The function and purpose of the patent is apparent on its face. The patent specification describes Markman's invention as relating to "inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in the establishment." J.A. 296, col. 1, ln. 12-15. The last paragraph of claim 1 explains that "said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom." J.A. 301, col. 11, ln. 9-11. The additions or deletions are discovered by the scanning of "bar codes on all articles passing a predetermined station." J.A. 301, col. 11, ln. 7-8. The specification summarizes the function of the invention, stating that "the progress of articles through the laundry

Certiorari, the Patent and Trademark Office issued a final rejection of the patent in this case on July 26, 1994, after the *in banc* hearing before the Federal Circuit. The rejection was the result of numerous challenges on the basis of prior art. A decision is pending from the Board of Patent Appeals and Interferences on the appeal of the final rejection.

and dry cleaning system can be completely monitored." J.A. 296, col. 2, ln. 55-56. The claims and specification make it clear that the patent claims a system which has the ability to track individual articles of clothing through the dry cleaning process, to detect and localize missing and additional articles of clothing and to generate reports about the status and location of the individual articles of clothing.²

4. The Accused System. The accused system was invented and manufactured by Respondent Westview Instruments, Inc. for use in the dry cleaning business.³ The facts about the accused system are not in dispute. The accused system consists of two units, the DATAMARK and the DATASCAN. J.A. 307. The DATAMARK prints bar coded invoices that contain information about the customer, the clothes to be cleaned and charges for cleaning. J.A. 307. The DATAMARK stores in memory only the invoice number and the invoice cash total. J.A. 303. The DATASCAN is a portable bar code reader containing a microprocessor used to read bar codes on invoices wherever they are located. J.A. 204. After the invoice list is transferred from the DATAMARK to the DATASCAN, the

2. The inventor's application for the reissue patent further emphasized that the claimed patent tracks articles:

The limitations which render the claims unnecessarily narrow over all known prior art, are:

1. Tracking of individual articles.

It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing brought by a single customer to a drycleaning establishment or the like The claim language recites entry of "descriptions of each of said articles associated with the trans-actions." This passage is more limited than I had a right to claim because, although individual articles, e.g. a pair of pants, could be accounted for by marking, scanning and reconciliation in reports, the grouping of such articles into sets for tracking is reasonably disclosed as forming part of the invention and is allowable over the prior art.

J.A. 320-21.

While claim 14 was expanded to include the tracking of groups of articles rather than individual articles, the focus of the invention remained on the tracking of articles, not invoices.

3. Respondent Althon Enterprises is a drycleaner that purchased the accused system.

DATASCAN is carried through the store, reading bar codes on invoices wherever they are found. J.A. 204, 303. The DATASCAN will then report any discrepancy between the list of invoice numbers it has received from the DATAMARK and the numbers of the invoices that it has actually read. J.A. 303. In this way, the accused system detects extra or missing invoices. It cannot localize where those additions or deletions occurred because DATASCAN is portable and does not operate at a fixed, predetermined station. J.A. 204. While the accused system can compute the cash total, it has no ability to generate a report in which the article descriptions and the invoice numbers are reconcilable against one another. J.A. 303. The invoice itself is the only document the Westview system prints that contains article descriptions. J.A. 912.

The accused system does not track articles of clothing individually or in batches. To track such articles, the DATAMARK would also have to print bar-coded tags for attachment to them. It does not. J.A. 219. The only bar-coded document that the DATAMARK prints is the invoice. Similarly, the DATAMARK stores the invoice numbers in memory but does not retain descriptions of individual articles of clothing. J.A. 208-209. Since the DATAMARK does not tag individual articles or retain information about them, it cannot detect or locate deletions or additions of articles as they pass through the dry cleaning process. J.A. 204.

5. Procedural History. Before trial, Respondents moved for summary judgment on the question of infringement on the grounds there was no genuine factual dispute about the accused device and Respondent were entitled to judgment in their favor upon the proper legal interpretation of the claims. The trial court denied the motion. After Respondents moved for reconsideration, the court issued an order stating, "There is a genuine issue of material fact as to whether defendant's product stores in memory individual articles. Compare Jenkins Dep. p. 108 (Exh. B Motion) with operator's manual P.6 attached" J.A. 292. The judge did not identify any trial issue, legal or factual, with respect to the meaning of the patent.

The sole fact issue identified by the trial court concerned the accused system's ability to store article descriptions in memory. Petitioners, to create an apparent fact dispute, had pointed to a statement in the DATAMARK operator's manual that data, including article descriptions, was "saved in DATAMARK memory and printed on the laundry/dry cleaning ticket." While that statement was literally true, the article descriptions are erased from the limited DATAMARK memory once the ticket is printed. Article descriptions are "saved" only for the moment between when they are entered and when the ticket is printed.

Evidence at trial about the capabilities of the accused device was neither sophisticated nor voluminous. In fact, the presentation of all of the evidence took less than two trial days.

Petitioners' first witness was Mr. Mikula, an expert on bar codes who had studied and operated the accused system. He admitted that once the invoice was printed, Westview's system did not store individual article descriptions in memory, and did not track articles of clothing. J.A. 36-38. Thus, there was no dispute about the capabilities of the accused device.⁴

The rest of the trial consisted of Petitioners' efforts to interpret the language of the patent so that the claims would encompass the accused system. Since Westview's system does not identify extra or missing clothing, does not generate any reports about articles and does not maintain an inventory total, Petitioners argued that inventory did not mean clothes. Their expert witness on claim interpretation, Mr. Chovanes, was a patent lawyer who had no skill in the dry cleaning art. Nevertheless, in Petitioners' words, he "interpreted the claims of the patent and testified on how the claims of the patent read on the accused system."⁵ Pet. Br. 5. The lawyer's testi-

4. After this admission, and in the middle of Respondents' cross-examination of Mr. Mikula, the trial judge decided *sua sponte* to bifurcate the trial, planning to try the question of infringement first and issues of validity second. J.A. 42-44. Westview had moved before trial for such a bifurcation and its motion had been denied.

5. Mr. Chovanes' testimony consisted of legal conclusion supported by a fair amount of doubletalk. For example:

mony was that spurious additions or deletions to "inventory" are spurious deletions and additions to invoices. J.A. 73-74. He redefined the "report" that reconciles article descriptions against invoice numbers as an invoice. J.A. 71. He argued that the "tag" attached to the articles is an invoice. J.A. 128-193.

Mr. Chovanes' claim interpretation was contradicted by the documentary record, which established that inventory meant articles of clothing.⁶ The patent documents also demonstrated that the invoice, tags and the report are each separate documents.⁷

Q: Is it your testimony here today that this patent does not require the system to be able to keep track of individual articles of clothing?

A: Well, again, that question has to be answered this way. It does keep on the tickets which are then attached — which are to be attached and are attached to the batches, to the articles as called for in the claims, it does keep track. You can reconcile all the items on that and through the total, and through the invoice number the total and invoice number are back in the "Datamarx," you can reconcile the whole works where, as they say themselves, whereby missing and extra you can find out where they are so you are in that sense if a person comes in and you do all those things and so forth, you are keeping — you are reconciling with the invoice number the articles and with the actual inventory of articles out on line so the claim, what the claim calls for is what I have gone over there in great detail and that's all present, that's the test of infringement. Are the elements of the claim or their equivalent present in the accused structure and we've shown how they are or I have tried to show how they are.

J.A. 97-98.

6. The patent specification makes it certain that "inventory" means articles of clothing, as the following examples reveal:

"[A] basic function of inventory control is the counting of incoming and outgoing materials" J.A. 296, col. 1, ln. 19-20.

"The identity of specific articles must be monitored, making inventory control somewhat more complicated" J.A. 296, col. 1, ln. 21-23.

"[A] problem which appears to occur randomly in the inventory (e.g., damage to garments)" J.A. 298, col. 5, ln. 59.

"[I]ncoming articles to be placed in inventory are accumulated over a counter. . ." J.A. 298, col. 6, ln. 8.

"[I]ndividual article tags may be attached to items in inventory" J.A. 299, col. 8, ln. 9-10.

Additional examples are found in the Federal Circuit's opinion at 37a-38a. See also Petitioner Markman's remarks in support of the amended patent at J.A. 314.

7. For example, the specification distinguishes between tags and reports, stating: "the bar code tags are attached to articles of clothing and

The patentee, Mr. Markman, testified at trial. Petitioners objected to Respondents' cross-examination of Mr. Markman about the meaning of his claim on the basis that Markman was not a "patent expert." J.A. 169. Mr. Markman protested repeatedly that he could not interpret the language because he was not a patent attorney; he knew only how the patent was "implemented at his company" and stated that "I get as messed up in this language as anybody." J.A. 174.

Respondents moved for a directed verdict at the close of Petitioners' case because the question of claim interpretation was determinable as a matter of law, and because there was not even an arguable factual dispute over the accused system. The trial judge deferred ruling on the motion in accordance with Rule 50 of the Federal Rules of Civil Procedure.⁸

Respondents did not call any witnesses to testify about the meaning of the claims because their meaning was readily discernable from the patent specification and prosecution history. Their only witness was Mr. James Jenkins, Westview's president, who explained and then demonstrated how the accused system worked.

On cross-examination, Petitioners elicited testimony about the meaning of "inventory" when used by Mr. Jenkins to describe the capabilities of the accused system. Mr. Jenkins

NOTES (Continued)

are used with the scanning apparatus to facilitate generation of reports according to various management needs." J.A. 293. The patent-in-suit also refers to "bar code records and tags," thereby differentiating tags from invoices. J.A. 293. Additionally, Figure 2 of the specification, J.A. 294, clearly shows a multiple part record that includes an invoice (numbered 46 and referred to in the specification as "an establishment ticket copy" at J.A. 299, col. 7, ln. 44-45) and detachable tags (numbered 48 and referred to in the specification as "article tags" at J.A. 299, col. 7, ln. 46). Finally, the specification states that the optical scanning station is used to reconcile inventory articles. J.A. 300, col. 9, ln. 57-59. Inventory articles can be reconciled at an optical scanning station by reading tags attached to the articles. However, reading just invoices with an optical scanner does not reconcile articles because it does not divulge any article-specific information.

8. The practice of deferring a ruling on a Rule 50 motion is encouraged in the Advisory Committee Notes to that rule. Fed. R. Civ. P. 50 advisory committee note, 1991 Amendment subdivision (b).

testified that a dry cleaner was concerned about two kinds of inventory, both "cash" and "articles of clothing." He explained that the Westview system was designed to look after cash. J.A. 212. Mr. Jenkins was not asked to testify about what the claim language meant to him as one skilled in the art. Rather, Petitioners' counsel obtained the admission from Mr. Jenkins that he had "a very difficult time with language in patents." J.A. 205. After Mr. Jenkins testified, Respondents offered into evidence the prosecution history of the original and reissue patents, rested on infringement, and renewed their Rule 50 motion.

In his summation, counsel for Petitioners reminded the jury that Respondents had presented no expert on claim language and that Respondents' president — one skilled in the art — had not interpreted the claim language because "he has trouble knowing what that means" and the interpretation of claim language is "an area of expertise." J.A. 231. He argued that the jurors should accept the testimony of the patent lawyer, "who has taught law," that the accused system infringes the patent. J.A. 231.

Respondents requested jury instructions construing the claim language for the jury as well as the use of special interrogatories to require the jury to apply the claim interpretation as given by the trial judge. Petitioners objected, claiming that interpretation of the claims was for the jury to decide. J.A. 241. The trial judge's instruction included a mere reading of the claim language to the jury. The trial judge told the jury that "you must determine the meaning of the claims taking the interpretation as I've explained it to you using the relevant patent documents including the specifications, the drawings and the file histories" J.A. 253. Respondents objected to the court's failure to interpret the claim for the jury and the instruction that the jury must determine the claims. J.A. 264.

After deliberation, the jury returned contradictory findings that Respondents had infringed Claim 1 and Claim 10 but not the broader Claim 14. The trial judge then heard argument on and granted Respondents' motion for a directed verdict.

6. The Trial Court's Opinion. In its Opinion and Order granting Respondents' motion for a directed verdict, the trial

court held that claim construction is a matter of law for the court. The district court cited case law holding that "a mere dispute concerning the meaning of a term does not itself create a genuine issue of material fact." 171a. The court concluded that the plaintiffs' expert tried to redefine common words in unusual and novel ways in order to sustain infringement. The judge observed that the expert's "artificial" reading of the claim is that "report" means "invoice"; "attached to said articles" means "attached to a plastic bag that covers a batch of the articles"; and "inventory" means "cash" or "invoices" but not "articles of clothing." 173a. The court determined that these definitions were contrary to the ordinary and customary meaning of the terms and the obvious meaning intended by the patentee as used in the specifications, the drawings and file wrapper. 173a.

The court regarded the patent lawyer's testimony as "unhelpful" because claim meaning is a matter of law for the court. 173a. Interpreting words in the patent as the Petitioners urged would require "semantic antics" because it would require a system that detects and localizes spurious additions and deletions of dollars to inventory and would require defining "inventory" in a dry cleaning system to mean only "cash" and not "articles of clothing." 175a. Since the claim meaning was clear on the face of the patent, and there was no dispute over the capabilities of the accused device, the court directed the verdict in favor of Respondents.

7. Proceedings in the Federal Circuit. Petitioners appealed and the case was fully briefed and argued before a panel of the Federal Circuit. Eighteen months later, the Federal Circuit *sua sponte* issued an order for rehearing of the case *in banc*. In a subsequent order, the Court requested the parties to brief four questions.⁹

After briefing and oral argument, the Federal Circuit issued the opinion that is before the Court today. The court's

9. The Federal Circuit's orders and the text of the four questions are reproduced in the Appendix to the Petitioners' Petition for Writ of Certiorari at 162a-167a.

nearly unanimous judgment was that the district court was correct to grant Respondents' motion for directed verdict.¹⁰

The majority opinion, joined by eight judges, characterized Petitioners' argument as follows:

Markman contends that the jury was properly given the question of claim construction and that the jury's claim construction and verdict thereon is supported by substantial evidence. The evidence Markman points to in support of the jury verdict is not the language of the patent specification or prosecution history, but rather Markman's own testimony as inventor and the testimony of his patent expert. He also relies on the use of the word "inventory" in Westview's product literature and on the testimony of its president. Markman's position essentially is that all the evidence of the meaning of the word "inventory," from the patent, prosecution history, experts, and documents, was properly lumped together and submitted to the jury for it to resolve what in fact is the meaning of "inventory," and that the result of this process is entitled to highly deferential review both by the trial court on motion for JMOL and by this court on appeal from the grant or denial of JMOL.

16a.

The Federal Circuit, rejecting Petitioners' assertions, held that the district judge was correct to construe the patent as a matter of law and that the construction was subject to *de novo* review on appeal. The Federal Circuit agreed with the district court that the testimony of Mr. Chovanes, Petitioners' legal expert, amounted to no more than legal opinion that the trial court was free to accept or reject as it saw fit, stating:

When legal "experts" offer their conflicting views of how the patent should be construed, or where the legal expert's view of how the patent should be construed conflicts with the patent document itself, such conflict does

10. *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995) (Archer, C.J., joined by seven other judges); *id.* at 989 (concurrency by Mayer, J.); *id.* at 998; (concurrency by Rader, J.) *id.* at 999; (dissent by Newman, J.).

not create a question of fact nor can the expert opinion bind the court or relieve the court of its obligation to construe the claims according to the tenor of the patent.

42a.

The Federal Circuit ruled that extrinsic evidence cannot be used to change the meaning of the claims. The Court agreed that the trial court properly used the patent documents to interpret the claims and, upon review of the claim language, specification and prosecution history, concluded that the district court's claim construction was correct. 36a-43a.

The Federal Circuit also agreed with the trial court that the Petitioners' proffered claim interpretation was illogical. Thus, the phrase "detect and localize spurious additions to inventory as well as spurious deletions therefrom," logically must refer to clothing and not "dollars" or "invoices." Dollars do not travel through the plant and the location of invoices within the plant is unimportant. Only clothes need to be localized, because they can be lost or stolen at different points as they travel through the plant. Also, "spurious additions" and "spurious deletions" to inventory logically relate to clothing because dollars and invoices would not be spuriously *added* to a dry cleaning inventory. 37a.

In its general holding, the majority resolved a split in Federal Circuit authority as to whether there could ever be jury triable fact issues subsidiary to claim construction. The Federal Circuit stated:

We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim.

30a.

Judge Mayer, who is quoted heavily by Petitioners, filed a separate opinion in which he opposed the majority's broad conclusions about the role of juries in infringement cases in which claim construction requires extrinsic evidence. Despite his disagreement with the majority on these matters, he concurred in the judgment on the ground that the trial court's

claim construction was proper because the meaning of the patent did not require inquiry beyond the patent documents. 57a, 61a n.2. Judge Rader filed a separate concurring opinion on the basis that the Federal Circuit should not have decided whether subsidiary fact issues relating to claim interpretation should be determined by the judge or the jury, because there were no such fact issues present in this case. He specifically concluded that there was no substantial evidence to support the jury's findings. 81a-83a.

The sole dissenter, Judge Newman, would have remanded the case to allow the trial judge to apply the "substantial evidence" standard to the jury verdict. 159a. Thus, the concurring judges agreed with the trial court's claim construction, and the single dissent did not argue that this construction was incorrect. The center of the disagreement within the *in banc* panel was the effect of the majority's opinion on future patent cases, not its judgment as to this case.

The Federal Circuit opinion relied on the traditional standard for review of a grant of JMOL: substantial deference is given to factual findings of the jury, but the legal standards applied by the jury in reaching the verdict are considered *de novo* to determine their correctness as a matter of law. 19a. Applying that standard to this case, the Federal Circuit found that the trial court properly construed the claims as a matter of law, stating:

Correctly reasoning that claim construction is a matter of law for the court, the district court properly rejected the jury's verdict and granted JMOL. Upon our *de novo* review of the court's construction of the claim language, we agree that "inventory" in claim 1 includes within its meaning "articles of clothing." It is undisputed that Westview's device does not and cannot track articles of clothing. Accordingly, there is no substantial evidence to support the jury's finding of infringement of claims 1 and 10 of United States Reissue Patent No. 33, 054 when those claims are correctly construed. The district court's grant of judgment of non-infringement as a matter of law is **AFFIRMED**.

56a.

SUMMARY OF ARGUMENT

Petitioners assert that the decision of the Federal Circuit in this case violates the Seventh Amendment's guarantee of a right to a jury trial. This argument depends on several assumptions. Petitioners must posit that there was a real factual dispute in the case, that the trial court improperly usurped the jury's role by directing a verdict in favor of the Respondents, and that the judgment of the Federal Circuit affirming the trial court, thus, is flawed. But none of the necessary predicates to Petitioners' arguments is present in this case.

Petitioners' brief is fixed on fact disputes over scientific evidence, but there was no scientific or technical evidence given at trial. Petitioners refer to expert disputes, but there were no such disputes because Respondents had no expert at trial and because Petitioners' supposed expert was simply a patent lawyer who had no training in the relevant art and put forth no "evidence." This was not a case where the trial judge determined credibility of disputing witnesses over issues of what someone skilled in the dry cleaning art would understand the patent claims to mean. Testimony like that presented at trial, giving only distorted legal conclusions in contradiction of the written record, is not competent evidence at all. It was the trial judge's obligation to decide matters of law in the case, as in all cases, and that obligation extended to construction of the plain meaning of the patent claims at issue.

In this case the Federal Circuit overwhelmingly agreed that the documentary record revealed the one susceptible meaning of the claim, and that extrinsic evidence was not a necessary part of proper claim construction. Claim construction clearly was a matter exclusively for the judge, and his judgment as a matter of law was appropriate.¹¹

11. The judgment in Respondents' favor is correct whether claim interpretation is always purely a matter of law or whether it may sometimes involve fact-findings on genuinely disputed terms. Since there was no real dispute in this case, the distinction here is immaterial. Alternatively, assuming *arguendo* that there were genuine issues in dispute, which Respondents deny, the judgment was still appropriate because the trial record easily reveals that there was no substantial evidence to support the jury verdict. The judgment can be affirmed under either of these analyses.

The Seventh Amendment question addressed by Petitioners relates to the Federal Circuit majority opinion's statements concerning the respective roles of judge and jury in interpreting claim language when testimony of those skilled in the art might be necessary to reveal the technical meaning of the claim to the trial court. While these statements may extend beyond this case, the Federal Circuit's view that claim construction in those circumstances is a question of law for the court is consistent with the precedent of this Court.

The properly framed constitutional question here is how the Seventh Amendment affects the determination of whether a particular issue in a jury trial, in this case, claim construction, is a matter of law for the judge or a matter of fact for the jury. This Court repeatedly has held that it is the essence of the common law jury's fact-finding role that is preserved, not the incidents and details. The allocation of roles between judge and jury is necessarily flexible because of the indistinct and sometimes shifting line between law and fact. Judge and jury roles also have changed as federal procedures and modern substantive laws have evolved.

The determination of how the task of claim construction should be allocated between judge and jury at trial today therefore must take into account both the roles of judge and jury in pre-1791 infringement cases and the evolution of those roles through history as trial practices and the patent system have developed. The Seventh Amendment framework supports the majority's conclusion that judges, not juries, construe patent claim language as a matter of law. Under this analysis, the essence of the jury's historical role in infringement trials is undisturbed, just as the sound policies toward providing uniformity and consistency in patent law are advanced.

The Federal Circuit properly rejected Petitioners' contention that claim interpretation becomes an issue of fact whenever extrinsic evidence is used as an aid to determine the meaning of patent claims. While a judge who is not skilled in the art may need testimony from an expert to explain the meaning of technical terms, this does not change the legal nature of claim construction. This process parallels other areas

of the law, where judges often consider extrinsic evidence to interpret written documents and determine foreign law.

The patent system's policies are advanced by the Federal Circuit's broader holding in this case. Patents are private monopolies of public rights. Patent claims are statutorily required to define the invention clearly and specifically so that the public can know the boundaries of the patent while it is in effect and benefit from its teaching after the patent expires. Their meaning cannot properly turn on determinations of witness credibility or demeanor.

Consequently, genuine fact disputes concerning the meaning of claim language to those skilled in the art cannot arise because the patent statute does not permit ambiguity. If the patent is truly ambiguous, it is simply invalid. Construction of claims as a matter of law both guards against unlawful ambiguity and promotes needed certainty in the patent system.

ARGUMENT

A. The Trial Judge Properly Construed The Petitioners' Patent Claims As A Matter Of Law.

Petitioners try to raise a Seventh Amendment claim by contending that there were fact issues underlying the construction of the claim language involved. They ignore the trial record and the claim construction actually undertaken by the trial judge and do not discuss the opinion of the Federal Circuit as it relates to the record below. When Petitioners' Seventh Amendment arguments are viewed in the context of the trial record, one sees immediately how extreme and inherently flawed these arguments are.

At trial, Petitioners' own witness testimony revealed that there was no dispute about the capabilities of the accused device. To avoid an inevitable legal conclusion to the case based on the meaning of the patent claims, Petitioners focused their efforts on attempting to redefine dispositive claim terms in contradiction to the written record. The key words were "inventory," "attached to," "report" and "invoice" — terms

easily understood by lay people and artisans alike. Rather than putting forth the testimony of someone skilled in the art, Petitioners relied on a patent lawyer who testified over Respondents' objection about the legal meaning of the patent claims.¹² This individual had no skill or expertise in the subjects taught in the patent. Expert instead in the lawyerly craft of linguistic legerdemain, he twisted the words of the claim so that they meant what Petitioners wanted them to mean.

As parsed against this record, Petitioners' legal arguments run as follows: the Seventh Amendment preserves the right to jury trial; juries find facts; the interpretation of claim language is completely factual whenever the parties' lawyers argue over the meaning of any claim word, no matter how simple the term, and no matter how artificial the argument; the judge can make no rulings of law on the meaning of claim terms once such a dispute is concocted and at trial must allow all testimony on the meaning of claim terms, even if the testimony contradicts the written record, and no matter how unfamiliar the witness is with the art in question; the judge must let the jury consider this testimony, whatever its content, and must thrust the claim language, the prosecution history, the specification and the drawings at the jury and instruct them to "figure it out"; and the jury is free to disregard the written record in favor of the aforementioned testimony. Obviously, the Seventh Amendment right to a jury trial cannot support all of Petitioners' far-flung assertions.

A quick examination of the well-settled principles of claim interpretation reveals the flaws in Petitioners' arguments. In an infringement case, the determining issue is whether the patent claims, properly construed, read on the

12. Petitioners have done an interesting about-face in strategy. At trial, their strategy was to impugn the claim interpretation abilities of the two witnesses who knew anything about the pertinent art, presumably to bolster the testimony submitted by their patent lawyer. Petitioners thus objected to cross-examination of the inventor (who testified that he did not understand the claim) about the claim language, and even attacked Respondents' president about his trouble understanding claim language. Now, however, they trumpet the testimony of these witnesses on the general meaning of the term "inventory," even though the testimony was not elicited in context of the term as used in the patent documents.

accused device. *Coupe v. Royer*, 155 U.S. 565, 579 (1895). While the capabilities of the accused device and the ultimate issue of infringement are jury issues, claim language is a matter of law for the judge. *Id.*

The judicial process for interpreting claims is well-known. The first step is to look at the claim itself. *Read Corp. v. Portec*, 970 F.2d 816, 821 (Fed. Cir. 1992). If necessary, the court also should consider the full documentary record, which includes the specification and prosecution history. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrochrome*, 796 F.2d 443, 480 (Fed. Cir. 1986), *cert. denied*, 404 U.S. 823 (1987). Where the documentary record is clear, the determination of terms in the claim is for the court. This conclusion is compelled by a legion of cases. See, e.g., *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 134 (1942); *Smith v. Snow*, 294 U.S. 1, 14 (1935); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895); *Coupe v. Royer*, 155 U.S. 565, 579 (1895); *Looms v. Higgins*, 105 U.S. 580, 596-99 (1882); *Heald v. Rice*, 104 U.S. 737, 749 (1882); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877); *Turrill v. Michigan So. & Northern Indiana R.R. Co.*, 68 U.S. 491, 509-11 (1864); *Winans v. New York and Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 339 (1854); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225-26 (1853); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), citing *Earle v. Sawyer*, 4 Mass. 1 (C.C.D. Mass. 1825).¹³

Although in some circumstances expert testimony may be necessary to explain terms of art to the judge, such testimony cannot contradict the clear meaning of the documentary

13. This view is shared by the Federal Circuit and other federal courts of appeal. See, e.g., *SSIH Equip., S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 376 (Fed. Cir. 1983); *Devex Corp. v. General Motors Corp.*, 667 F.2d 347, 357 (3d Cir. 1981), *aff'd*, 461 U.S. 648 (1983); *Del Francia v. St-Anthony Corp.*, 278 F.2d 745, 747 (9th Cir. 1960); *Solomon v. Renstrom*, 150 F.2d 805, 807-08 (8th Cir. 1945); *Cold Metal Process Co. v. E.W. Bliss Co.*, 285 F.2d 231, 239 (6th Cir. 1960), *cert. denied*, 366 U.S. 911 (1961); *Automatic Pencil Sharpener Co. v. Boston Pencil Pointer Co.*, 279 F. 40, 41-44 (1st Cir. 1922), *cert. denied*, 260 U.S. 728 (1922); *Brothers v. Lidge-wood Mfg. Co.*, 223 F. 359, 364 (2d Cir. 1915).

record. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992); *Kohn v. Eimer*, 265 F. 900, 902 (2d Cir. 1920) (Hand, J.). Moreover, no expert can presume to answer the legal question for the judge of what the ultimate meaning of the claim language is. See *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991). The recognition that such testimony is not competent evidence is long-standing. This Court has noted that a judge cannot be compelled to receive expert testimony on terms in a specification because "[e]xperience has shown that opposite opinions of persons professing to be experts may be obtained to any amount. . . ." *Winans v. New York and Erie R.R. Co.*, 62 U.S. at 100-101. Similarly, Judge Learned Hand observed that such testimony in contradiction to the written record "is inevitably a burdensome impertinence." *Kohn*, 265 F. at 902.¹⁴

By these standards, the testimony of Petitioners' patent "expert" was not evidence at all but the assertion of legal conclusions. In short, he was trying to supplant the trial judge. Since his legal conclusion contradicted the documentary record, the trial court was obligated to disregard it, and did so. 173a. Moreover, the testimony by the inventor and Respondents' president added nothing because it was not even couched in the context of the terms as used in the claims. Petitioners' witness "evidence" was the equivalent of testimony that a color is green when the documents say the color is purple.

The fact that the trial court allowed the expert legal testimony to go to the jury did not transform claim construction from a judge issue to a jury issue. The jury's contradictory answers on infringement made the judge's duty to construe the claims all the more apparent. When the trial judge then performed the requisite claim construction, he ruled that the meanings of the key terms in the claim were clear from the documentary record. The trial court rejected Petitioners' urged interpretation of these terms as "artificial" and "con-

14. Judge Hand observed in another case that "[a]rgument is argument whether in the box or at the bar, and its proper place is the last." *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 123 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

trary to their ordinary and customary meaning, as well as the obvious meaning intended by the patentee." 176a. Since no dispute existed about the capabilities of the accused device, the trial court granted Respondent's motion for directed verdict.

The trial court's ruling in this case was upheld by ten of eleven judges on the Federal Circuit on the basis that no fact disputes were presented at trial.¹⁵ The Federal Circuit's rejection of Petitioners' attempt to manufacture a factual dispute is unremarkable and follows the well-established precedent of this Court.

B. The Seventh Amendment Does Not Prohibit A Judge From Interpreting Patent Claims As A Matter Of Law.

Petitioners argue that the Seventh Amendment right to jury trial is implicated in this case because neither the Federal Circuit nor the trial judge applied the substantial evidence standard to the jury's "construction" of the claim language. This argument is premised on the mistaken assertion that juries interpreted claims at common law, and that all matters of fact for common law juries must be determined by juries today.

Petitioners' arguments run counter to the weight of authority. The Seventh Amendment preserves the role of both judge and jury at common law. It does so in jury trials by preserving the essential nature of those roles, not their incidents and procedural details. In the context of jury triable issues, the

¹⁵ Petitioners curiously quote from Judge Mayer's concurrence. He found that this case involved only issues of interpretation of the written record — the claim, the specifications and prosecution history — and therefore that the trial court correctly resolved the meaning of the claim language as a matter of law. 61a n.2 (no excursion needed beyond the patent documents). See also Judge Rader's concurrence at 81a ("The testimony of Markman's patent law expert is not evidence at all") (citing *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991)). Even Judge Newman, the lone dissenter, has stated this principle in another case; see *Advanced Cardiovascular Sys. v. Scimed Sys.*, 887 F.2d 1070, 1076 (Fed. Cir. 1989) (Newman, J., dissenting) (expert testimony cannot change the meaning of ordinary terms, as understood in light of the specification, prosecution history, and prior art).

division between judge and jury has never been fixed to a rigid historical analysis, other than through the general notion that the Seventh Amendment preserves the role of judge as law-determiner and jury as fact-finder. The historical inquiry is so limited because the line between judge and jury in jury trials at common law fluctuated and was indistinct. Moreover, in this country both the roles of judge and jury and the procedures governing them at trial have evolved over time making any strict historical analysis both impossible and against sound policies.

Historical analysis, thus, provides limited guidance in examining the particular question of whether the judge or the jury interprets patent claims. Indeed, the present patent claim system was not mandated until 1870. The jury's role in English common law patent cases was markedly different from the jury's role in American patent cases today. Nevertheless, a close reading of patent cases both at English common law and in this country confirms that the court, not the jury, interpreted claim and specification language. Despite the limitations of the historical record, it supports the Federal Circuit's analysis in this case — the construction of patent claims is properly given to the court.

1. Cases Dealing With The Distinction Between Law And Equity Are Not Helpful In Distinguishing Between Issues Of Law And Issues Of Fact.

The Seventh Amendment reads simply that "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall otherwise be reexamined in any Court of the United States, than according to the rules of common law." The history of the passage of the Amendment indicates that it was not intended to freeze the roles of juries in jury-triable cases, but rather to prevent the wholesale abolition of juries in the new country.

The right to jury trial was well-known in English common law and was practiced in all of the states at the time of the Constitutional Convention. See Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 Minn. L.

Rev. 639, 653-54 (1973); Kenneth S. Klein, *The Myth of How to Interpret the Seventh Amendment Right to a Civil Jury Trial*, 53 Ohio St. L. J. 1005, 1008, 1010 (1992). The Framers, as well as the individual states, were intent on preserving some right to civil jury trials in this country's government. Klein, *supra*, at 1008-10; Edith G. Henderson, *The Background of the Seventh Amendment*, 80 Harv. L. Rev. 289, 299 (1966). The commitment grew out of the fear of the capricious power of the judge of chancery that was part of the English system, as well as out of anti-federalist sentiments. Wolfram, *supra*, at 742-43. As this Court explained in *Colgrove v. Battin*, 413 U.S. 149, 152 (1973), the controversy generating the Amendment was not animated by "concern for preservation of jury characteristics at common law, but by fear that the civil jury itself would be abolished unless protected in express words."

There was very little attention given to discussion of this proposition at the Constitutional Convention. As many commentators have pointed out, there is scant written record indicating any significant debate or even discussion of the right to jury trial. Henderson, *supra*, at 291; Klein, *supra*, at 1008; Wolfram, *supra*, at 657. It is likely that the Framers felt that any significant pronouncement on civil juries in the Constitution would become mired in protracted disputes because the practice of jury trials among the states was so diverse. Klein, *supra*, at 1014; Wolfram, *supra*, at 665-66.¹⁶

During ratification several states expressed strong interest in preserving some form of right to jury trial in civil cases. The First Congress responded by proposing a constitutional amendment on the subject. But because of the lack of uniformity on the nature of jury rights among the states, the job of crafting meaningful amendment language was undoubtedly perplexing. James Madison, the chief author of the final product, apparently cobbled together an amalgam of language proposed by various states during the ratification process. Klein,

16. One framer noted that any such general clause would have been "pregnant with embarrassments." Klein, *supra*, at 1014. General Washington later noted that civil rights were omitted from the Constitution for fear of intruding on established state practices. *Id.* at 1014-15 (citation omitted).

supra, at 1018. Again, there was astonishingly little debate in the First Congress over the drafting of the amendment. *Id.* The final result was a guarantee framed in general terms that protected the jury trial right without trampling the states' practices. *Id.* at 1016-20. Yet by avoiding particulars, the language does little to explicate the precise scope of the right.

Aside from expressing a general desire to preserve the institution of the jury, the Framers gave no particularized consideration to the roles of judge and jury in a case where the right is preserved. The Reexamination Clause reflects the Framers' general belief that appellate courts should be prevented from abrogating the civil jury's fact-finding role by finding new facts on appeal, but the Framers also knew that jury facts could be reviewed in some manner at common law. See Henry Slocum, *New Trials and the Seventh Amendment*, 8 U. Ill. L. Rev. 292, 300-01 (1913). Again, however, specifics were not addressed. As Edith Henderson pointed out in her exhaustive review of the drafting and ratification of the Seventh Amendment:

Nowhere in the history of the Philadelphia convention, the ratifying conventions of the several states, or the specific 'legislative history' of the Bill of Rights can any evidence be found that the relation of judge to jury was considered as affected in any but the most general possible way by the seventh amendment, or even that it was considered at all.

Henderson, *supra*, at 290.

This historical background is important because it illuminates the two quite distinct inquiries that can arise under the Seventh Amendment. The difference between the two is of particular relevance here because Petitioners have confused the more common inquiry, whether the jury trial right attaches to a particular cause of action, with the less common inquiry involved here of whether a particular issue in a jury trial is for the court or for the jury.

Twenty years after the Seventh Amendment's passage, Justice Story gave the interpretation of the Seventh Amendment that set the standard for future jurisprudence on the issue. In *United States v. Wonson*, 28 F. Cas. 745 (C.C.D. Mass.

1812), the Justice found that the common law alluded to in the Seventh Amendment "is not the common law of any individual state (for it probably differs in all), but it is the common law of England, the great reservoir of all our jurisprudence." *Id.* at 750. Labelling this conclusion "obvious," Justice Story gave no citations for his assertion, but the federal courts have adopted his comments as the benchmark of Seventh Amendment analysis. Wolfram, *supra*, at 641. As the courts have interpreted Justice Story's statement, there is an implicit requirement that Seventh Amendment analysis start from the vantage point of jury trial practice at common law at the date of adoption of the Amendment in 1791. *See, e.g., Ross v. Bernhard*, 396 U.S. 531, 534 (1970); *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935).¹⁷

This framework supports two different inquiries, depending on the type of jury issue involved. The most common question is whether the Constitution provides a right to jury trial in a particular action. This issue arises as Congress creates new statutory rights and remedies that must be analyzed to see whether they are analogous to remedies tried to juries at the common law. Fleming James, Jr., *Right To A Jury Trial in Civil Actions*, 72 Yale L. J. 655, 656 (1963). This inquiry usually turns on whether the matter in question is more analogous to matters heard in law courts or to matters heard in equity courts. Much of the jurisprudence from this Court on the Seventh Amendment has focused on this inquiry. *See, e.g., Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 41-42 (1989); *Tull v. United States*, 481 U.S. 412, 426 (1987); *Pernell v. Southall Realty*, 416 U.S. 363, 370-71 (1974); *Fleitman v. Welsbach St. Lighting Co. of Am.*, 240 U.S. 27, 29 (1916).

Petitioners apply this "law/equity" distinction to this case, even though the question of whether a jury trial can be demanded in a particular action has no relevance here. Respondents do not dispute that a jury right under the Seventh Amendment attaches to patent infringement actions for

17. This conclusion has not escaped criticism. In a recent article, for example, commentator Klein argues that this historical mode of analysis may be less faithful to the purposes behind the Seventh Amendment than a functional analysis. Klein, *supra*, at 1034-36.

damages, since there is no doubt that in 1791 litigants brought these cases at common law. Here, the question before the Court turns on how the Seventh Amendment affects the roles of judge and jury in cases where a jury right exists. This is a separate inquiry. *See In re Peterson*, 253 U.S. 300, 310 (1920) ("No one is entitled in a civil case to trial by jury, unless and except so far as there are issues of fact to be determined").

2. The Case Law Concerning The Roles Of Judge And Jury In A Jury Trial Teaches That The Seventh Amendment Preserves The Essence Of The Jury Right, Not Matters Of Form And Procedure.

The courts have less frequently addressed the question of how the Seventh Amendment affects the roles of judge and jury in the course of a jury trial than they have the more fundamental question of whether there is any right to a jury trial. In contrast to the rather fixed historical analysis of the law/equity inquiry,¹⁸ the focus of this second inquiry is less easily defined. Without question, the "right of jury trial in civil cases at common law is . . . basic and fundamental," *Jacob v. City of New York*, 315 U.S. 752, 752 (1942), so that any seeming curtailment of this right "should be scrutinized with the utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935). Furthermore, the Amendment gives constitutional dimensions to the well-known English common law maxim that "issues of law are to be founded by the court and issues of fact are to be determined by the jury under appropriate instructions by the court." *Baltimore & Carolina Line v. Redman*, 295 U.S. 654, 657 (1935), citing *Walker v. New Mexico R.R. Co.*, 165 U.S. 593, 596 (1897).

However, it is equally clear that the Seventh Amendment preserves only the basic institution of the jury trial, and not its details. Time and again this Court has stated that the substance of the right is preserved, not matters of particular form

18. On which many courts have commented may "reek unduly of the study," if not, by Justice Clark's view, of the museum. *See* Martin H. Redish, *Seventh Amendment Right to Jury Trial: A Study in the Irrationality of Rational Decision Making*, 70 Nw. U. L. Rev. 486, 487 (1975), citing *Damsky v. Zavatt*, 289 F.2d 46, 48, 59 (2d Cir. 1961).

and procedure. See, e.g., *In re Peterson*, 253 U.S. 300, 309 (1920); *Walker*, 165 U.S. at 596; *Galloway v. United States*, 319 U.S. 372, 392 (1943). "The procedure of the first half of the seventeenth century or of the second half of the eighteenth century surely was not 'fastened upon the American jurisprudence like a strait-jacket, only to be unlocked by Constitutional amendment.'" Austin W. Scott, *Trial by Jury and the Reform of Civil Procedure*, 21 Harv. L. Rev. 669, 670 (1918), quoting *Twining v. New Jersey*, 211 U.S. 78, 101 (1908) (discussing due process of law).

Thus, numerous attacks have been made against the power of judges to take cases from juries, on the basis that the Seventh Amendment permits only procedures known at the common law. This approach has been consistently rejected since the mid-nineteenth century. See *Galloway*, 319 U.S. at 389 n.19 (1943) (collecting cases). This rejection is based on two factors: in the common law system itself, the jury's role was constantly in flux; and courts routinely exercised authority that effectively took away from the power of juries to decide facts. Both points were explicated succinctly in *Galloway*:

[T]he argument from history is not convincing. It is not that 'the rules of the common law' in 1791 deprived trial courts of power to withdraw cases from the jury, because not made out, or appellate courts of power to review such determinations. The jury was not absolute master of fact in 1791. Then as now courts excluded evidence for irrelevancy and relevant proof for other reasons. . . . The Amendment did not bind the federal courts to the exact procedural incidents or details of jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing. Nor were 'the rules of the common law' then prevalent, including those relating to the procedure by which the judge regulated the jury's role on questions of fact, crystallized in a fixed and immutable

system. On the contrary, they were constantly changing and developing during the late eighteenth and early nineteenth centuries.

Id. at 389-391 (citations omitted).

As the Second Circuit put it in *Dagnello v. Long Island R.R. Co.*, 289 F.2d 797, 804 (2d Cir. 1961), the single purpose of the Amendment is to preserve the essentials of jury trial and to safeguard the jury's function from encroachment that the common law did not permit. This does not, and cannot, mean that the roles of judge and jury at common law, if they even can be clearly deciphered, are to be adhered to in every detail for all times. There are obvious limitations to the strict comparison of jury practices in pre-1791 English common law with jury practice today, since "asking how 1791 England would deal with a 1991 multi-district patent infringement case is a little like asking how the War of the Roses would have turned out if both sides had airplanes." Klein, *supra*, at 1028.

For example, early in the law juries were required to have personal knowledge of the incidents at issue, and parties were disqualified from testifying because of self-interest. Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 Colum. L. Rev. 43, 80 (1980); James B. Thayer, "Law and Fact" in *Jury Trials*, 4 Harv. L. Rev. 170-74 (1890); James, *supra*, at 662. As that practice eroded, a system of superjurors arose, in which the same men in a particular parish, educated and qualified freeholders all, sat on civil cases involving their particular trade or profession. Devlin, *supra*, at 80-83. Inevitably, judge and jury knew each other well, and rendering a verdict in a case was at times a sort of informal group reasoning session. *Id.* Legal historians have noted that Lord Mansfield developed the law of modern commercial litigation by using a group of sea merchant jurors who informed him on how legal standards should

be set according to the practices of the trade. *Id.* at 81-82.¹⁹ The lines between law and fact, and judge and jury, were slippery indeed. They varied from time to time, issue to issue, and court to court.

At common law, English judges could take a case away from a jury and decide it as a matter of law. By 1791, an English judge could take cases from a jury on matters of law by, variously, granting a new trial, a nonsuit or a demurrer to the evidence. Henderson, *supra*, at 299-302. In addition, the phrase "to direct a verdict" was known and often used. *Id.* at 302. These procedures had the effect of reserving for later judicial decision questions of law arising during trials, and of taking verdicts subject to the ultimate resolution of the legal issue. *Baltimore & Carolina Line*, 295 U.S. at 659; *Galloway*, 319 U.S. at 390-391.

These procedures followed by 18th century common law courts are the precursors to the modern federal procedures of summary judgment and judgments taken as a matter of law. There has been no constitutional impediment to adoption in the Federal Rules of Civil Procedure of devices that limit the role of the jury in hearing evidence. The Seventh Amendment

does not prohibit the introduction of new methods for determining what facts are actually in issue, nor does it prohibit the introduction of new rules of evidence New devices may be used to adapt the ancient institution to present needs and to make of it an efficient instrument in the administration of justice.

In re Peterson, 253 U.S. at 309-10; see also *Baltimore & Carolina Line*, 295 U.S. at 657.

Here, the trial judge's use of the directed verdict device in determining the meaning of the claims as a matter of law was directly in line with the power of judges under the common law. The directed verdict device is a common feature of

19. "In 1761, for example, [Lord Mansfield] let a jury decide what would now be regarded as a pure question of law; namely, whether a shipper, whose cargo of sugar had been damaged on the voyage, could recover under his insurance policy . . . the profit he would have made on an imminent rise in the market." Devlin, *supra*, at 83. See also James B. Thayer, "Law and Fact" in *Jury Trials*, 4 Harv. L. Rev. 171, 173 (1890).

American jurisprudence and has been used countless times to resolve cases without violating either clause of the Seventh Amendment. This Court made this clear in *Capital Traction Co. v. Hof*, 174 U.S. 1, 13-14 (1899):

[A]t the common law and in the American constitutions, [trial by jury] . . . is a trial by a jury of 12 men in the presence and under the superintendence of a judge empowered to instruct them on the law and to advise them on the facts, and (except on acquittal of a criminal charge) to set aside their verdict, if, in his opinion, it is against the law or the evidence.

The Seventh Amendment preserves not only the jury's role, but also the judge's role as the governor of the trial. *Herron v. Southern Pacific Co.*, 283 U.S. 91, 95 (1931) (discharge of the judicial function as at common law is an essential factor in the due process which the Federal Constitution provides). When in the performance of that role the judge ascertains that an issue cannot be subject to any material dispute, it is the judge's obligation to decide the issue as a matter of law.

3. To The Extent That The Historical Record Is Pertinent, It Supports The Proposition That Judges, Not Juries, Construe Claim Language.

Even though an inquiry into the historic practices of the common law is of limited value, it nonetheless demonstrates that the construction of patent claims is an issue for the judge, not jury. To examine the effect of the Seventh Amendment on patent infringement trials, one first must compare the system of patent claiming and patent trials at the English common law to the modern claiming system and modern infringement trials. No historian can make a comparison of an institution through time without understanding its function in the context of the system in which it works, and how that system — and by necessity the jury role in it — has changed. The patent definition system currently practiced in the United States differs significantly from the systems practiced in 1791 England or in the early years of this country. There is no precise corre-

late in the historic record to modern patent infringement actions because the system of patent claiming has changed in style and content.

The theoretical price extracted from the inventor for the grant of the patent monopoly was (and is) that the patentee teach the public the invention for use after the life of the monopoly. This concept was a fundamental part of patent trials at the early English common law. See, e.g., XI W. S. Holdsworth, *History of English Law* 427 (1938). It was paramount that the inventor give the "recipe" for the patent in the specifications. Likewise, the requirement of a claim did not appear in this country until the Act of 1836, and a typical claim at that time was only a catalog of certain elements without explanation of what they meant and how they were to operate. The claim often simply referred to the specifications and was subordinate to the fuller description in those documents. R. Ellis, *Patent Claims* §6 (1949). The court in an infringement trial was left with the task of sorting out what was a material element of an invention, which not surprisingly required resort to the patented device. *Id.* Distinct claims were not required until 1870, when Congress provided by statute that the applicant "shall particularly point out and distinctly claim the part, improvement, or combination, which he claims as his own invention." Act of 1870, ch. 230, Sec. 26, 16 Stat. 198 (July 8, 1870).

Given the historic predominance of the specification, patent claiming first operated on the central claiming theory, in which claims were not required to be rigorously defined and so named the features of the invention by reference to its specification. *Ex parte Fressola*, 1993 Pat. App. LEXIS 3, *4 (Bd. Pat. App. & Interferences 1993). Under this system "the drawings and descriptions were the main thing, the claims merely an adjunct." A. Deller, *Patent Claims* § 4 (2d ed. 1971), cited in *Ex parte Fressola*, 1993 Pat. App. LEXIS at *4. In this century, however, the patent process has evolved into a peripheral claiming system, where the claim is statutorily required to be set out strictly and in practice sets forth the boundary of the area marked by the claim. *Id.*; see also John A. Diener, *Claims of Patents*, 18 J. Pat. Off. Soc. 389, 391-93

(1936) (explaining the peripheral claiming system's growth out of the American culture of individualism). The modern peripheral claim system is thus quite different from its predecessor in its focus on the specificity of the claim language, which must describe the "metes and bounds" of the patent monopoly. 35 U.S.C. §112 now requires that the specification be written in "full, clear, concise, and exact terms" and that it include claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Thus, cases involving claim construction under the old central definition system focused on whether the patented invention was the technical equivalent of the accused device. As the peripheral claim system developed, the focus changed, and the law of infringement came to center on whether the claims, which now predominated, read on the accused device. The effect of this change was to give the claims of the patent a new prominence, but at the same time to give the claims a more specific, abstract quality as the legal boundaries of the invention, rather than a specific "recipe" for making it.

The historical record must be considered in this context. Judges at English common law, just as judges today, were charged with the general duty of interpreting written documents as a matter of law. Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 Colum. L. Rev. 43, 75-76 (1980). This is not surprising. At the time of the passage of the Seventh Amendment, English juries were often illiterate. *Id.* at 75; see also Stephen Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 Cal. L. Rev. 1867, 1932 (1966).

The Petitioners' conclusions about English common law cases are uniformly misleading. The historical record does not show that juries interpreted patents in England in 1791. A close reading of each of the cases cited by Petitioners demonstrates that juries were performing two basic tasks: they determined whether specifications adequately "taught" a person skilled in the art how to reconstruct the invention, and they determined whether the devices at issue were the same inven-

tion. The first task, the modern equivalent of an enablement defense, was particularly important because of the significance of the specification in the patent system. Juries determined whether the patented inventions at issue could be copied by skilled craftsmen, and often heard testimony from craftsmen who tried to make the device from the specifications. I J. Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century* 732 (1992).

Thus, in *Liardet v. Johnson*, (K.B. 1778), a defendant asserted that a patent was invalid because its specification had not adequately described how to make the invention. Lord Mansfield asked the jury to determine the enablement function of the specifications, not the meaning of the words themselves.²⁰ Accordingly, Petitioners' reliance on this case for the proposition that claim interpretation was a matter for the jury reflects a basic misunderstanding of the case.

Similarly, at issue in *Turner v. Winter*, 1 T.R. 602 (K.B. 1787) was whether the specification was adequate to teach the public how to make the invention. *Id.* at 605. The jury in that case heard testimony from witnesses who literally followed the "recipe" of the instructions in the specification to see whether the substances produced were what were detailed in the specification. *Id.* "Therefore, if the process, as directed by the specification, does not produce that which the patent professes

20. Petitioners' citation to the "influential 1791 authority," Francis Buller, erroneously implies that Buller stated that juries must determine the meanings of specifications. Pet. Br. 25. The authority cited, *Trials Nisi Prius*, says nothing about juries. Buller summarized the *Liardet* case by stating, "The general questions on patents are, 1st, whether the invention were known and in use before the patent. 2d, whether the specification is sufficient to enable others to make it up. The meaning of the specification is, that others may be taught to do the thing for which the patent is granted" F. Buller, *An Introduction to the Law Relative to Trials at Nisi Prius* ch. VII (6th ed. 1791). It is furthermore clear that Lord Mansfield believed that judges, and not juries, determine the meaning of written documents. In *Macbeath v. Haldimand*, 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786) he and Justice Buller agreed with a lower court's order that directed a verdict for the defendant, because "there was no evidence which was proper for [the jury's] consideration for the evidence consisting altogether of written documents and letters which were not denied, the import of them was matter of law and not of fact." 1 T. R. at 180, 99 Eng. Rep. at 1040.

to do, the patent itself is void." *Id.* The jury was not given the words of the specification and told to decipher their meaning.

Petitioners' reliance on *Neilson v. Harford*, 8 M. & W. 806 (Exch. Pleas 1841) is curious, since it directly supports the Federal Circuit's opinion. The judge in *Neilson* made it clear that he construed the specification language at trial, since specifications, like all written documents, are to be construed as a matter of law. *Id.* at 822. As in *Liardet* and *Turner*, the jury's role was limited to ascertaining whether the instructions in the specification could produce the claimed invention and arose from a defendant's claim that the patent specification was insufficiently specific. *Id.* The jury's duty at trial was to ascertain whether a competent workman could follow the instructions in the patent. *Id.* at 824. Likewise, two other cases cited by Petitioners, *Arkwright v. Nightingale*, Davies Pat. Cas. 38 (Common Pleas 1785) and *Hornblower v. Boulton*, 8 T. R. 95 (K. B. 1799), are also enablement cases. *Arkwright*, Davies Pat. Cas. at 50-53 (five witnesses testified that they could make the machine from specifications); *Hornblower*, 8 T.R. at 99 (whether patentee gave adequate directions in specification was question for the jury).

At other times, the jury was called upon to compare the patented device with the accused device, to see if the patented device were "new." This is the inquiry undertaken by the juries in *Bovill v. Moore*, Davies Pat. Cas. 320 (Common Pleas 1816) and *Huddart v. Grinshaw*, Davies Pat. Cas. 200 (K.B. 1803). The juries did not "interpret" the involved specifications but rather looked at the inventions to determine if they had been disclosed by prior art.²¹

21. Petitioners' summary of *Collins v. Sawrey*, 4 Bro. P.C. 692 (H.L. 1772) is also misstated. In *Collins* the question was whether the claims at issue sought equitable rights and remedies or legal ones. It was held that the case involved legal issues and so should not be heard by the Court of Exchequer, but rather at law — i.e., by a "single judge, by a jury at an assize . . ." *Id.* at 699. Petitioners' omission of the phrase "before a single judge" and connection of the phrase "written evidence" to "by a jury" make it seem as if the question of whether the jury, as opposed to the judge, should construe written evidence. This was not at issue in the case. Likewise, in *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102 (K.B. 1774), the holding was not, as Petitioners tell it, that the interpretation of a charter is a question of

Later sources confirm that English common law courts construed patent language as a question of law, even where extrinsic evidence was required to understand the claim. As 1 Thomas Brett, *Commentaries on the Present Laws of England*, (1890) puts it, "The construction of a specification is the province of the Court, but evidence will be heard in explanation of technical terms used in the arts, or phrases used in particular trades. The rules of construction applicable to specifications are those applied to the interpretation of written instruments." *Id.* at 289. See also *Brooks v. Steele*, 14 R.P.C. 73 (1896) where the Court said,

The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification But after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined.

Id.; see also *Harrison v. Anderson Foundry Co.*, 1 App. Cas. 581 (1874) (interpretation of specifications is for the court).

C. The Consideration Of Extrinsic Evidence Does Not Change An Issue Of Law To An Issue Of Fact.

1. This Court Has Consistently Held That Claim Construction Is A Matter Of Law Even Where Extrinsic Evidence Is Used As An Aid To Construction.

NOTES (Continued)

fact for the jury. The holding was that the jury properly determined upon strongest possible evidence that a port was an ancient port because it had been enjoyed for 350 years. The meaning of a term in the charter was not at issue; the length of use of the port was. *Id.* at 108. In any event, even if the Petitioners' interpretation of these cases were correct, they would prove too much: construction of deeds and charters is now a clear matter of law for the court. See, e.g., *Driggins v. Okla. City*, 954 F.2d 1511, 1513 (10th Cir. 1991), cert. denied, 113 S. Ct. 129 (1992).

This Court has held repeatedly that claim construction is a matter of law. In infringement cases, this means that the judge defines the patent and the jury decides whether the accused device is covered by the patent claim. In one early decision, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), the Court explained it this way:

On . . . trial for [infringement] two questions arise. The first is, what is the thing patented; the second, has the thing been constructed, used, or sold by the defendants. The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to the jury.

Id. at 338. Likewise, in *Coupe v. Royer*, 155 U.S. 565 (1895), this Court said:

The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol. 3, page 378, as follows: "Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant."

Id. at 579. In practice, then, the judge construes the words of the patent claim, while the jury makes fact-findings about the capabilities of the accused device. Thus, the *Winans* court construed the letters patent by determining structure, mode of operation, and the result obtained from a patent. *Winans*, 56 U.S. at 338. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1853), construction of the combination patent claim was reserved to the court, while the jury was assigned the role of determining what parts of the machine were necessary to effect a particular result. *Id.* at 225-26. In *Coupe v. Royer*, 155 U.S. 565 (1895), the court's job was to give proper instructions to the jury on the scope of the patent, and the jury had to decide the question of infringement. *Id.* at 579.

This Court has repeatedly noted that it is the judge's duty to examine the written record in determining claim construction as a legal matter. The trial court's and the Federal Circuit's decisions in this case, that the claim language, specification and prosecution history show clearly that "inventory" includes "articles of clothing," stand squarely in line with this Court's precedent. Every case cited by Petitioners as contradictory to the Federal Circuit's decision is actually firmly in support of this basic principle. See *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (face of the instruments allows the judge, by comparing their terms, to determine the inventions described in the patents); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (in an anticipation case, issue of whether prior patents were for the same invention as the patent at issue was matter of law; court could decide the issue by comparing the patents); *Heald v. Rice*, 104 U.S. 737, 749 (1882) (Court interpreted the issue of whether a reissue patent was for the same invention as the original patent and found it a matter of law for the court where no extrinsic evidence was necessary); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877) (Court held that the claim language clearly did not cover the defendant's invention, so no verdict of infringement).

Not surprisingly, Petitioners fail to recognize the consistency of the Federal Circuit's holding with precedent and center their contentions on the question of extrinsic evidence. In doing so, they move well beyond the record in this case. Here again, however, Petitioners' citation to Supreme Court case law is misleading. Although this Court has never directly considered the question, there is ample support in the precedent for the conclusion that the use of extrinsic evidence does not change the character of claim construction as one of a pure legal issue for the judge.

Rather than supporting a Seventh Amendment right to jury trial when extrinsic evidence is necessary to explain terms of art in a patent, this Court's decisions have indicated that it is the role of the court to avail itself of such information if necessary as an aid to performing its legal duty of construing the claim. In *Looms v. Higgins*, 105 U.S. 580 (1882), the Court

availed itself on appeal of the testimony supplied by weaving industry experts in construing the meaning of a looming patent in an infringement case. *Id.* at 586. Similarly, the Court relied on the testimony of experts at trial in *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854) to understand the mode of operation of the patent in suit. *Id.* at 341. And in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848) the Court found the specification to be clear by its terms, citing *Earle v. Sawyer*, 4 Mason 1 (C.C.D. Mass. 1825), where the Court ruled on the clearness of the description of the specification, with such explanatory testimony as the experts and machinists furnished. *Id.* at 484-85.

Winans v. New York and Erie R.R. Co., 62 U.S. (21 How.) 88 (1859) is particularly instructive. There, the patent at issue was for an improvement in the construction of railroad cars. The patentee sued for infringement, and the defendant raised an invalidity defense based on numerous claims of prior art. This Court held,

There was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury. The testimony of experts which was rejected had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent. Experts may be examined to explain terms of art, and the state of the art, at any given time. They may explain to the court and jury the machines, models, or drawings, exhibited . . . [P]rofessors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence. . . . If the construction given by the court to the specification be correct, and in fact the only construction of which it is capable, as we think it is, it would be wholly superfluous

to examine experts to teach the court, what they could clearly perceive without such information

Id. at 100-01.²²

Petitioners try in vain to find cases that conflict with this Court's precedent that claim construction is a matter of law. First, the cases cited by Petitioners refer to the use of extrinsic evidence in dictum only. In every case on which Petitioners rely, the Court determined the patent meaning on the record before it. *See Singer Mfg. Co.*, 192 U.S. at 275; *Market St. Cable Ry. Co.*, 155 U.S. at 625; *Heald*, 104 U.S. at 737. Moreover, the allusion to the use of extrinsic evidence in these cases is not germane to the current system of claiming. Rather, the consideration of "extrinsic evidence" involved a determination of what the invention did — much as the jury today in an infringement case determines the capabilities of the accused device. In *Singer*, for example, the Court made a determination of whether a claim defined solely by its specification was the technical equivalent of the accused device. 192 U.S. at 275. In *Market St. Cable Ry. Co.* and *Bischoff*, the question was whether the prior patent disclosed the same invention as the current patent. 155 U.S. at 625; 76 U.S. at 816. In *Heald*, the question was whether the reissue patent was for the same invention as the previous patent. 104 U.S. at 737. And in *Tucker v. Spalding*, 80 U.S. 453 (1871), the question was whether an identity existed between the accused device and the patented device. *Id.* at 454.

The argument that the decision below is in conflict with this Court's precedent is thus misconceived. Supreme Court authority holds that claim construction is a matter of law for the court, regardless of whether extrinsic evidence is necessary to inform the court of the meaning of the claim language.

22. *See also* Albert Walker, *Textbook of the Patent Law of the United States of America* (3d ed. 1895), where the influential American patent expert states that judges are free to avail themselves or reject expert testimony on the meaning of particular phrases on the way to construing patents as matters of law. *Id.* at 173-74.

2. The Use Of Extrinsic Evidence In The Interpretation Of Documents Other Than Patents Does Not Transform The Issue From One Of Law To One Of Fact.

In other areas, the consideration of extrinsic evidence does not change an issue of law into an issue of fact for the jury. *United States v. Weitzenhoff*, 1 F.3d 1523, 1531-32 (9th Cir. 1993) (fact that judge allowed jury to hear expert testimony about meaning of EPA permit did not change construction of permit from question of law to question of fact). Courts routinely consider extrinsic evidence, including testimony, as an aid in other cases where they are called upon to interpret the meaning of documents as a matter of law. In this fashion, courts construe statutes, foreign laws, consent orders and treaties. *See Order of Ry. Conductors v. Swan*, 329 U.S. 520, 525 (1947) (documentary evidence and testimony considered as an aid to construing a statute); *Overseas Dev. Disc Corp. v. Sangamo Constr. Co.*, 840 F.2d 1319, 1324-26 (7th Cir. 1988) (expert testimony considered in determining foreign law); *cf. United States v. Reader's Digest Ass'n*, 662 F.2d 955, 961 (3d Cir. 1981), *cert. denied*, 455 U.S. 908 (1982) (underlying administration complaint examined as an aid in construction of consent order); *Choctaw Nation of Indians v. United States*, 318 U.S. 423, 431-432 (1943) (when construing a treaty, courts may consider extrinsic evidence concerning the history of the treaty, the negotiations, and the practical construction adopted by the parties).

Judges also routinely make rulings on "facts" in ways that prevent matters from going to a jury, without running afoul of the constraints of the Seventh Amendment. Judges make evidentiary rulings in determining relevance, competence of witnesses, probity, and prejudice, and they even review trial proceedings in ruling on questions of issue preclusion. These are all matters of law for the judge, although they may have factual underpinnings, and though the judge's ruling may profoundly affect the scope of the jury's factfinding authority.

There has been much discussion about the best analogy to patent interpretation. This decision is not critical to the issue before the Court. Ultimately, the quest for an analogy cannot provide an answer to the question before the Court, and there

is no precise analog to claim interpretation. But a closer look at how trial judges deal with other written instruments is helpful to understanding the judge's role in construing claim language.

The interpretation of a statute is similar to the interpretation of a patent claim. A patent and a statute both are delineations of public rights and/or obligations. They are each applicable to all persons similarly situated. The construction of a patent or statute establishes a standard that will then impact on people who were not involved in the drafting of the document. Although the construction of a statute begins with its words, where necessary, the court can consider extrinsic evidence or testimony, like legislative history or committee reports. See *Order of Ry. Conductors v. Swan*, 329 U.S. 520, 525 (1947). The consideration of such evidence does not change statutory construction from a legal question to a factual question. See, e.g., *Dakota Nat'l Bank & Trust Co. v. First Nat'l Bank Trust Co.*, 554 F.2d 345 (8th Cir. 1977), *cert. denied*, 434 U.S. 877 (1977). This is equally true of claim construction.

Petitioners argue that claim construction is analogous to contract interpretation, presumably because juries are sometimes called upon to consider parol evidence where it is necessary to determine the meaning of ambiguous words in the contract. This argument is of limited aid because there are significant differences between patents and contracts. Unlike statutes and patents, contracts normally have little or no impact on the public. There is no statutory requirement that a contract be clear and unambiguous and contracting parties are free to write contracts in a language that only they can understand. Since subjective intent is important in a contract interpretation, in an appropriate case, both sides to the contract can testify about the meaning of a contract as a factual matter. In a patent case, there is no subjective intent to determine.

However, in many cases, the meaning of contract language is interpreted as a matter of law without the need for extrinsic evidence. Moreover, even where contract language is disputed, a court can and should accept expert testimony to help it to determine whether or not a particular term is

ambiguous. See, e.g., *Mellon Bank, N.A. v. Aetna Business Credit*, 619 F.2d 1001, 1011 (3d Cir. 1980). This does not change the character of the determination of whether ambiguity exists from law to fact.

D. The Federal Circuit's Decision Advances Patent Law Policies.

1. The Construction Of Patent Claims As A Matter Of Law Promotes Specific And Clear Claims And Consistent Interpretation.

Contrary to Petitioners' suggestions, the jury retains its key role in patent cases. While patent validity is ultimately a matter of law, juries decide underlying fact issues involving obviousness, anticipation, and prior use or sale. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *Atlas Powder Co. v. E. I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1573 (Fed. Cir. 1984); *U.S. Envtl. Prods., Inc. v. Westall*, 911 F.2d 713, 715 (Fed. Cir. 1990). In infringement trials, juries decide as fact issues the capabilities of the accused device, file wrapper estoppel, the doctrine of equivalents claim and, of course, the issue of damages. See, e.g., *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1524 (Fed. Cir. 1995). In fulfilling these tasks, the jury is called upon to perform its traditional function of finding facts.

At the same time, the Federal Circuit's reaffirmation that claim construction is a matter of law serves important policy goals. Congress created the Federal Circuit for the express purpose of promoting uniformity, predictability, and fairness in patent law. H.R. No. 97-312, 97th Cong., 1st Sess. at 9 (1981). The aims are achieved in the policies underlying the Federal Circuit's decision in this case. The Federal Circuit has reached a compelling conclusion: patents are fully integrated written instruments that should be interpreted uniformly as a matter of law. As the Federal Circuit noted, the exclusive grant of right to the patentee makes it only fair that competitors "be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." 28a, citing *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1877). The only way a patent claim can

receive universal treatment is for it to be construed as a matter of law. If not, the same patent language could be subject to different interpretations by different juries in different infringement actions. There would be no uniformity, and definitely no certainty.²³ Most claims can be readily interpreted upon a judge's review of the documentary record.²⁴ After all, the patentee is statutorily required to set forth both the claim and specification with clarity and specificity. 35 U.S.C. §112. A litigation-induced parade of experts cannot change the meaning of the claim or the nature of the inquiry. Even a claim term that raises some complexity for the judge, who is not skilled in the art, does not change the issue from law to fact. The judge may need assistance from experts skilled in the art to understand what the term means, but if the patentee has complied with Section 112, there should be no dispute in the relevant community.

23. Petitioners argue that determination of patent claims as a matter of law promotes uncertainty until the appellate process is complete. Yet the supposed uncertainty created by the appellate process in this situation is no different from that involved in the interpretation of the words of any statute or regulation. The general uniformity fostered by interpreting these documents as matters of law is greater than any temporary uncertainty created by the appellate process. The temporary uncertainty created by the appellate process is far less than the permanent uncertainty created by allowing different juries to find different meaning in the same patent.

24. Petitioners cite to two district court opinions expressing concerns over the timing of a judge's claim construction. In one of these cases, *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 890 F. Supp. 329, 332 n.3 (D. Del. 1995), the Federal Circuit opinion in this case was issued days after the court had allowed claim construction to go to the jury in an eleven-day trial. Despite the opinions of these two judges, an overwhelming majority of district court judges have applied with no difficulties the directives of the Federal Circuit in this case, even upon consideration of extrinsic evidence. See, e.g., *Rolite, Inc. v. Wheelabrator Technologies, Inc.*, 1995 U.S. Dist. LEXIS 16453 at *4 (E.D. Pa. 1995) (construing claims on motion for partial summary judgment); *Edward Lowe Indus., Inc. v. Oil-DRI Corp. of Am.*, 1995 U.S. Dist. LEXIS 15790 at *5 (N.D. Ill. 1995) (same); *American Perma-hedge, Inc. v. Barcana, Inc.*, 1995 U.S. Dist. LEXIS 15838 at *10-11 (S.D.N.Y. 1995) (same); *Century Wrecker Corp. v. E.R. Buske Mfg. Co., Inc.*, 898 F. Supp. 1334, 1343-46 (N.D. Iowa 1995) (on motion in limine, ruling that court must instruct jury on interpretation to be given claim language).

Nor does the truly ambiguous patent term present a fact question. If two persons skilled in the art reasonably could interpret the same claim language differently, there is no need for further inquiry, because the patent has failed to satisfy its statutory obligation. Under Section 112, the patentee is required to distinctly and precisely state his or her claim, and if the patentee fails, the patent is invalid. This Court has emphasized the importance of and reasons for clarity and specificity in claim language:

Patents . . . must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.

General Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 369 (1938) (citations omitted).

This then is not just a theoretical issue. Patents are normally drafted by lawyers, not artisans. Often the lawyer's goal is to draft the patent claims with some ambiguity to allow the patentee to expand or constrict the patent as subsequent events dictate.²⁵ This has led to the anomalous situation that occurred in this case, where only the drafting lawyers, and not those skilled in the art to whom the patents are directed, can understand the claim language. Putting teeth into the requirements of Section 112 so that patents are drafted to teach rather than to spawn litigation, will undoubtedly result in more precise patent claiming, and fewer patent infringement cases.

25. See, e.g., Arthur H. Seidel, et al., *What the General Practitioner Should Know About Patent Law and Practice* 65 (5th ed. 1993):

The greatest possible effort should be exerted to avoid adopting a position in which the applicant may later be placed in a corner. It is much better technique, when possible, not to pinpoint the essence of patentability to a particular feature and, instead, to attempt to leave a certain amount of ambiguity or room to maneuver should very pertinent prior art be subsequently unearthed.

2. Adoption Of Petitioners' Argument Would Result In Serious Limitations On Procedures And The Evolution Of Law.

The line between "fact" and "law" is often nebulous, and judges undoubtedly have different thresholds for determining what is a genuine dispute of fact.²⁶ This Court has said that "no rule or principle [exists] that will unerringly distinguish a factual finding from a legal conclusion" *Pullman-Standard v. Swint*, 456 U.S. 273, 288 (1982). Where the distinction is difficult to make, it may turn on a policy analysis of who, in the administration of justice, is in a better position to decide the question. *Miller v. Fenton*, 474 U.S. 104, 113-14 (1985).

The Seventh Amendment does not require that the characterization of what is law and what is fact remain forever frozen, even if it were possible to distinguish law from fact in every case. Such a rigid outlook would prevent numerous developments in the law, such as this Court's refinement in *Daubert v. Merrill Dow/Pharmaceuticals*, 113 S. Ct. 2786 (1993), of the judge's role as the gatekeeper of expert testimony. It would also unduly constrain efforts to modernize the Federal Rules of Civil Procedure. For example, in 1966 Rule 44.1 of the Federal Rules of Civil Procedure was adopted. The Rule requires that determinations of foreign law be made as matters of law. A judge determining foreign law issues is free to look at any relevant source, including expert testimony. *Overseas Dev. Disc Corp. v. Sangamo Constr. Co.*, 840 F.2d 1319, 1324 (7th Cir. 1988), citing *United States v. Peterson*, 812 F.2d 486, 490 (9th Cir. 1987). Although now clearly questions of law, historically, issues of foreign law were at times viewed as factual. See, e.g., *Liverpool & G.W. Steam Co. v. Phoenix Ins. Co.*, 129 U.S. 397, 442 (1889). The ruling Petitioners request in this case would place the constitutionality of this Rule in doubt.

26. For example, this Court has noted that Rule 52(a) provides no particular guidance on distinguishing law from fact, just as it has recognized the sometimes critical importance of drawing the line between these two concepts. *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 501 (1984).

Any holding under the Seventh Amendment that patent construction is for the jury may put potentially serious limits on Congressional powers. Doubts would arise whether Congress could adopt other procedural devices that designate matters for the court. Such a holding also could handicap Congress's power to further reform patent law, for example by further refining the 35 U.S.C. § 112 requirements for patent drafting. Such a result would indeed "strait-jacket" the constantly evolving nature of federal procedure and jurisprudence.

If the jury must interpret every patent claim regardless of whether a dispute about claim language is reasonable, then a true sea change will be effected in patent law. The number of infringement cases decided by juries will surge, since it is child's play to create a dispute about the meaning of words. Cases in which imaginative but unreasonable interpretations previously would have been rejected as a matter of law will have to be decided by the jury. Trial judges will rarely be able to grant summary judgment on infringement issues because both prongs of the infringement analysis will turn on matters of fact. The time-honored balance between law and fact in patent infringement cases will be skewed. Trials will be lengthier and more complicated because each side will have to hire one or more experts to testify about the meaning of the claims. Cases like this one, in which the presentation of all of the evidence took less than two days, will disappear like the dinosaur.

CONCLUSION

Despite the consideration by Petitioners given to the Seventh Amendment, the Court need not reach the constitutional issue to affirm the judgment below. The Seventh Amendment issue was raised by Petitioners in their appeal to the Federal Circuit, and the Federal Circuit addressed the issue to resolve inconsistencies in its precedent and to explain its view for future cases in which disputes may be raised over technical terms. The Federal Circuit's teaching is compelled by precedent and sound policy. Yet, the fundamental issue here is whether the trial court correctly interpreted the claim language in this case as a matter of law. The Federal Circuit held that he did. The judgment of the Federal Circuit can be upheld on this basis alone.

For the foregoing reasons, Respondents respectfully request that this Court affirm the judgment of the United States Court of Appeals for the Federal Circuit affirming the trial court's grant of Respondents' motion for a directed verdict.

Respectfully submitted,

Frank H. Griffin, III

Counsel of Record

Peter A. Vogt

Polly M. Shaffer

GOLLATZ, GRIFFIN & EWING, P.C.

Two Penn Center Plaza

16th Floor

Philadelphia, PA 19102

Attorneys for Respondents

WESTVIEW INSTRUMENTS, INC. and

ALTHON ENTERPRISES, INC.

Dated: December 8, 1995

APPENDIX

35 U.S.C. §112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

22
No. 95-26

Supreme U.S.
F I D
DEC 28 1995

OFFICE OF THE CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

REPLY BRIEF FOR PETITIONERS

Of Counsel

LEWIS F. GOULD, JR.
STEPHAN P. GRIBOK
ECKERT SEAMANS CHERIN
& MELLOTT
1700 Market Square
Suite 3232
Philadelphia, PA 19103
(215) 575-6000

WILLIAM B. MALLIN
Counsel of Record
TIMOTHY P. RYAN
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
(412) 566-6000

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

28 pp

(i)

TABLE OF CONTENTS

TABLE OF AUTHORITIES (ii)

1.	Respondents Misstate Both The Record And The Basis For The Opinions Of The Courts Below	1
2.	Respondents Mischaracterize Petitioners' Argument Where There Is A Genuine Issue Of Material Fact	5
3.	Respondents Misstate The Scope Of The Seventh Amendment Right To Jury Trial	6
4.	The Historical Record Establishes That Interpretive Disputes As To The Meaning Of Patents Must Be Resolved By The Factfinder	7
5.	Respondents' Discussions Of The Precedents Of This Court Are Irrelevant And Mistaken	14
6.	The Need For Construing Claim Terms Does Not Render The Patent Void For Vagueness	17
7.	The Analogous Interpretive Issues Urged By Respondents Are Erroneous . .	18

(ii)

TABLE OF AUTHORITIES

Cases

<i>Bischoff v. Weathered</i> , 76 U.S. (9 Wall) 812 (1869)	15, 16
<i>Boulton v. Bull</i> , DAVIES PATENT CASES 162 (Common Pleas 1795)	8
<i>Bovill v. Moore</i> , DAVIES PATENT CASES 361 (Common Pleas 1816)	10, 12
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 212 (1853)	12
<i>Century Electric Co. v. Westinghouse Electric & Mfg. Co.</i> , 191 F. 350 (8th Cir. 1911)	19
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	15, 16
<i>DMI, Inc. v. Deere & Co.</i> , 755 F.2d 1570 (Fed. Cir. 1985)	4
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	7
<i>E. I. DuPont de Nemours & Co. v. Phillips Petroleum Co.</i> , 849 F.2d 1430 (Fed. Cir.), <i>cert. denied</i> , 488 U.S. 986 (1988)	13
<i>Evans v. Eaton</i> , 20 (7 Wheat) U.S. 161, (1822)	12, 14

(iii)

<i>Finney v. Guy</i> , 189 U.S. 335 (1903)	20
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	19
<i>Granfinanciera S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	13
<i>Harries v. Air King Products Co.</i> , 183 F.2d 158 (2d Cir. 1950)	14
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	16, 17
<i>Hilton Davis Chemical Co. v. Warner- Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995)	13
<i>Huddart v. Grinshaw</i> , DAVIES PATENT CASES 265 (K. B. 1803)	10
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	17
<i>Intervet America, Inc. v. Kee-Vet Lab, Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	9, 10
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	17
<i>Kneass v. Schulykill Bank</i> , 14 F. Cas. 746 (Cir. Pa. 1820)	14
<i>Liardet v. Johnson</i> (K.B. 1778)	8, 9
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1881)	17

(iv)

<i>Market Street Cable Ry. Co. v. Rowley</i> , 155 U.S. 621 (1895)	17
<i>Macbeath v. Haldimand</i> , 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786)	10
<i>Morris v. Bramsom</i> , DAVIES PATENT CASES 202 (K.B. 1776)	10, 12
<i>Neilson v. Harford</i> , WEBSTER PATENT CASES 295 (Exch. 1841)	8
<i>North American Vaccine, Inc. v.</i> <i>American Cyanamid Co.</i> , 7 F.3d 1571 (Fed. Cir. 1993)	18
<i>Philadelphia and Trenton Railroad Co.</i> <i>v. Stimpson</i> , 39 U.S. (14 Pet.) 376 (1840)	12
<i>R v Else</i> (1785), DAVIES PATENT CASES 144, 1 WEBSTERS PATENT CASES 76	12
<i>Silby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	12
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	17
<i>Teamsters v. Terry</i> , 494 U.S. 558 (1990)	7
<i>Tucker v. Spaulding</i> , 80 U.S. (13 Wall.) 453 (1871)	16
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1778)	8

(v)

<i>United States v. State Investment Co.</i> , 264 U.S. 206 (1924)	20
<i>Walker v. New Mexico & S. Pac.</i> <i>R.R. Co.</i> , 165 U.S. 593 (1879)	7
<i>Washburn v. Gould</i> , 29 F. Cas. 312 (C.C.D. Mass. 1844)	13
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 339 (1853)	15
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1859)	14, 15

Constitution

U.S. Const. amend. VII	passim
----------------------------------	--------

Statutes

35 U.S.C. § 112	9, 17
Act of 1870, Ch. 230, § 26, 16 Stat. 198 (July 8, 1870)	11
Act of 1836, Ch. 375, § 6, 5 Stat. 117 (July 4, 1836)	11
Act of April 10, 1790, Ch. 7, § 1, 1 Stat. 109	11

Other Sources

ADAMS & AVERLY, THE PATENT SPECIFICATION: THE ROLE OF LIARDET V. JOHNSON, 7 J. Legal Hist. 156 (1986)	12
A. CORBIN, CORBIN ON CONTRACTS, §§ 534, 554 . .	19, 20
ESSAY, NOTE ON THE PATENT LAWS, 3 Wheaton 655 (1818)	7
E. WALTERSCHEID, THE EARLY EVOLUTION OF THE UNITED STATES PATENT LAW: ANTECEDENTS (Part 3), 77 J. Pat. & T. Off. Soc'y 771 (1995)	9
GERALD GUNTHER, LEARNED HAND: THE MAN AND THE JUDGE, 138 (1994)	14
I J. OLDHAM, "THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY (Chapel Hill & London, 1992)	6, 8
S. WILLISTON, WILLISTON ON CONTRACTS, §§ 602, 616 (3d Ed. 1961)	19, 20

REPLY BRIEF FOR PETITIONERS

Petitioners submit this Reply Brief to reply to the contentions of respondents and certain *amici*. Respondents and their supporting *amici* respond to contentions not advanced by petitioners, misstate the record below, mischaracterize the opinions of the trial judge and the Federal Circuit and misconstrue the precedent of this Court. In apparent recognition that their position on the Constitutional issue before the Court is wrong, respondents and these *amici* attempt to convince this Court not to address the Constitutional question raised by this case and, failing that, advance a position that would undermine the Seventh Amendment right to a jury trial on infringement issues in patent litigation.

1. Respondents Misstate Both The Record And The Basis For The Opinions Of The Courts Below.

Respondents mistakenly suggest that the decisions of the trial judge and the majority were predicated upon holdings that there was no genuine dispute as to the meaning of the patent terms at issue and that the "correct" construction of the patent arrived at below could be ascertained from the patent documents as a matter of law. This simply is untrue. The trial judge here based his decision on his misdirected view that the interpretation of a patent is always a question of law reserved exclusively for the judge's decision. In his view, the jury's verdict of infringement could be discarded by labelling the issue a legal question.

Respondents state that "[t]he trial court determined the meaning of the patent claims as a matter of law from the patent documents." Opp. 2. This statement, which forms the foundation for respondents' arguments to this Court, is false. The trial judge did not cite a single passage from the claims, the patent specification or the file history to support his erroneous interpretation of the term inventory which is not defined in these documents. Instead, the trial judge, relied on extrinsic evidence, weighed evidence, evaluated credibility, rejected evidence and disregarded express admissions of

respondents to support his erroneous factual findings, because he insisted that interpretation of a patent is always a legal question.

Claim 1 of the '054 patent requires that the system "maintain an inventory total." At trial, petitioners introduced evidence to establish what the term "inventory" meant to one of ordinary skill in the relevant art—a meaning consistent with the specification and file history. The trial judge rejected this evidence and adopted, without an appropriate evidentiary foundation, constructions of the term "inventory" which he stated were the "ordinary and customary meanings" of the term.¹ He concluded that "[i]nventory means articles of clothing" and that to infringe the patent, the accused system must maintain an inventory of descriptions of articles of clothing. There was no evidence that the '054 patent requires the system to keep in its memory indefinitely the descriptions of articles of clothing. The trial judge did not cite to the evidence upon which he relied in making factual determinations as to the "ordinary and customary meaning" of the term at issue.

According to respondents: "Markman's system, as defined by the patent, tracks articles of clothing through the dry cleaning process. The tracking of articles is accomplished by printing bar-coded article tags, attaching the tags to articles of clothing and scanning them at predetermined stations." Opp. 5. Respondents' description is incorrect. The infringed claims of the '054 patent do not require that bar coded tags be attached to individual articles or that such articles be monitored as they move through the drycleaning process. As the

¹See, e.g., *Trial Judge's Opinion* at 137a, "[t]hese definitions [of petitioners' expert] are contrary to the ordinary and customary meanings of these terms . . ."; "Plaintiffs' technical expert's testimony is based on an artificial interpretation of key words and phrases that runs counter to their ordinary meaning."

evidence at trial established, the patent's requirement of a "memory operable to record said information" is satisfied if the accused system possesses memory which enables it to record or print information regarding the articles.² The trial judge's erroneous conclusion is not supported by the claims, the patent specification, its prosecution history or other evidence. The jury's finding is supported by the evidence.

Respondents also mischaracterize the claims of the '054 patent as requiring the patented system to track individual articles of clothing through the drycleaning process. Though this may well describe a preferred embodiment of the '054 patent, it misrepresents the elements of independent claim 1, a claim of the '054 patent which respondents infringed as found by the jury. Having the capability to generate individual garment tags and thereby track individual garments through the drycleaning process is but one possible embodiment of the invention, an embodiment not required in claim 1. To the contrary, throughout the patent specification, the invention is described in terms of controlling "batches" or groups of articles in inventory. The trial judge's conclusion that the '054 patent requires individual articles of clothing and not batches to be processed is defective.

By reading into independent claim 1 the requirement of attachment of individual bar coded tags to individual articles of clothing (and thereby enabling the system to track individual articles), the trial judge erroneously read into claim 1 additional claim elements contained in dependent claims 5 and 6. However, dependent claims 5 and 6 are not limitations of claim 1. The Federal Circuit has held repeatedly that it is improper to read the requirements of a dependent claim into

²See, e.g., Testimony of inventor that "The primary claim, Claim 1, does not require that the system retain details as far as the articles associated with the ticket after the ticket is produced." App. 188.

an independent claim. *See, e.g., DMI, Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985). Consequently, claim 1 of the '054 patent does not require that individual garments be tracked through the drycleaning process. As found by the jury based on the evidence, the accused system infringes claim 1 as it requires only that the "written record" be attached to articles, either individually or in batches.

The evidence introduced at trial does not lend support to the judge's conclusion or, at the very least, there is substantial evidence supporting the jury's contrary interpretation. The evidence established that the ordinary meaning of inventory as used in the drycleaning industry is not limited to articles of clothing. Rather, Westview conceded that: "inventory" may mean dollars or it may mean articles of clothing; that both kinds of inventory are important in the industry; that the accused system was designed to account for inventory in both dollar and invoice forms; and that the accused system maintains an inventory by listing the invoices representing the batches of articles taken in by an establishment.

Respondents, recognizing that their position on the law is without support, now attempt to redraft the majority opinion to hold something which it does not. According to respondents: "The Court agreed that the trial court properly used the patent documents to interpret the claims and, upon review of the claim language, specification and prosecution history, concluded that the district court's claim construction was correct." *See*, Opp. 14. This simply is not the case. The trial judge did not predicate his findings on the claim language, the specification or the prosecution history, nor did he apply the substantial evidence standard. Rather, the trial judge, guided by the fiction that construing the claim terms is always a legal question, rejected the jury's findings by ignoring evidence, reweighing evidence and drawing unsupported inferences from the evidence.

The majority similarly adopted the position that it, upon *de novo* review, should weigh evidence and make credibility determinations *en route* to resolving claim construction issues as a legal question. The majority opinion did not conclude that the jury's verdict was not supported by substantial evidence. Like the trial judge, the majority concluded that judges must always interpret patents as a matter of law in every infringement action for damages. As respondents concede, but characterize as the "general holding," the Federal Circuit squarely held that "in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." 30a.

This legal question now stands at the very threshold of every patent infringement suit. Indeed, the majority explicitly rejected the notion that the issue was not before it; it emphasized that "Markman squarely raised the issue of whether the court acted within its power in granting JMOL after the jury had construed the claims," 55a, and denied that its decision concerning the proper allocation of functions between judge and jury as to claim construction issues was dictum. The majority's constitutional holding which governs every infringement case in the nation is before this Court for decision.

2. Respondents Mischaracterize Petitioners' Argument Where There Is A Genuine Issue Of Material Fact.

Respondents contend that petitioners here are advancing the argument that the interpretation of claim language is triable to a jury irrespective of the existence of a genuine issue of material fact. Opp. 19. This misstates petitioners' position. *See* petitioners' Question Presented for Review: "In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment to the United States Constitution of genuine factual disputes about the meaning of a patent?" Petitioners concede that if no triable issue of fact exists, the trial judge may withdraw the issue from the jury.

Pet. Brief at 35. But where there is a dispute of fact, the issue cannot be taken from the jury by simply saying that the issue is always a legal question.

3. Respondents Misstate The Scope Of The Seventh Amendment Right To Jury Trial.

Respondents argue that the right to jury trial on issues of patent interpretation does not attach because such issues are mere "incidents" or "procedural details." This argument is unsupportable in both law and logic.³ As Judge Mayer's concurring opinion below recognized, "[t]o decide what the claims mean is nearly always to decide the case" and "[n]ot infrequently, the ultimate question of infringement, indisputably a matter for the jury, is effectively dictated by the construction given the patent claims." 57a; 67a.

This Court's teachings are clear that the Seventh Amendment bestows upon a litigant in a civil case the right to trial by jury as to those issues which go to the "fundamental elements"

³Respondents' contention that "[h]ere the trial judge's use of the directed verdict device in determining the meaning of the claims as a matter of law was directly in line with the power of judges under the common law" begs the question before the Court which is a litigant's fundamental right to trial by jury as to issues of claim construction when there exist genuine disputes of fact as to the meaning of terms used in the patent. Additionally, respondents' contention in and of itself is inaccurate. Respondents fail to acknowledge, as a leading commentator has explained, that the concept of a "directed verdict" in eighteenth century trial practice "differs from the modern concept of the directed verdict as a final determination. The eighteenth-century jury was considered to have a moral obligation to follow the direction of the judge in his construction of applicable laws, but there was no legal obligation to do so. Nevertheless, trial judges did frequently direct juries to find for one party or the other, and juries ordinarily complied." I J. OLDHAM, *THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY* (1992) at p. 150. This practice, which did not limit the power of the jury at common law, is no basis for restricting the role of the jury today.

or the "substance of the common law right of trial by jury." *Walker v. New Mexico & S. Pac. R.R. Co.*, 165 U.S. 593, 596 (1897). Issues of claim construction constitute "fundamental elements" and, as Judge Mayer recognized, in most cases go to the very heart of the common law right of trial by jury of infringement issues in a patent suit. Petitioners' right to trial by jury cannot be extinguished by relabelling this central issue as a "procedural incident."

4. The Historical Record Establishes That Interpretive Disputes As To The Meaning Of Patents Must Be Resolved By The Factfinder.

Respondents do not dispute that the Seventh Amendment guarantees a jury trial in all cases where legal as opposed to equitable rights are at issue. *Teamsters v. Terry*, 494 U.S. 558, 564-65 (1990). That distinction incorporates English practice as of 1791. *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935). Curiously, the majority conducted no historical analysis to determine whether interpretation of the patent was an issue triable to a jury at common law. Respondents likewise proclaim that "[h]istorical analysis . . . provides limited guidance in examining the particular question of whether the judge or the jury interprets patent claims." Opp. at 23.⁴

⁴*Amicus* U.S. Surgical's efforts to undermine the significance of the state of English patent law as of 1791 are misleading. Its contention that "[p]atent law in England as [sic] that time was scarcely describable" is inaccurate. As of the time of the adoption of the Seventh Amendment, a well defined body of English case law had developed and was being applied. See Essay, Note on the Patent Laws, 3 Wheaton 655 (1818) describing legal principles discernable from the "great variety" of English decisions. U.S. Surgical's statement that "[t]here was no coherent body of English patent law to be known by the enactors of the Seventh Amendment" is mistaken. It is important to emphasize that the Seventh Amendment incorporates the *common law*, not English textbooks.

(continued...)

The rationale underlying respondents' efforts to deflect the Court's attention away from the proper analysis is simple — it is beyond question that according to the common law of England as of 1791 the jury has always had a role in determining a patent's scope. Respondents' attempts to distinguish the leading authorities on this point are unconvincing. Respondents contend that *Liardet v. Johnson* (K.B. 1778); *Turner v. Winter*, 1 T.R. 602 (K.B. 1787); and *Neilson v. Harford*, WEBSTER PAT. CAS. 295 (Exch. 1841), are distinguishable because these cases involved patent validity determinations based on the alleged insufficiency of the patent

⁴(...continued)

Whether or not there was a coherent, articulated body of patent law in the English law texts of the late 18th century, there was no uncertainty about what the functions of judge and jury were in the conduct of the many patent trials that had by then occurred. Concerning the volume of patent litigation, U.S. Surgical's statement that "there were only 18 patent decisions at common law in England" is incorrect and misleading. Until the very end of the 18th Century, there was no court reporting at the trial level. J. OLDHAM p. 164. For example, in Lord Mansfield's surviving trial notes (which cover only about one-half of Lord Mansfield's cases), there are 11 patent trials described, none of which was reported contemporaneously. See J. OLDHAM. Additionally, there were unreported patent trials being conducted during the 18th Century in England in the Court of Common Pleas and the Court of Exchequer, the vast majority of which went unreported. These facts explain Justice Buller's remark in 1787 that "[m]any cases upon patents have arisen within our memory," and the observation of Chief Justice Eyre of Common Pleas in 1795 that "we have heard many cases upon patents." *Turner v. Winter*, 1 T.R. 602, 602; *Boulton v. Bull*, Davies Pat. Cas. 162, 204, respectively. Moreover, even the reporting that did take place when the full courts sat was selective and intermittent. J. OLDHAM at 118-19, 1814. Consequently, U.S. Surgical's report concerning the volume of precedents existing in England in the 18th Century does not undercut to any extent the state of the English common law discussed in petitioners' Brief.

specification.⁵ However, respondents ignore the fact that determinations concerning validity, like infringement, require the patent to be interpreted and that juries making those interpretive determinations performed that specific function in England as of 1791.⁶ It has been consistently held as logic dictates that patents must be interpreted identically for purposes of both validity and infringement. See, e.g., *Intervet America, Inc. v. Kee-Vet Lab, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989) ("[c]laims must be given the same construc-

⁵The description of the *Liardet* decision advanced by *amicus* U.S. Surgical is flatly wrong and demonstrates its lack of understanding of the English precedents applicable here. Contrary to U.S. Surgical's contention that *Liardet* was "not a decision reviewed by the King's Bench," the case was reviewed before the full Court of King's Bench which ordered a new trial. Moreover, petitioners' statement of Lord Mansfield's instructions to the jury to determine "all objections made to exactness, certainty and propriety of the specification" is precisely correct. This portion of the jury instruction is taken directly from Justice Buller's handwritten notes of the case, not as U.S. Surgical contends, from Justice Buller's work, *TRIALS AT NISI PRIUS*, or from a party's "pamphlet." U.S. Surgical apparently does not recognize that Justice Buller was a judge on the King's Bench who participated in hearing and deciding the motion for a new trial in the *Liardet* case. Even U.S. Surgical's most recent secondary authority states that, in the ascendance of the specification in English patent law, *Liardet v. Johnson* "led the way." E. Walterscheid, *THE EARLY EVOLUTION OF THE UNITED STATES PATENT LAW: ANTECEDENTS (PART 3)*, 77 J. Pat. & T. Off. Soc'y 771, 801 (1995). *Liardet* is a leading English patent case which unequivocally demonstrates that English juries as of 1791 were called upon to decide issues of patent interpretation.

⁶For example, in *Liardet*, in proving whether the challenged invention was "new", it was necessary for the jury to compare the specification to comparable inventions in dictionaries, other printed sources and as described in testimony. In doing so, the jury necessarily had to discern the "subject matter which the applicant regards as his invention." See, 35 U.S.C. § 112.

tion when considering infringement as when considering validity.") (emphasis in original).

Respondents also attempt to distinguish several other leading cases on the basis that the juries in those cases were called upon to decide whether the invention subject to the patent was "new" in light of the accused device or other prior art. In both *Huddart v. Grinshaw*, DAVIES PAT. CAS., 265 (K.B. 1803) and *Bovill v. Moore*, DAVIES PAT. CAS., 361 (C. P. 1816), the juries interpreted the terms of the patents at issue in order to determine whether a new invention was disclosed. In each of these cases, the jury was assigned the task of determining the scope of the words used in the patent disclosure so as to enable them to pass upon the invention's novelty. See also, *Morris v. Bramson*, 1 DAVIES PAT. CAS. 202, 203 (K.B. 1776) (an improvement on an existing machine could be patented; however, as Justice Buller stated, "it must be for the addition only and not for the old machine too" thereby requiring the jury to construe the patent specification to determine whether an alleged new improvement to the existing machine was disclosed).⁷

Respondents attempt to further undermine the significance of these English precedents by contending that such jury determinations concerning the scope of a patent have "no

⁷Respondents' citation of *Macheath v. Haldimand*, 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786), cannot support the proposition advanced by respondents as that case dealt only with the construction of written documents and letters about which there was no factual disagreement to be submitted to the jury. Tellingly, Justice Buller observed that if letters "be written in so dubious a manner, as to be capable of different constructions, and can be explained by other transactions, the whole evidence must be left to the jury to decide upon; for they are to judge of the truth or falsehood of such collateral facts which may vary the sense of the letters themselves: but if they be not explained by any other circumstances, then, like deeds or other written agreements, the construction of them is a mere matter of law." 1 T.R. at 182.

precise correlate in the historic record to modern patent infringement actions because the system of patent claiming has changed in style and content." Opp. 31-32. In essence, respondents and certain of their supporting *amici* contend that because the statutory requirement of a claim did not appear in this country until 1836, prior precedents construing patent specifications (rather than strictly "claims") are irrelevant. These contentions are without merit.

The patent laws in the United States, like those of England prior to 1791, have always required inventors to point out their inventions in detail sufficient to distinguish any relevant prior art and to disclose to the public what protection the patent confers. The first patent statute enacted in this country required that the patent "describ[e] the said invention or discovery, clearly, truly and fully." Act of April 10, 1790, Ch. 7, § 1, 1 Stat. 109. Not unlike the procedure in modern practice, as of 1791 in the United States the applicant for a patent was required to submit "a specification in writing, containing a description . . . of the thing or things by him or them invented or discovered, . . . which specification shall be so particular . . . as . . . to distinguish the invention or discovery from other things before known and used." *Id.* § 2. The Act of 1836, ch. 357, § 6, 5 Stat. 117 (July 4, 1836) expressly included the word "claim" requiring that the applicant "[s]hall particularly specify and point out the part, improvement or combination, which he claims as his own invention." Claims as commonly used today were expressly made part of patent law by the Act of 1870, Ch. 230 § 26, 16 Stat. 198 (July 8, 1870), which mandated that an applicant for a patent "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

This evaluation is wholly irrelevant to the Seventh Amendment analysis. Claims, much as they are presently employed,

were in common use even before the first mention of claims in a statutory form in 1836. *See, e.g., Evans v. Eaton*, 20 (7 Wheat.) U.S. 161, 194 (1822) (specification concluded, "I claim as my invention, . . ."); *Philadelphia and Trenton R.R. Co. v. Stimpson*, 39 U.S. (14 Pet.) 376, 378 (1840) (discussing patent issued in 1831 as "[t]he specification describes the invention with minute particularity, and concludes: 'What I claim as my invention or improvement, is . . .'" The making of claims as a mandatory portion of the specification as provided in the Act of 1870 simply codified the preference for particular claiming already expressed by decisions of this Court. *See Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853) (specification and drawings to be considered "[o]nly for the purpose of enabling us to correctly interpret the claim"). *See also, Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852) (discussing "claims" of the specification). Though the statutory requisites may have changed, the essential functions of construction remained unaltered.⁸

In addition, even if the English precedents are somehow

⁸The specificity required of specifications under 18th Century English law is effectively the same as that required of claims under existing American law. *See* Pet. Brief fn. 15. With respect to the English practice of including claims at the end of a specification, it has been observed that, "[t]he distinction between the description element of the specification and the claim was a statutory creation -- Patents Act (1883), s.5-First Schedule. Actual practice long pre-dated that Act, however, to the extent that patentees did end their specifications with a statement of the features of the invention that they considered new and important. *See, R v Else* (1785), Dav. Pat Cas. 144, 1 Web. 76, Carp. 103; *Bovill v. Moore* (1816), 2 Marsh 211." *Adams & Averly, The Patent Specification: The Role of Liardet v. Johnson*, 7 J. Legal Hist. 156, n.16 (1986). This was, moreover, essential in any specification for a new improvement after such patents were validated in *Morris v. Bramson*, Davies Pat. Cas. 202 (1776), and juries construing such specifications were performing a task virtually identical to modern claim construction.

limited to juries construing the "specification" rather than the "claims" (a distinction without substance), the analysis cannot change. It is well-settled that the patent specification should be looked to in divining the scope of patent terms (*i.e.*, construction). *E. I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir.), *cert. denied*, 488 U.S. 986 (1988) ("[i]t is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in a claim"). Thus, a construction of a patent's scope often entails the need to construe the patent's specification today just as it did under English practice prior to and following 1791.⁹

Though Judge Story is acknowledged by the Federal Circuit to be "the leading intellectual property scholar of that era," (*see, Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1516 (Fed. Cir. 1995)), respondents and their supporting *amici* fail to distinguish meaningfully his views on this issue. In *Washburn v. Gould*, 29 F. Cas. 312 (C.C.D. Mass. 1844), Judge Story summarized English practice explaining that, "[T]he jury are judge of the meaning of words of art, and technical phrases, in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification." *Id.* at 325. Similarly, though Judge

⁹Even if it is assumed that the 1870 Act created a different claiming requirement, inventors could not thereby be stripped of their right to a jury trial in light of the Seventh Amendment's command that it be preserved. *Granfinanciera S.A. v. Nordberg*, 492 U.S. 33, 51 (1989) (Congress "lacks the power to strip parties contesting matters of private right of their Constitutional right to a trial by jury."). Moreover, respondents fail to explain why a clear historical practice of juries interpreting patents in the validity context is not sufficiently "analogous" for Seventh Amendment purposes to require jury interpretation in the closely related infringement context which is governed by the identical interpretation.

Learned Hand has been described as "one of the Nation's great patent judges" (see, Gerald Gunther, *Learned Hand: The Man And The Judge*, 138 (1994)), respondents and their amici remain silent with respect to Judge Hand's view that the interpretation of patent claims was "plainly a question of fact" subject to "clearly erroneous" review on appeal. *Harries v. Air King Products Co.*, 183 F.2d 158 (2d Cir. 1950).¹⁰

5. Respondents' Discussions Of The Precedents Of This Court Are Irrelevant And Mistaken.

Respondents devote considerable attention to attempting to establish that this Court has in the past concluded that claim construction is a matter of law in a case where there does not exist a genuine dispute as to the proper construction of a patent term. This analysis misses the point of this appeal. Respondents do not cite a single decision of this Court which even remotely supports the erroneous conclusion reached by the majority below. The Court accurately stated the controlling legal principles with respect to the interpretation of patent terms in *Evans v. Eaton*, 20 U.S. at 193-94, "[i]t is not disputed that the specification does not contain a good and sufficient description of the improved [invention], and of the manner of constructing it: and if there had been any dispute on this subject, it would have been a matter of fact for the jury, and not of law for the decision of this court."

In support of their position, respondents rely heavily upon *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858), where the Court interpreted a patent as a matter

¹⁰The views of Justice Story and Judge Hand were in accordance with the early American understanding. See, *Kneass v. Schulykill Bank*, 14 F. Cas. 746, 747 (Cir. Pa. 1820) (jury instructed that it was to resolve the interpretive dispute by reference to the patent specification, learned treatises, and expert testimony of those "acquainted with and practicing this art" and that the interpretation of the patent terms en route to an infringement finding was "for you to decide upon this evidence.")

of law since its meaning was clear from the text of the patent alone. As the Court concluded, "[i]f the construction given by the court to the specification be correct, and in fact the only construction of which it is capable, as we think it is, it would be wholly superfluous to examine experts that teach the court, what they could clearly perceive without such information." (emphasis supplied). This Court's decision in *Winans* is silent as to the division of responsibility between the judge and jury if a genuine dispute as to the meaning of a patent term is presented.¹¹ Respondents cite similar language from a hornbook quoted in *Coupe v. Royer*, 155 U.S. 565 (1895). Like *Winans* however, *Coupe* involved no disputed claim construction issue. Moreover, to the extent that language from *Coupe* is relevant, respondents ignore that *Coupe* explicitly reaffirmed the controlling analytical framework of *Bischoff v. Weathered*, 76 U.S. (9 Wall.) 812 (1869), see discussion *infra*. As the *Coupe* Court reiterated:

A case may be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instruction as the nature of the document seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of the evidence. *But in all such cases, the question still would be treated as a question*

¹¹Respondents attempt to emphasize one sentence of dictum from *Winans v. Denmead*, 56 U.S. (15 How.) 339 (1853), that patent interpretation is a "question of law to be determined by construing the letters-patent" and the "specification of claim annexed to them." That dictum, however, does not address the question here presented of whether there is a right to a trial by jury when there exists a material question of fact on the meaning of a patent term. That question is affirmatively answered by *Evans v. Eaton* and *Bischoff v. Weathered*.

of fact for the jury, and not a question of law for the court. 155 U.S. at 578-79 (emphasis added) (quoting *Bischoff*, 76 U.S. (9 Wall.) at 814).

Respondents attempt to distinguish *Bischoff* as involving "whether the prior patent disclosed the same invention as the current patent," Opp. at 40, is unconvincing because *Bischoff* directly supports the proposition that a jury and not the judge must interpret both the prior and the current patents. In *Bischoff*, this Court endorsed the "common practice" of making such determinations by submitting to the jury expert testimony regarding "the nature of the various mechanisms or manufactures described in the different patents produced." The Court, emphasizing the role that the jury has in determining the meaning of the patent terms, noted that judges might set aside clearly incorrect verdicts as against the weight of the evidence, but nonetheless concluded that the question remains an issue of fact for resolution by the jury, and not as a question of law for the judge. *Id.* at 814.

Similarly, respondents attempt to distinguish *Tucker v. Spaulding*, 80 U.S. (13 Wall.) 453 (1871), as a case involving the issue of whether "an identity existed between the accused device and the patented device." Opp. 40. In *Tucker*, the Court held that an existing patent and expert testimony on the issue of "diversity or identity" were improperly withheld from a jury. The Court described the issue of identity as a "mixed question of law and fact," holding that "the resemblance [of the two patents] was close enough to require the submission of the question of identity to the jury, and the admission of the testimony of experts on that subject." *Id.* at 456.

Indeed, this is the very basis for the Court's conclusion in *Heald v. Rice*, 104 U.S. 737 (1881), where a validity defense turned on whether a reissued patent and an original one were identical. In *Heald*, the Court interpreted the two patents because their language was "clear." *Id.* at 749. The Court

expressly distinguished *Bischoff* on the basis that "If it appears on the face of the instruments that extrinsic evidence is not needed to explain terms of art," then construction or interpretation "consequently is [a] matter of law for the court." *Id.* (emphasis supplied). See also, *Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (patent construction presents a "matter of law for the court" where "[n]o extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject matter.") (citing *Heald*).

The cases cited by respondents stand only for the proposition that where the terms themselves are clear without resorting to extrinsic evidence and no genuine issue of material fact is raised, there simply is no interpretive dispute for the jury to decide.¹² But the authorities do not support the notion that the judge can impose an interpretation where there is evidence supporting a contrary finding by the jury.

6. The Need For Construing Claim Terms Does Not Render The Patent Void For Vagueness.

In a further effort to avoid the Constitutional issue, respondents argue that if there is a factual dispute concerning the meaning of a claim term, there would be no need of further inquiry because such a dispute would, by definition, demonstrate a violation of 35 U.S.C. § 112, which requires a patentee to accurately set forth his invention in the claims of the patent. That position ignores both reality and the developed body of case law relating to the interpretation and construction of a patent claim. It is frequently the case that parties in patent litigation dispute the meaning of claim terms, which underlies the development of established claim construc-

¹²This same rationale underlies the basis for the other decisions cited by respondents as purportedly supporting their position. See, *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877); *Loom Co. v. Higgins*, 105 U.S. 580 (1881); *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848).

tion principles which permit a court or jury to turn to the specification, prosecution history, expert testimony and other evidence to resolve such disputes. According to respondents, if the court or jury must go beyond the patent to resolve a dispute over claim meaning, then the claim would be void for vagueness. Of course, this is not sensible and is not the law.

Courts have long recognized that language does not have the precision of a mathematical formula and that sometimes an inventor's description of his invention in his claims is the best that he can do within the limitations of expression. *See, e.g., North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1779-80 (Fed. Cir. 1993) (claims in light of specification must only *reasonably* apprise others of scope of invention and if language is as precise as subject matter permits, no more can be demanded). If the evidence shows that persons skilled in the art would understand a term in a patent, such as in the present case where the evidence demonstrated that the term "inventory" means both physical and cash inventory, that is sufficient.

7. The Analogous Interpretive Issues Urged By Respondents Are Erroneous.

Respondents and certain of their supporting *amici* contend that construction of a patent is most analogous to a statute and that, accordingly, there is purportedly no role for the jury in interpreting the meaning of patent terms, even when there is a material factual dispute over meaning. If a patent is deemed to be a "baby statute," that might indicate that its construction is the province of the judge. However, in the two hundred year history of patent litigation in this country (as well as in the common law of England), not a single decision is cited supporting the proposition that patents are like statutes and should be construed in a like manner. This is understandable because statutes are publicly enacted laws whereas patents are grants related to a specific invention privately worked out

between the inventor and the Patent Office. This new analogy is ingenious but without foundation. It is hard to fathom how a new and dubious analogy could alter the teachings of the relevant historical record and the relevant precedents.

The great weight of authority and the more reasoned analogy is that a patent is more like a contract with the government and, accordingly, should be construed using established principles of contract interpretation. This more appropriate analogy finds support in this Court's own decisions. *See, e.g., Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880). Lower courts have adopted the same view. *See, e.g., Century Electric Co. v. Westinghouse Elec. & Mfg. Co.*, 191 F. 350, 354 (8th Cir. 1911). It was also recognized at English common law. *See* Pet. Brief, fn. 27.

Briefs of some of the *amici* supporting affirmance take issue with petitioners' suggestion that interpretation and construction of a patent, as with any written instrument, involve distinct phases of analysis which often require that certain issues be resolved by the jury. This is not a distinction created by petitioners, but is one that is well recognized in the law. As Professor Corbin explains, "The question of interpretation of language and conduct -- the question of what is the meaning that should be given by a court to the words of a contract, is a question of fact, not a question of law." *A. Corbin, Corbin on Contracts*, § 554, p. 219 (1960). Professor Corbin explains that the process of "interpretation" is determining what ideas the language in the instrument induces in other persons, while "construction" relates to a determination of the legal operation of an instrument once its meaning has been ascertained. *Corbin*, § 534 p. 8-9. His views are in agreement with those of Professor Williston. *See, Williston on Contracts*, § 602, p. 320 (3d Ed. 1961).

This distinction has a significant impact under circumstanc-

es, as in the present case, where a dispute as to the meaning of a term is presented at trial. In such circumstances, the meaning of the disputed terms must be found as a fact before construction can proceed, and it is the role of the jury to make that finding. *Corbin*, § 554 p. 226-27 (jury should resolve opposing interpretations of contract terms); *Williston*, § 616 p. 652, 660 (it is the jury's function to interpret the meaning of written terms where the meaning is not so clear as to preclude doubt by a reasonable person). Even if a patent is not considered to be a contract, the model of contract construction as described above fits squarely with issues involving the interpretation and construction of a patent.¹³

In the final analysis, the various analogies advanced by respondents and U.S. Surgical are not helpful, especially in light of the persuasive historical record and authorities supporting petitioners' position. It is telling that respondents attempt to downplay the forceful historical record while grasping for strained analogies to escape the Constitutional mandate. In Seventh Amendment jurisprudence, a page of history is more persuasive than volumes of indirect and doubtful analogies, mostly newly discovered for litigation. At English common law in 1791, the meaning of "inventory" on this record would go to the jury. The jury verdict rendered in 1991 should be preserved by the Seventh Amendment.

¹³Respondents and their *amici* rely on other tangential purported analogies, such as determinations of foreign law, meaning of land patents, jurisdiction or the admissibility of evidence. Foreign law obviously is a special situation because the inquiry by definition is one of pure law. See, *Finney v. Guy*, 189 U.S. 335, 342 (1903). Similarly, the purported analogy to land patents is misplaced as this Court has held that disputed meaning of the patent grant presents a question for the jury. *United States v. State Investment Co.*, 264 U.S. 206, 211 (1924). Since petitioners' position, based upon the relevant history and authorities, addresses the merits of the infringement finding, jurisdictional and evidentiary rulings are beside the point.

Dated: December 28, 1995

Of Counsel

Lewis F. Gould, Jr.
Stephan P. Gribok
Eckert Seamans Cherin
& Mellott
1700 Market Street
Suite 3232
Philadelphia, PA 19103

Respectfully submitted,

William B. Mallin
Counsel of Record
Timothy P. Ryan
Timothy S. Coon
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

NOV 9 1995

CLERK

No. 95-26

IN THE

Supreme Court of the United States**OCTOBER TERM, 1995**

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND ALTHON ENTERPRISES, INC.,
Respondents.

**On Writ Of Certiorari To The United States
Court of Appeals for the Federal Circuit**

**BRIEF OF AMICUS CURIAE
THE ASSOCIATION OF TRIAL LAWYERS OF AMERICA
IN SUPPORT OF THE PETITIONERS**

PAMELA A. LIAPAKIS
President
1050 31st St., N.W.
Washington, D.C 20007
(202) 965-3500

JEFFREY ROBERT WHITE
Counsel of Record
1050 31st St., N.W.
Washington, D.C 20007
(202) 965-3500

JOSEPH W. COTCHETT
MARY SETH WEINER
COTCHETT & PITRE
840 Malcolm Rd. Suite 200
Burlingame, CA 94010
(415) 697-6000

CLYDE W. WILSON, JR.
WILSON, JOHNSON &
JAFFER, P.A.
27 South Orange Ave.
Sarasota, FL 34236
(813) 955-5800

Counsel for The Association of Trial Lawyers of America

BEST AVAILABLE COPY

33P8

TABLE OF CONTENTS

TABLE OF AUTHORITIES	iii
IDENTITY AND INTEREST OF AMICUS CURIAE.....	1
SUMMARY OF ARGUMENT	2
ARGUMENT	3
I. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO MANIPULATE PRECEDENT BY RECLASSIFYING DISPUTED PATENT CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT.....	3
A. The Jurisprudential Foundation Of Disputed Claim Interpretation Being A Question Of Fact, Rather Than A Question of Law, Has Its Genesis In The Precedent Of This Court.	5
B. The Federal Circuit Blatantly Ignores That The Majority Of Court Decisions Considering The Issue Of Disputed Claim Interpretation, Including Its Own Precedent, Have Found The Issue To Be A Question Of Fact.	7
C. As a Direct Consequence of the Decision in Markman, Decisions That Have Historically Been Considered Questions of Fact Will Now Have to be Decided by the Court as Questions of Law.....	10
II. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO CIRCUMVENT THE RULES OF	

**EVIDENCE AS ESTABLISHED BY THIS COURT BY
RECLASSIFYING DISPUTED CLAIM
INTERPRETATION AS A QUESTION OF LAW
RATHER THAN A QUESTION OF FACT..... 11**

**A. This Court Has Previously Found That
Evidentiary Questions Requiring
Presentation Of Conflicting External
Evidence Is A Question Of Fact And Not A
Question Of Law. 12**

**B. Prior To The Decision In *Markman*, The
Federal Courts Recognized That
Interpretation Of Disputed Terms
Requiring Expert Testimony Is A Question
Of Fact. 14**

**III. THE FEDERAL CIRCUIT SHOULD NOT BE
ALLOWED TO UNDERMINE THE FUNDAMENTAL
RIGHT TO A JURY TRIAL BY RECLASSIFYING
DISPUTED CLAIM INTERPRETATION AS A
QUESTION OF LAW RATHER THAN A QUESTION
OF FACT 16**

**A. The Seventh Amendment To The
Constitution Guarantees Petitioners The
Right To A Jury Trial And Must Be
Protected..... 16**

*1. The Historical Role Of The Jury
Must Be Maintained..... 18*

*2. Complexity Of The Issues Is Not A
Valid Reason To Remove An Issue Of
Fact From The Jury. 23*

CONCLUSION 25

TABLE OF AUTHORITIES

Cases

<i>Aetna Life Ins. Co. v. Ward</i> , 140 U.S. 76 (1891).....	14
<i>American Cyanamid Co. v. United States Surgical Corp.</i> , 833 F. Supp. 92 (D. Conn. 1993)	10
<i>Autogiro Co. of America v. United States</i> , 384 F.2d 391 (1967)	4
<i>Beacon Theatres, Inc. v. Westover</i> , 359 U.S. 500 (1959).....	22
<i>Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.</i> , 739 F.2d 604 (Fed. Cir.), cert. denied, 469 U.S. 1038 (1984)	5, 8
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	5, 6
<i>Booktree Corp. v. Advanced Micro Devices, Inc.</i> , 977 F.2d 1555 (Fed. Cir. 1992)	10
<i>Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry</i> , 110 S. Ct. 1339, 1344-45, 1353 (1990)	19, 22
<i>Connell v. Sears, Roebuck & Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)	18
<i>Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.</i> , 868 F.2d 1251 (Fed. Cir. 1989)	4
<i>Data Line Corp. v. Micro Technologies, Inc.</i> , 813 F.2d 1196 (Fed. Cir. 1987)	7
<i>Daubert v. Merrell Dow Pharmaceuticals, Inc.</i> , ___ U.S. ___, 113 S. Ct. 2786 (1993)	12, 13, 14

<i>Delta-X Corp. v. Baker Hughes Production Tools, Inc.</i> , 984 F.2d 410 (Fed. Cir. 1993)	4, 7, 10, 11
<i>Dimmick v. Schiedt</i> , 293 U.S. 474 (1935).....	22
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> 315 U.S. 126 (1942)	7
<i>Gant v. Union Bank</i> , 446 U.S. 929 (1980)	23
<i>Grand Chute v. Winegar</i> , 82 U.S. 373 (1872)	21
<i>Granfinanciera, S.A. v Nordberg</i> , 492 U.S. 33, 83 (1989)....	20
<i>H.H. Robertson Co. v. United Steel Deck, Inc.</i> , 820 F.2d 384 (Fed. Cir. 1987)	4, 8, 9
<i>Hoffman-LaRoche Inc. v. Burroughs Wellcome Co.</i> , 10 USPQ2D 1602 (D. Md. 1989).....	10
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	6
<i>In re Financial Securities Litigation</i> , 609 F.2d 411 (9th Cir. 1979) <i>cert. denied sub nom.</i>	23
<i>In re Lockwood</i> , 50 F.3d 966 (Fed. Cir. 1995).....	17
<i>Jacob v. New York</i> , 315 U.S. 752, 753 (1943)	21
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989).....	4
<i>Levy v. Gadsby</i> , 7 U.S. (3 Cranch) 180 (1805)	7
<i>Lemelson v. General Mills, Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992), <i>cert. denied</i> , 113 S. Ct. 976 (1993).....	4, 7

<i>Loctite Corp. v. Ultraseal, Ltd.</i> , 781 F.2d 861 (Fed. Cir. 1985)	3
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1881)	7
<i>Lucas Aerospace, Ltd. v. Unison Indus., L.P.</i> , ___ F. Supp. ___, 1995 WL 548544 (D. Del. 1995)	14
<i>Lyon v. Mutual Benefit Assoc.</i> , 305 U.S. 484 (1939).....	21
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) (<i>en banc</i>).....	passim
<i>McGill, Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir.), <i>cert. denied</i> , 469 U.S. 1037 (1984)	5, 8
<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986)	4, 5, 8, 9, 15
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985) 5, 8, 9	
<i>Parklane Hoisery Co. v. Shore</i> , 439 U.S. 322 (1979)	18, 19, 20, 24
<i>Patlex Corp. v. Mossinghoff</i> , 758 F.2d 594 (Fed. Cir. 1985), <i>mod.</i> 771 F.2d 480 (1985).....	17
<i>Perini America, Inc. v. Paper Converting Machine Co.</i> , 832 F.2d 581 (Fed. Cir. 1987).....	4, 7, 15, 16
<i>Railroad Dynamics, Inc. v. A. Stucki Co.</i> , 727 F.2d 1506, 220 USPQ 929 (Fed. Cir.), <i>cert. den.</i> , 469 U.S. 871 (1984) .	14
<i>RasterOps v. Radius, Inc.</i> , 861 F. Supp. 1479 (N.D. Cal. 1994)	10

<i>Sartor v. Arkansas Natural Gas Corp.</i> , 321 U.S. 620 (1944)	14
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	5
<i>Snellman v. Ricoh Co.</i> , 862 F.2d 283 (Fed. Cir. 1988), cert. denied 491 U.S. 910 (1989)	4, 7
<i>SRI International v. Matsushita Electric Corp. of America</i> , 775 F.2d 1107 (Fed. Cir. 1985)	23
<i>Tandom Corp. v. United States Int'l Trade Comm'n</i> , 831 F.2d 1017 (Fed. Cir. 1987)	7
<i>Tillotson, Ltd. v. Walbro Corp.</i> , 831 F.2d 1033 (Fed. Cir. 1987)	7, 9, 15
<i>Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed. Cir. 1991)	4, 7, 10
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	6
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	17
<i>Vieau v. Japax, Inc.</i> , 823 F.2d 1510 (Fed. Cir. 1987)	7
<i>Walker v. New Mexico & So. Pac. R. Co.</i> , 165 U.S. 593 (1897)	18

Constitutions, Statutes And Rules

U.S. Const., amend VII	16, 17
U.S. Const., Art. III, §2, cl.3	19
Federal Rule of Evidence 702	12, 13, 14

Other Authorities

Arnold, <i>A Historical Inquiry Into the Right to Trial By Jury in Complex Civil Litigation</i> , 128 U. Pa. L. Rev. 829 (1980)	20
de Tocqueville, <i>DEMOCRACY IN AMERICA</i> (Bradley revised ed. 1945)	21
Henderson, <i>The Background of the Seventh Amendment</i> 80 Harv. L. Rev. 289 (1966)	20
Jefferson, <i>THE WRITINGS OF THOMAS JEFFERSON</i> (Washington ed. 1861)	19
Landsman, <i>The Civil Jury In America: Scenes From an Unappreciated History</i> , 44 Hastings L.J. 579 (1993)	19, 20
Lovinger, <i>Science as Evidence</i> , 35 Jurimetrics J. 153 (1995)	12
Pound, <i>THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY</i> (1957)	19
Scheiner, <i>Judicial Assessment of Punitive Damages, the Seventh Amendment and the Politics of Jury Power</i> 91 Colum. L. Rev. 142 (1991)	20
Weinstein, <i>The Effect of Daubert on the Work of Federal Trial Judges</i> , 2 Expert and Scientific Evidence Quarterly 1 (Shepards 1994)	12
Wolfram, <i>The Constitutional History of the Seventh Amendment</i> , 57 Minn. L. Rev. 639 (1973)	19, 20

IN THE
Supreme Court of the United States

October Term, 1995

No. 95-26

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.,
Respondents.

**On Writ Of Certiorari To The United States
Court of Appeals for the Federal Circuit**

**BRIEF OF AMICUS CURIAE
THE ASSOCIATION OF TRIAL LAWYERS OF AMERICA
IN SUPPORT OF THE PETITIONERS**

IDENTITY AND INTEREST OF *AMICUS CURIAE*

The Association of Trial Lawyers of America ["ATLA"] is a national organization of American trial lawyers dedicated to the preservation of the adversary system, to trial by jury, to advancement of the science of jurisprudence and to promotion of the administration of justice for the public good.

ATLA has no interest in any of the parties or in which side ultimately wins this lawsuit on the merits. Rather, its

interest is in the important issue that this case raises, concerning the reclassification of patent claim interpretation from a question of fact to a question of law, thus impacting the existing Constitutional right to trial by jury.

Letters of consent from the parties to the filing of this brief have been filed with the Court.

SUMMARY OF THE ARGUMENT

Unless the Federal Circuit's split decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed Cir. 1995) (*en banc*) is reversed, the ramifications upon patent litigation will be detrimental to the fundamental rights protected by the Seventh Amendment of the United States Constitution and will signify an abrupt departure from federal precedent.

First, the Federal Circuit, in its majority opinion, completely ignores historical precedent and the foundation laid by this Court, with its unique decision that disputed patent claim interpretation will no longer be a question of fact for the jury, as it has been for hundreds of years, and instead, will now fall within the realm of the court as a question of law.

Second, the decision below is in direct conflict with this Court's interpretations of the Federal Rules of Evidence in determining which issues must be decided by the court and which issues must be decided by the trier of fact.

Third, it is an attempt by the Federal Circuit to trump the fundamental guarantees under the Seventh Amendment by taking away decisions that have always been squarely placed in the hands of a jury.

Considering the severity of the Federal Circuit's decision upon all patent infringement litigation cases, and its potential

for erosion of the Constitutional right to trial by jury in other fields of civil law, this Court must review the Court of Appeals' decision with the utmost scrutiny. This decision is an absolute *departure* from the basic principles of what issues are factual and, consequently, what is within the realm of the trier of fact.

The underlying premise of the Federal Circuit's holding is that issues involving specialized areas of the law, such as patent law, which generally require the assistance of expert testimony, are too complicated for handling by juries, and instead should only be decided by judges. Such a premise signifies the destruction of a fundamental right guaranteed by the United States Constitution and the foundation of American jurisprudence since its inception --- the Constitutional right to trial by jury.

ARGUMENT

I. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO MANIPULATE PRECEDENT BY RECLASSIFYING DISPUTED PATENT CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT

The ultimate issue in patent infringement cases is determining whether or not infringement has taken place. The first step in determining infringement is to construe the "claims" in the patent. *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985). Within patent law, a "claim" serves as the framework for the patented item:

The claims of the patent provide the concise formal definition of the invention. They are the numbered paragraphs which "particularly [point] out and distinctly [claim] the subject

matter which the applicant regards as his invention." 35 U.S.C. § 112. It is to these wordings that one must look to determine whether there has been infringement.

Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1258 (Fed. Cir. 1989); *Autogiro Co. of America v. United States*, 384 F.2d 391, 395-96 (1967). Next, the properly construed claims are compared to the alleged infringing device. *Loctite*, 781 F.2d at 866. The purpose of claim construction is to determine how other persons who are skilled in the art would construe the terms in the claims. *Id.*

Prior to *Markman*, claim interpretation was separated into two possible alternatives. See *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); cf., *Markman v. Westview Instruments, Inc.*, 52 F.3d at 977. One: In situations in which the terms in the claims and the underlying facts were not in dispute, the issue of claim interpretation has always been treated as a question of law. *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989). Two: If the terms and facts were in dispute, the issue of claim interpretation has always been held as a question of fact. A significant majority of appellate cases reflect the developed line of precedent establishing patent claim construction as an issue of fact when conflicting evidence is presented by the parties.¹

¹ See e.g., *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), cert. denied, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed.

A. The Jurisprudential Foundation Of Disputed Claim Interpretation Being A Question Of Fact, Rather Than A Question Of Law, Has Its Genesis In The Precedent Of This Court

Precedent established by this Court and relied upon in *Markman*, is the correct starting point for claim interpretation; however, the majority's reliance is based upon a misinterpretation of that established law. See *Markman*, 52 F.3d at 994.

In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1853), a decision allegedly relied upon by the majority in *Markman*, this Court refused to take disputed factual issues away from the jury. This Court specifically held that it was the jury's role to determine what the patent claims covered, in light of the conflicting evidence, as part of the overall analysis of whether infringement had occurred. *Id.* at 225-26. This Court further construed and classified this determination as a matter of fact for the jury to decide. *Id.*

In *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), the issue presented was the identity of the invention, and this Court again reiterated that the meaning of disputed terms of art is "a question of fact for the jury." *Id.* at 814. In a bewildering reversal of interpretations, the Court of Appeals majority in *Markman* relies upon *Bischoff* as alleged support for taking factual determinations away from the jury. *Markman*, 52 F.3d at 977.

Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 613 (Fed. Cir.), cert. denied, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984).

This utilization of *Bischoff* is even more surprising in that this Court's holding in *Bischoff* was extremely clear and totally to the contrary of *Markman*. This Court held that even in situations in which the facts are so clear that there is no need for an expert to explain the terms of art, the question itself, in determining the meaning of the terms of art, remains one of fact for the jury. *Bischoff*, 76 U.S. at 814. This Court specifically held that a party does not have a right to demand from the court that these issues be decided as a matter of law. *Id.*

This Court again considered this issue of disputed terms of art in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872), holding that evidence of a prior patent and expert testimony concerning that issue were improperly withheld from a jury when the trial court was presented with a mixed question of law and fact.

The issues surrounding mixed questions of law and fact are extremely relevant to the matter at bar. In *Tucker*, the Court recognized that even in situations where the disputed factual question is minor in comparison to the legal issue, the essential nature of the trial mandates that the case be given to the jury. *Id.* at 455. Accordingly, even if *undisputed* claim interpretation is a matter of law, when the evidence presented by the parties is in conflict, claim interpretation is a question of fact. According to *Tucker*, in situations that involve hybrid scenarios concerning issues of fact and of law, the questions must be submitted to the jury. *Id.*

In a final attempt by the Federal Circuit to gain some semblance of support, the majority cites a string of other Supreme Court cases. *Markman*, 52 F.3d at 977-78. However, as with those cases noted above, these cases provide only facial support and offer no substantive basis for this radical departure from precedent. See *Hogg v. Emerson*,

47 U.S. (6 How.) 437 (1848); *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180 (1805); *Loom Co. v. Higgins*, 105 U.S. 580 (1881); *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942). Some of these cases say absolutely nothing about removing disputed factual questions from the jury, while other cases were decided under bills in equity.

The bottom line is that none of this Court's prior decisions cited by the majority in *Markman* offer any support for the proposition that claim interpretation is a question of law for the court when disputed evidence is provided by the litigants.

B. The Federal Circuit Blatantly Ignores That The Majority Of Court Decisions Considering The Issue Of Disputed Claim Interpretation, Including Its Own Precedent, Have Found The Issue To Be A Question Of Fact.

By using the groundwork laid by this Court as precedent, the majority of the decisions by lower courts that have contemplated this issue have found disputed patent claim interpretation to be a question of fact for the jury. See e.g., *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987); *Tandom Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017 (Fed. Cir. 1987); *Vieau v. Japax, Inc.*, 823 F.2d 1510 (Fed. Cir. 1987); *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196 (Fed.

Cir. 1987); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 613 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984). This established precedent is either completely ignored or inappropriately criticized in *Markman*. A review of these cases demonstrates the severe and drastic shift of the Federal Circuit in *Markman* away from any reputable, established case law on point.

The first case to directly address the issue at bar is *McGill, Inc. v. John Zink Co.*, 736 F.2d 666 (Fed. Cir. 1984). The parties had presented conflicting evidence regarding the meaning of terms in the claims contained in the patent specification. *Id.* at 668-69. The Court of Appeals recognized that, when disputed extrinsic evidence is used to explain the meaning of a term of art in the claims, the construction of the claims could be left to the jury as the finders of fact. *Id.* at 672. The court further determined that the jury could *not* be instructed as to the meaning of the disputed term of art from the court as a matter of law. *Id.*

The Federal Circuit further strengthened its position that disputed claim interpretation is a question of fact in *Palumbo v. Don-Joy Co.*, 762 F.2d 969 (Fed. Cir. 1985). The trial court had granted a summary judgment motion in favor of the defendant on the grounds that, after the court interpreted the terms in the disputed claims, there was no genuine issue of fact. *Id.* at 971-72. The Federal Circuit reversed, noting:

If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law. [Citation] But when the meaning of a term in a claim is disputed and

extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction.

Id. at 974.

In *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986), the issue before the trial court also concerned the interpretation of the disputed terms, "electrode," "electrode body," and "disposed in said body," in the patent claims. The Federal Circuit recognized that the meaning of the terms were disputed by the parties, recognized the conflicting evidence surrounding the meaning of the terms, and held that the matter required a trial by jury because it raised a genuine issue of fact. *Id.* at 657.

The Federal Circuit again found disputed claim interpretation to be a question of fact in *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed. Cir. 1987). In that case, the dispositive issue was the interpretation of the term, "bottomless trench," used in a patent claim. *Id.* at 388-89. The Federal Circuit affirmed the decision of the trial court, finding that disputed meaning of terms within patent claims are questions to be decided by the trier of fact -- which in the situation of a preliminary injunction was the trial court. *Id.* at 389.

In *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987), the Federal Circuit held that when a claim is in dispute, and it is necessary to look to extrinsic evidence presented by the parties, the underlying interpretation is a question of fact creating a sufficient dispute that must survive a summary judgment motion. *Id.* at 1037.

In *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546 (Fed. Cir. 1991), the Federal Circuit again reached the same conclusion that claim interpretation, when the meaning of a term in a patent is subject to varying interpretations or ambiguity, can be a question of fact to be decided by the jury. *Id.* at 1549-50.

As these and the many other cases that have followed this line of reasoning show, prior to the decision below in *Markman*, lower courts including the Federal Circuit developed a well-established and understood principle of patent law: When the meaning of terms in patent claims is disputed and conflicting extrinsic evidence is presented by the parties, claim interpretation is a question for the jury, to be decided as a question of fact.

C. As a Direct Consequence of the Decision in *Markman*, Decisions That Have Historically Been Considered Questions of Fact Will Now Have to be Decided by the Court as Questions of Law.

The majority's decision in *Markman* in reclassifying questions of fact as questions of law will have profound and adverse consequences upon the entire judicial system. Factual issues that have historically been presented to the jury will now be forced upon the court. See e.g., *Booktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555 (Fed. Cir. 1992); *American Cyanamid Co. v. United States Surgical Corp.*, 833 F. Supp. 92 (D. Conn. 1993); *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410 (Fed. Cir. 1993); *RasterOps v. Radius, Inc.*, 861 F. Supp. 1479 (N.D. Cal. 1994); *Hoffman-LaRoche Inc. v. Burroughs Wellcome Co.*, 10 USPQ2D 1602 (D. Md. 1989).

For example, after the *Markman* decision, the court will now be forced to determine the meaning of "first electrical

comparator connected to the load measuring means measuring the polished rod load relative to a present load point" to an engineer skilled in designing fluid pumps, after listening to expert witness testify about its disputed meanings. *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d at 412 n. 1, 414-15.

There is simply no basis to conclude that a judge with a law degree is in a better position to weigh conflicting testimony of experts as to the meaning of a term of art in a patent claim than a jury of mixed credentials. Further, if a law degree qualifies one to better evaluate expert testimony as to the meaning of a technical term, why not apply the same rationale to disputed expert testimony in a medical negligence case or blood analysis in a criminal case? The Seventh Amendment is a rejection of the concept that only an elitist group of "qualified" individuals should determine disputed issues of fact. The interpretation of disputed issues of fact is not the courts' job. It is guaranteed to the jury under the Seventh Amendment to the Constitution.

II. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO CIRCUMVENT THE RULES OF EVIDENCE AS ESTABLISHED BY THIS COURT BY RECLASSIFYING DISPUTED CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT.

In reclassifying disputed claim interpretation as a question of law, the majority in *Markman* has abandoned recent evidentiary standards established by this Court. Moreover, issues that involve presentation of conflicting extrinsic evidence would be decided as a matter of law, in direct conflict with this Court's present interpretations of the Federal Rules of Evidence.

A. This Court Has Previously Found That Evidentiary Questions Requiring Presentation Of Conflicting External Evidence Is A Question Of Fact And Not A Question Of Law.

In patent cases, disputed questions of the meaning and scope of technological terms and words of art are to be decided from the viewpoint of persons skilled in the particular field of technology under dispute. Regardless of whether the meaning of the terms is classified as a question of fact or a question of law, if the meaning is disputed, the parties will be forced to provide extrinsic expert evidence. See Lovinger, *Science as Evidence*, 35 *Jurimetrics J.* 153 (1995); Weinstein, *The Effect of Daubert on the Work of Federal Trial Judges*, 2 *Expert and Scientific Evidence Quarterly* 1 (Shepard's 1994). Accordingly, the Federal Rules of Evidence, which regulate the admission of expert testimony, are extremely relevant to the issue presented in the case at bar.

The Federal Rules of Evidence address the admission of expert testimony under Rule 702 as a means of assisting the trier of fact. Federal Rule of Evidence 702 states:

If scientific, technical, or other specialized knowledge will assist the *trier of fact* to understand the evidence or to *determine a fact in issue*, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise . . . (Emphasis added.)

Accordingly, from the express language of the Rule, the use of expert testimony is to assist the trier of fact.

As a further means of interpreting this rule, this Court addressed the role of novel scientific evidence in its recent decision in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*,

— U.S. —, 113 S. Ct. 2786 (1993). This Court found that the use of expert testimony is to be a two-stage process in which both the court and the trier of fact are involved. *Id.* at 2794-97. The initial, pretrial stage is for the trial court to determine: (1) if the methodology of the expert testimony is reliable in itself (*id.* at 2794-95), and (2) if the expert testimony is even admissible (*id.* at 2795-96). The second stage, if the testimony is determined to be reliable and admissible, is for the *trier of fact* to determine the credibility to be given to the expert testimony at trial. *Id.*

In other words, once the trial court has found the evidence to be admissible, its role is over. The jury is then required to weigh the evidence as it is presented by the experts, and make a factual determination as to which position they find to be more credible.

This is where the majority in *Markman* has created a significant flaw in their decision in determining who should interpret disputed terms in claim interpretation. *The majority acknowledges that the use of extrinsic expert evidence is necessary in determining the appropriate interpretations of the terms in dispute.* *Markman v. Westview Instruments, Inc.*, 52 F.3d at 979, quoting *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 631 (Fed. Cir. 1987). However, in recognizing the need for extrinsic evidence, such as expert testimony, the majority has effectively precluded the trier of fact from ever weighing the credibility of the evidence.

This rationale, in itself, is in direct conflict with this Court's interpretation of Federal Rule of Evidence 702 which requires the trier of fact to weigh the expert testimony and determine the appropriate credibility. *Daubert*, 113 S. Ct. at 2795-96. In effect, the majority's decision in *Markman* has denied patent cases the availability of using Rule 702 at all because the purpose of the rule is to assist the trier of fact. *Id.*

This Court's conclusion that the weight and credibility of expert testimony is a question of fact is not unique to the decision in *Daubert*. This Court has held on numerous occasions that the weight and credibility of witness testimony belongs to the trier of fact, because that is one of the fundamental roles of the jury, regardless of whether the issues concern technological or complex scientific evidence. See *Sartor v. Arkansas Natural Gas Corp.*, 321 U.S. 620 (1944); *Aetna Life Ins. Co. v. Ward*, 140 U.S. 76, 88 (1891); see also *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed. Cir.), cert. denied, 469 U.S. 871 (1984).

The process of weighing the credibility of the expert testimony is not the same as deciding a question of law. When analyzing two conflicting expert testimonies, it is necessary to decide which position to accept and which position to reject. In addition, the testimony must be allocated the appropriate weight by the deciding party. This is not the analysis for determining a question of law. But, it is the function of the jury prescribed in the Constitution under the Seventh Amendment.

The majority's attempt to distinguish disputed claim interpretation is an exercise in futility. See *Markman*, 52 F.3d at 981; see also *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, ___ F.Supp. ___, 1995 WL 548544, *12 n.7 (D. Del. 1995) (criticizing *Markman*). The majority seems to suggest that analyzing opposing expert opinions concerning disputed term interpretations does not constitute weighing the evidence's credibility or making factual evidentiary findings. *Id.* That suggestion is rather unique in its origin, and it is directly in conflict with this Court's interpretation of Federal Rule of Evidence 702. *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. at 2795-96.

B. Prior To The Decision In *Markman*, The Federal Courts Recognized That Interpretation Of Disputed

Terms Requiring Expert Testimony Is A Question Of Fact.

The most serious error in the majority's holding in *Markman* can be seen by looking at the Federal Circuit's own precedents. Situations that demand the introduction of extrinsic expert testimony to support diametrically opposing positions is a classic question of fact. See *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

In *Moeller*, the Federal Circuit acknowledged that the use of expert testimony is generally discretionary to the trial judge. *Moeller v. Ionetics, Inc.*, 794 F.2d at 657. However, the court went on to emphasize that in patent cases involving interpreting the meanings of disputed terms it becomes almost a necessity to involve extrinsic expert evidence. *Id.* Moreover, the court held that determining the meanings of the disputed terms after the admission of the expert evidence is a question of fact to be determined by a jury. *Id.*

The Federal Circuit again strengthened this position involving the use of expert testimony in *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033. The court concluded that when a patent claim is in dispute and it is necessary to look at extrinsic evidence, including the specification, the prosecution history, and other claims, the issue of claim interpretation becomes a question of fact. *Id.* at 1037. In holding such, the court determined that in light of the conflicting extrinsic evidence presented by the parties, the trial court's granting of summary judgment was inappropriate. *Id.*

In *Perini America*, the Federal Circuit again found that the use of conflicting extrinsic evidence created a factual issue for the jury. The court observed that legal conclusions are

dictated by established facts and not the other way around. 832 F.2d at 584. Accordingly, the court concluded that weighing disputed extrinsic evidence is not appropriate as a question of law and instead must be decided by the trier of fact. *Id.*

The precedent established by the Federal Circuit prior to the decision in *Markman* expressly demonstrates how the majority's decision is a complete flipflop in terms of established law. The use of extrinsic expert evidence to determine the appropriate meaning to disputed terms can only be a question of fact, and the *Markman* decision must accordingly be reversed.

III. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO UNDERMINE THE FUNDAMENTAL RIGHT TO A JURY TRIAL BY RECLASSIFYING DISPUTED CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT

A. The Seventh Amendment To The Constitution Guarantees Petitioners The Right To A Jury Trial And Must Be Protected.

Where, as here, a case presents a legal, as opposed to equitable, right to court adjudication, it falls under the scope of the Seventh Amendment of the United States Constitution. This Amendment, which guarantees the right to a jury trial, states:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States,

than according to the rules of the common law.

U.S. Const., amend. VII.

The Seventh Amendment confers upon litigants rights equal in scope to those that existed in the English Common Law of 1791, when the Amendment was adopted. The purpose of the Amendment was to "preserve the right to jury trial as it existed in 1791." *In re Lockwood*, 50 F.3d 966, 971 (Fed. Cir. 1995). The right to a jury trial guaranteed by the Seventh Amendment has also extended to statutory actions, subsequently developed, that are analogous to those decided in the courts of Eighteenth Century England. *Tull v. United States*, 481 U.S. 412, 417 (1987). The array of actions in which the Seventh Amendment guarantee applies is quite expansive. "In short, any adjudication of a legal, as opposed to an equitable, right falls within the scope of the Amendment." *Lockwood*, 50 F.3d at 972.

The Seventh Amendment guarantee of a jury trial applies to actions for patent infringement since such actions are "one[s] that would have been heard in the law courts of old England. [citations omitted]" *Markman*, 52 F.3d at 992 (Mayer, C.J., concurring). Additionally, the issue of patent validity has been found to be within the scope of the Seventh Amendment. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 603 (Fed. Cir. 1985), *modified*, 771 F.2d 480 (1985) ("The right to a jury trial on issues of patent validity that may arise in a suit for patent infringement is protected by the Seventh Amendment.")

The majority's decision below disregards history and precedent which place actions for patent infringement with the jury. The Seventh Amendment guarantee of a jury trial applies to patent infringement actions, and yet the court

below took the matter from the jury to render its own decision. This action must be corrected.

The common-law right of trial by jury in patent infringement cases must be protected. An issue of fact that falls within the scope of the Seventh Amendment must be determined by the jury. *Walker v. New Mexico & So. Pac. R. Co.*, 165 U.S. 593, 596 (1897). Where an issue is to be decided by the jury, as guaranteed by the Seventh Amendment, the court must respect the mandate of the Amendment. In such cases, "the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Id.*, 165 U.S. at 596.

The court must give deference to jury verdicts and allow the jury to fulfill its role as the finder of fact. "So long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

The Seventh Amendment and precedent applying its guarantee mandate that actions for patent infringement be determined by a jury. The actions of the majority below, which inexplicably run directly contrary to the past two hundred years of jurisprudence, must be reversed. The right to a jury trial, a fundamental right denied to petitioners, must be protected and preserved.

1. *The Historical Role Of The Jury Must Be Maintained.*

Chief Justice Rehnquist has stated that "The right of trial by jury in civil cases at common law is fundamental to our history and jurisprudence." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 388 (1979)(Rehnquist, C.J., dissenting). He

also remarked that "the scope and effect of the Seventh Amendment . . . perhaps more than with any other provision of the Constitution, are determined by reference to the historical setting in which the Amendment was adopted." *Id.* at 339. ATLA suggests that this history is particularly instructive with respect to the issue before this Court.

Those who view the jury trial as a mere procedural feature of our civil justice system overlook the fact that a war was fought, and lives lost, to win this right. A primary grievance of the American colonists was the extensive effort by England to shift the adjudication of civil and criminal disputes from colonial courts, where local juries sat, to Vice-Admiralty courts and other non-jury tribunals administered by judges beholden to the Crown. Roscoe Pound, *THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY* 69-72 (1957); Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 Minn. L. Rev. 639, 654 (1973); *Parklane Hosiery*, *supra*, 439 U.S. at 340 (Rehnquist, C.J., dissenting), *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 110 S. Ct. 1339, 1353 (1990)(Brennan, J., concurring). The colonists complained of this infringement through the Stamp Act Congress, the Continental Congress, and, finally, in the Declaration of Independence ("For depriving us in many cases, of the benefits of Trial by Jury"). Stephan Landsman, *The Civil Jury In America: Scenes From an Unappreciated History*, 44 Hastings L.J. 579, 595-97 (1993).

Independence from England did not diminish the sacredness of the jury in the eyes of the new Americans. Jefferson described the jury as "the only anchor yet imagined by man, by which a government can be held to the principles of its constitution. *THE WRITINGS OF THOMAS JEFFERSON* 71 (Washington ed. 1861). The proposed Constitution included the right to trial by jury in criminal cases, U.S. Const., Art. III, §2, cl.3. But the absence of an express guarantee of the

right in civil actions was condemned by the Antifederalists as sufficient cause to reject the entire Constitution. Their demand for an explicit guarantee of the right to trial by jury led to the adoption of a Bill of Rights as a condition to ratification of the constitution itself. Edith Guild Henderson, *The Background of the Seventh Amendment*, 80 Harv. L. Rev. 289, 195-98 (1966); Wolfram, *supra*, at 667-730 (extensive review of ratification debates); Landsman, *supra*, at 599.

Those who fought so strenuously for this right in 1791 saw the jury as an essential element of limited, democratic government. The jury was intended as a check on the power of the federal judiciary. Morris S. Arnold, *A Historical Inquiry Into the Right to Trial By Jury in Complex Civil Litigation*, 128 U. Pa. L. Rev. 829, 832-35 (1980). Reacting to their experiences at the hands of autocratic British judges,

The founders of our Nation considered the right of trial by jury in civil cases an important bulwark against tyranny and corruption, - a safeguard too precious to be left to the whim of the sovereign, or, it might be added, to that of the judiciary.

Parklane Hosiery Co. v. Shore, 439 U.S. 322, 343 (Rehnquist, C.J., dissenting). See also *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 83 (1989) (White, J., dissenting) ("The function of the civil jury is to diffuse the otherwise autocratic power and authority of the judge.").

In addition, the new Americans regarded juries "as more than a 'mode of trial'; they were instruments of local government as well." Arnold, *supra*, at 833. See also, Alan Howard Scheiner, *Judicial Assessment of Punitive Damages, the Seventh Amendment and the Politics of Jury Power*, 91 Colum. L. Rev. 142, 144-49 (1991). This view of the jury as

an element of self-government prompted de Tocqueville to observe:

It would be a very narrow view to look upon the jury as a mere judicial institution; for however great its influence may be upon the decisions of the courts, it is still greater on the destinies of society at large. The jury is, above all, a political institution, and it must be regarded in that light in order to be duly appreciated. . . . [I]t always preserves its republican character, in that it places the real direction of society in the hands of the governed, or a portion of the governed, and not in that of the government.

Alexis de Tocqueville, 1 DEMOCRACY IN AMERICA 293 (Bradley revised. ed. 1945).

In view of this history the Supreme Court has consistently emphasized the fundamental nature of the right to jury trials and has viewed any curtailment with great disfavor. Describing the right to trial by jury as "a great constitutional right," the Court stated that "it is only in exceptional cases and for specific causes that a party may be deprived of it." *Grand Chute v. Winegar*, U.S. 373, 375 (1872). See also, *Jacob v. New York*, 315 U.S. 752, 753 (1943) ("The right of jury trial in civil cases at common law . . . should be jealously guarded by the courts."); *Lyon v. Mutual Benefit Assoc.*, 305 U.S. 484, 492 (1939) ("It is essential that the right of trial by jury be scrupulously safeguarded.").

The immense respect given to the Seventh Amendment and its accompanying deference in the courts must not be compromised. Since the ratification of the Seventh Amendment the right it guarantees has evolved; yet the

importance placed on the role of the jury has remained sacrosanct. This Court has repeatedly declared:

Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.

Dimmick v. Schiedt, 293 U.S. 474, 486 (1935), quoted in *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 501 (1959); and in *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 110 S. Ct. 1339, 1344-45 (1990).

The jury's role has also served as a check on the power of the courts:

The deference that courts give to jury verdicts is the mechanism by which the Constitution protects the jury right from encroachment by judges. It is not this court's option to violate that right, whether by denying such deference or by taking from the jury the trial of factual issues.

Markman, 52 F.3d at 1010-11 (Newman, C.J., dissenting).

This protective function will also be lost, or at least significantly diminished, if the holding of the court below is allowed to stand.

The majority's holding in *Markman*, which effectuated a taking from the parties of the right to trial by jury of disputed factual issues would significantly curtail the rights guaranteed by the Seventh Amendment. Accordingly, the action below should be examined closely and, as it cannot be sustained upon scrutiny, reversed. It is strikingly clear that the Federal

Circuit's action is not only contrary to its own precedent but also flies in the face of one of our most fundamental constitutional rights, the Seventh Amendment guarantee of a jury trial.

2. Complexity Of The Issues Is Not A Valid Reason To Remove An Issue Of Fact From The Jury.

The jury's role as the trier of fact must not be compromised merely because of the technical nature of the facts to be determined. A "complexity exception" to the right to a jury trial as guaranteed by the Seventh Amendment has been regularly rejected. *In re Financial Securities Litigation*, 609 F.2d 411, 432, (9th Cir. 1979) cert. denied sub nom., *Gant v. Union Bank*, 446 U.S. 929 (1980); *SRI International v. Matsushita Electric Corp. of America*, 775 F.2d 1107 (Fed. Cir. 1985) (Markey, C.J., additional views.).

The Seventh Amendment's application to patent cases does not include a disclaimer of nonapplicability when the material is allegedly too difficult for a jury to comprehend. The Constitution does not so denigrate the intelligence of its citizens. "We discern no authority and no compelling need to apply in patent infringement suits for damages a 'complexity' exception denying litigants their constitutional right under the Seventh Amendment." *SRI*, 775 F.2d at 1130.

As the Chief Justice has observed:

[N]o amount of argument that the device provides for more efficiency or more accuracy or is fairer will save it if the degree of invasion of the jury's province is greater than allowed in 1791. The rule otherwise would effectively permit judicial repeal of the Seventh Amendment . . .

The guarantees of the Seventh Amendment will prove burdensome in some instances; the civil jury was surely a burden to the English governors who, in its stead, substituted the vice-admiralty court. But, as with other provisions of the Bill of Rights, the onerous nature of the protection is no license for contracting the right secured by the Amendment.

Parklane Hosiery Co. v. Shore, 439 U.S. 322, 348 (Rehnquist, C.J., dissenting).

Although the majority below did not directly state its holding was based on the complex nature of the patent claim interpretation, it nonetheless has the effect of creating a complexity exception to the Seventh Amendment. Thus this concept should continue to be rejected by this Court and the erroneous decision of the court below should be reversed.

CONCLUSION

For the foregoing reasons stated above, the ATLA respectfully requests this Court to reverse the decision of the courts below.

Respectfully submitted,

JEFFREY ROBERT WHITE
1050 31st St., N.W.
Washington, DC 20007
(202) 965-3500

JOSEPH W. COTCHETT
MARIE SETH WEINER
COTCHETT & PITRE
San Francisco Airport Office Center
840 Malcolm Road, Suite 200
Burlingame, CA 94010
(415) 697-6000

CLYDE H. WILSON, JR.
WILSON, JOHNSON & JAFFER, P.A.
27 South Orange Avenue, Suite One
Sarasota, FL 34236
(813) 955-5800

Counsel for Amicus Curiae:
Association of Trial Lawyers of America

November 9, 1995
|

No. 95-26

10

Supreme Court, U. S.

FILED

NOV 9 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF LITTON SYSTEMS, INC.,
AS AMICUS CURIAE
IN SUPPORT OF PETITIONERS**

FREDERICK A. LORIG
BRIGHT & LORIG
633 West 5th Street
Los Angeles, CA 90274
(213) 627-7774

JOHN E. PRESTON
VICTORIA T. MCGHEE
LITTON INDUSTRIES
21240 Burbank Blvd.
Woodland Hills, CA 93167

LAURENCE H. TRIBE
Counsel of Record
JONATHAN S. MASSEY
KENNETH J. CHESEBRO
1575 Massachusetts Avenue
Hauser Hall 420
Cambridge, MA 02138
(617) 495-4621

Counsel for Amicus Curiae

November 9, 1995

39 PM

TABLE OF CONTENTS

INTEREST OF <i>AMICUS CURIAE</i>	1
INTRODUCTION AND SUMMARY OF ARGUMENT	1
ARGUMENT	6
I. THE DECISION BELOW INVADES THE JURY'S CONSTITUTIONAL ROLE BY ERASING THE DISTINCTION BETWEEN LAW AND FACT	7
II. THE BASES OF THE FEDERAL CIRCUIT'S DECISION ARE FLAWED	19
A. The Seventh Amendment Cannot Be Circumvented by Resorting to A Strained Analogy Between Patents and Statutes	19
B. The Decision Below Cannot Be Defended By Assuming That 35 U.S.C. § 112 Requires Claims to Be Written So That They Are Not Ambiguous to Lawyers	25
C. No Policy Concerns Could Possibly Justify Violating The Seventh Amendment	27
CONCLUSION	30

TABLE OF AUTHORITIES

Cases	Pages
<i>Arachnid Inc. v. Medalist Mktg. Corp.</i> , 972 F.2d 1300 (Fed. Cir. 1992)	9
<i>Atlas Powder Co. v. E.I. du Pont de Nemours & Co.</i> , 750 F.2d 1569 (Fed. Cir. 1984)	18
<i>Baltimore & Carolina Line, Inc. v. Redman</i> , 295 U.S. 654 (1935)	13
<i>Barrows v. Jackson</i> , 346 U.S. 249 (1953)	20
<i>Beacon Theatres, Inc. v. Westover</i> , 359 U.S. 500 (1959)	2, 11-12
<i>Bi-Metallic Inv. Co. v. State Bd. of Equalization</i> , 239 U.S. 441 (1915)	19
<i>Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation</i> , 402 U.S. 313 (1971)	20
<i>Blunt v. Patten</i> , F. Cas. No. 1579 (C.C.N.Y. 1828)	23
<i>Brisk v. Miami Beach</i> , 726 F. Supp. 1305 (S.D. Fla. 1989)	23
<i>Brooktree Corp. v. Advanced Micro Devices, Inc.</i> , 977 F.2d 1555 (Fed. Cir. 1992)	8
<i>Brown v. Piper</i> , 91 U.S. 37 (1875)	17
<i>Cardinal Chemical Co. v. Morton Intern., Inc.</i> , 113 S. Ct. 1967 (1993)	20
<i>Carnegie Steel v. Cambria Iron Co.</i> , 185 U.S. 403 (1901)	1, 8, 25
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986)	5
<i>CFTC v. Schor</i> , 478 U.S. 833 (1986)	24
<i>Chandris, Inc. v. Latsis</i> , 115 S. Ct. 2172 (1995)	4, 22
<i>Charles Greiner & Co. v. Mari-Med Mfg., Inc.</i> , 962 F.2d 1031 (Fed. Cir. 1992)	28
<i>Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry</i> , 494 U.S. 558 (1990)	11, 25
<i>Christian v. Colt Industries Operating Corp.</i> , 822 F.2d 1544 (Fed. Cir. 1987), vacated and remanded on other grounds, 486 U.S. 800 (1988)	27
<i>Colgrove v. Battin</i> , 413 U.S. 149 (1973)	13
<i>Colonial Ford, Inc. v. Ford Motor Co.</i> , 592 F.2d 1126 (10th Cir.), cert. denied, 444 U.S. 837 (1979)	22
<i>Connally v. General Constr. Co.</i> , 269 U.S. 385 (1939)	23
<i>Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works</i> , 709 F.2d 403 (5th Cir. 1983)	9

Cases (continued)	Pages
<i>Control Components, Inc. v. Valtek, Inc.</i> , 609 F.2d 763 (5th Cir.), cert. denied, 449 U.S. 1022 (1980)	9
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	11
<i>Credle v. Bond</i> , 25 F.3d 1566 (Fed. Cir. 1994)	26
<i>Crowell v. Benson</i> , 285 U.S. 22 (1932)	24
<i>Curtis v. Loether</i> , 415 U.S. 189 (1974)	11, 22
<i>Dairy Queen, Inc. v. Wood</i> , 369 U.S. 469 (1962)	2, 12
<i>Daubert v. Merrell Dow Pharmaceuticals, Inc.</i> , 113 S. Ct. 2786 (1993)	28
<i>Delta-X Corp. v. Baker Hughes Production Tools, Inc.</i> , 984 F.2d 410 (Fed. Cir. 1993)	8
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	6
<i>Duncan v. Louisiana</i> , 391 U.S. 145 (1968)	13
<i>Edmonson v. Leesville Concrete Co.</i> , 500 U.S. 614 (1991)	6
<i>Ex parte Bakelite Corp.</i> , 279 U.S. 438 (1929)	24
<i>Exxon Chemical Patents, Inc. v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995)	29
<i>Gardco Mfg., Inc. v. Herst Lighting Co.</i> , 820 F.2d 1209 (Fed. Cir. 1987)	19
<i>Gasoline Prods. Co. v. Champlin Ref. Co.</i> , 283 U.S. 494 (1931)	12
<i>Georgia-Pacific Corp. v. United States Plywood Corp.</i> , 258 F.2d 124 (2d Cir.), cert. denied, 358 U.S. 884 (1958)	26
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	4, 20
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	17
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	11, 16, 24
<i>Graver Tank & Mfg. Co. v. Linde Air Prods. Co.</i> , 339 U.S. 605 (1950)	18
<i>H.H. Robertson Co. v. United Steel Deck, Inc.</i> , 820 F.2d 384 (Fed. Cir. 1987)	8
<i>Hall Lab., Inc. v. Economics Lab., Inc.</i> , 169 F.2d 65 (8th Cir. 1948)	9
<i>Harries v. Air King Prods. Co.</i> , 183 F.2d 158 (2d Cir. 1950)	8
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	17
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995) (en banc)	7, 8, 21
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	17

<i>Cases (continued)</i>	<i>Pages</i>
<i>Hormone Research Found. v. Genentech, Inc.</i> , 904 F.2d 1558 (Fed. Cir. 1990), <i>cert. dismiss'd</i> , 499 U.S. 955 (1991)	26
<i>Hurin v. Electric Vacuum Cleaner Co.</i> , 298 F. 78 (6th Cir. 1924)	9
<i>Hybritech, Inc. v. Monoclonal Antibodies, Inc.</i> , 802 F.2d 1367 (Fed. Cir. 1986), <i>cert. denied</i> , 480 U.S. 947 (1987)	26
<i>In re Financial Securities Litig.</i> , 609 F.2d 411 (9th Cir. 1979), <i>cert. denied</i> , 446 U.S. 929 (1980)	28
<i>In re Lockwood</i> , 50 F.3d 966 (Fed. Cir. 1995), <i>cert. granted</i> , 115 S. Ct. 2274 (1995), <i>vacated and remanded</i> , 64 U.S.L.W. 3182 (U.S. Sept. 1, 1995)	7
<i>Key Mfg. Group, Inc. v. Microdot, Inc.</i> , 925 F.2d 1444 (Fed. Cir. 1991)	28
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	19
<i>Kian v. Mirro Aluminum Co.</i> , 88 F.R.D. 351 (E.D. Mich. 1980)	28
<i>Laitram Corp. v. NEC Corp.</i> , 62 F.3d 1388 (Fed. Cir. 1995)	29
<i>Lemelson v. General Mills Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992), <i>cert. denied</i> , 113 S. Ct. 976 (1993)	9, 20
<i>Litton Systems, Inc. v. Honeywell, Inc.</i> , Nos. 95-1242, 95-1311 (Fed. Cir.) (pending)	1
<i>Litton Systems, Inc. v. Sunstrand Corp.</i> , 750 F.2d 952 (Fed. Cir. 1984)	1
<i>Litton Systems, Inc. v. Whirlpool Corp.</i> , 728 F.2d 1423 (Fed. Cir. 1984)	1
<i>Lytle v. Household Mfg., Inc.</i> , 494 U.S. 545 (1990)	22
<i>Machine Co. v. Murphy</i> , 97 U.S. 120 (1877)	18
<i>Marks v. United States</i> , 430 U.S. 188 (1977)	23
<i>Martin v. Wilks</i> , 490 U.S. 755 (1989)	12, 20
<i>McDermott Intern., Inc. v. Wilander</i> , 498 U.S. 337 (1991)	22
<i>McGill, Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir. 1984)	8
<i>Medcalf v. Kansas</i> , 626 F. Supp. 1179 (D. Kan. 1986)	23
<i>Miles Laboratories, Inc. v. Shandon, Inc.</i> , 997 F.2d 870 (Fed. Cir. 1993)	26
<i>Mistretta v. United States</i> , 488 U.S. 361 (1988)	19
<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986)	8
<i>Morgan v. Labiak</i> , 368 F.2d 338 (10th Cir. 1966)	23

<i>Cases (continued)</i>	<i>Pages</i>
<i>Northern Pipeline Construction Co. v. Marathon Pipe Line Co.</i> , 458 U.S. 50 (1982)	24
<i>Orthokinetics, Inc. v. Safety Travel Chairs, Inc.</i> , 806 F.2d 1565 (Fed. Cir. 1986)	26
<i>Pacemaker Diagnostic Clinic of America, Inc. v. Instromedix, Inc.</i> , 725 F.2d 537 (9th Cir.) (<i>en banc</i>), <i>cert. denied</i> , 469 U.S. 824 (1984)	24
<i>Pall Corp. v. Micron Separations, Inc.</i> , Nos. 91-1393, <i>et al.</i> , 1995 U.S. App. LEXIS 27366 (Fed. Cir. Sept. 26, 1995)	3, 7, 8, 29
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	9, 28
<i>Parkland Hosiery Co. v. Shore</i> , 439 U.S. 322 (1979)	5, 6, 13-14
<i>Parsons v. Bedford</i> , 28 U.S. (3 Pet.) 433 (1830)	3, 13
<i>Patlex Corp. v. Mossinghoff</i> , 758 F.2d 594, <i>modified on reh'g</i> , 771 F.2d 480 (Fed. Cir. 1985)	24
<i>Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	4, 21
<i>Quaker City Gear Works, Inc. v. Skil Corp.</i> , 747 F.2d 1446 (Fed. Cir. 1984), <i>cert. denied</i> , 471 U.S. 1136 (1985)	27
<i>Radial Lip Mach., Inc. v. International Carbide Corp.</i> , 76 F.R.D. 224 (N.D. Ill. 1977)	28
<i>Ralston Purina Co. v. Far-Mar-Co., Inc.</i> , 772 F.2d 1570 (Fed. Cir. 1985)	27
<i>Reed v. Proprietors of Locks & Canals on Merrimac River</i> , 49 U.S. (8 How.) 274 (1850)	20-21
<i>Rexnord, Inc. v. Modern Handling Systems, Inc.</i> , 379 F. Supp. 1190 (D. Del. 1974)	23
<i>Roberts v. Sears, Roebuck & Co.</i> , 723 F.2d 1324 (7th Cir. 1983)	8
<i>Royer v. Schultz Brewing Co.</i> , 135 U.S. 319 (1890)	11
<i>Shelley v. Kraemer</i> , 334 U.S. 1 (1948)	20
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1852)	2, 15-16, 22
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1903)	17
<i>SmithKline Diagnostics, Inc. v. Helena Lab. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988)	9
<i>Specialty Composites v. Cabot Corp.</i> , 845 F.2d 981 (Fed. Cir. 1988)	18

Cases (continued)	Pages
<i>Spectra-Physics v. Coherent</i> , 827 F.2d 1524 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987)	27
<i>SRI Int'l v. Matsushita Elec. Corp.</i> , 775 F.2d 1107 (Fed. Cir. 1985) (<i>en banc</i>)	5
<i>Structural Rubber Prods. Co. v. Park Rubber Co.</i> , 749 F.2d 707 (Fed. Cir. 1984)	9
<i>Sugarman v. Dougall</i> , 413 U.S. 634 (1973)	12
<i>Therma-Tru Corp. v. Peachtree Doors, Inc.</i> , 44 F.3d 988 (Fed. Cir. 1995)	18, 27
<i>Thomas v. Union Carbide Agricultural Prods. Co.</i> , 473 U.S. 568 (1985)	24
<i>Tights, Inc. v. Acme-McCrary Corp.</i> , 541 F.2d 1047 (4th Cir.), cert. denied, 429 U.S. 980 (1976)	9
<i>Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg.</i> <i>Gesellschaft m.b.H.</i> , 945 F.2d 1546 (Fed.Cir.1991)	8
<i>Triplett v. Lowell</i> , 297 U.S. 638 (1936)	20
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	2, 16
<i>Tyler v. Boston</i> , 74 U.S. (7 Wall.) 327 (1869)	11
<i>U.S. Envtl. Prods. v. Westall</i> , 911 F.2d 713 (Fed. Cir. 1990)	18
<i>United States v. Gaudin</i> , 115 S. Ct. 2310 (1995)	4, 22
<i>United States v. Telectronics, Inc.</i> , 857 F.2d 778 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989)	9
<i>United States v. Wonson</i> , 28 F. Cas. 745 (1812)	6
<i>Utter v. Hiraga</i> , 845 F.2d 993 (Fed. Cir. 1988)	26
<i>Walker v. New Mexico Railroad Co.</i> , 165 U.S. 593 (1897)	12
<i>Wang Laboratories, Inc. v. Toshiba Corp.</i> , 993 F.2d 858 (Fed. Cir. 1993)	27
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	16
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1858)	17

Constitutional Provisions, Statutes and Rules	Pages
U.S. Consitution, Seventh Amendment	<i>passim</i>
Judiciary Act of 1789	14-15
15 U.S.C. § 1221(a)	22
35 U.S.C. §§ 3-7	8
35 U.S.C. § 103	8, 17
35 U.S.C. § 112	<i>passim</i>
37 C.F.R. §§ 1.101-1.110	8
37 C.F.R. § 10.6(b)	8
42 U.S.C. § 1983	23
Fed. R. Evid. 706	28

Legislative Materials

<i>Hearings on the Federal Courts Improvement Act of 1979 Before the Senate Judiciary Subcommittee on Improvements in Judicial Machinery</i> , 96th Cong., 1st Sess. 114 (1979)	15
H.R. Rep. No. 312, 97th Cong., 1st Sess. 18-19 (1981)	15
S. Rep. No. 275, 97th Cong., 1st Sess. 2, 6 (1981), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 12	15

Miscellaneous

43 Am. Jur.2d <i>Interference</i> (1968 & 1994 supp.)	20
<i>The American Jury: A Justification</i> , 1 VALPARAISO L. REV. 1 (1966)	6
Annot., <i>Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties</i> , 6 A.L.R.4th 195 (1994)	20
Bernard Bailyn, <i>THE ORIGINS OF AMERICAN POLITICS</i> (1968)	14
Brookings Institution, <i>CHARTING A FUTURE FOR THE CIVIL JURY</i> (1992)	28
<i>The Civil Jury in Historical Perspective</i> , in <i>THE AMERICAN CIVIL JURY</i> (1987)	6
<i>THE COMPLETE ANTI-FEDERALIST</i> (H. Storing ed. 1981)	14
Arthur L. Corbin, <i>CORBIN ON CONTRACTS</i> (1960)	10

<i>Miscellaneous (continued)</i>	<i>Pages</i>
Michael C. Dorf, <i>A Comment on Text, Time and Audience Understanding in Constitutional Law</i> , 73 WASH. L.Q. 983 (1995)	23
THE FEDERALIST NO. 83 (H. Lodge ed. 1888)	14
Hon. Patrick Higginbotham, <i>Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power</i> , 56 TEX. L. REV. 47 (1977)	3, 13
Homer Carey Hockett, <i>THE CONSTITUTIONAL HISTORY OF THE UNITED STATES</i> (1939)	14
W. Holdsworth, <i>A HISTORY OF ENGLISH LAW</i> (1966)	13
Martin B. Louis, <i>Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion</i> , 64 N.C. L. REV. 993 (1986)	12
<i>Manual for Complex Litigation (Second)</i> (1986)	28
J. Wilson Parker, <i>Free Expression and the Function of the Jury</i> , 65 B.U. L. REV. 483 (1985)	13-14
Roscoe Pound, <i>THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY</i> (1957)	14
RESTATEMENT (SECOND) OF CONTRACTS (1981)	10
RESTATEMENT (SECOND) OF TORTS (1979)	19
William C. Robinson, <i>THE LAW OF PATENTS FOR USEFUL INVENTIONS</i> § 1037 (1890)	17, 21
A.H. Walker, <i>TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA</i> (4th ed. 1904)	17
Carl Ubbelohde, <i>THE VICE-ADMIRALTY COURTS AND THE AMERICAN REVOLUTION</i> (1960)	13
Charles Warren, <i>New Light on the History of the Federal Judiciary Act of 1789</i> , 37 Harv. L. Rev. 49 (1923)	15
Samuel Williston, <i>A TREATISE ON THE LAW OF CONTRACTS</i> (3d ed. 1961)	20
Charles Wolfram, <i>The Constitutional History of the Seventh Amendment</i> , 57 MINN. L. REV. 639 (1973)	6, 13
Charles Alan Wright & Arthur Miller, <i>FEDERAL PRACTICE & PROCEDURE</i> (1973 & 1995 supp.)	11

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ *amicus curiae* Litton Systems, Inc. ("Litton"), hereby submits this brief in support of petitioners Herbert Markman and Positek, Inc. Although Litton has no direct interest in the outcome of the case at bar, it has a strong and abiding interest in the question presented concerning the constitutionally guaranteed role of the jury in patent disputes. As a technology-based company whose business depends heavily on innovation and intellectual property, Litton is sometimes involved in litigation to protect the valuable patents it holds.² In such litigation, Litton is entitled to the jury-trial rights granted by the Constitution.

INTRODUCTION AND SUMMARY OF ARGUMENT

In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit has held that "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of *law* exclusively for the court," Pet. App. 5a (emphasis added),³ regardless of whether the definition of a disputed claim term can be found in the patent or its prosecution history and regardless of whether the definition turns on extrinsic technical or scientific evidence. The decision below is inconsistent with both clauses of the Seventh Amendment.

I. Interpreting a patent claim is a quintessentially *factual* inquiry into "what one of ordinary skill in the art at the time of the invention would have understood the term to mean." 48a. Patent claims are written from the perspective of those "skilled in the art." 35 U.S.C. § 112. "The specification of the patent is not addressed to lawyers" *Carnegie Steel v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902). The Federal Circuit itself acknowledged even in the decision

¹ Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

² See, e.g., *Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending); *Litton Systems, Inc. v. Sunstrand Corp.*, 750 F.2d 952 (Fed. Cir. 1984); *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

³ Citations to the Appendix to the Petition for Certiorari are styled "___a."

under review that interpreting a patent often requires weighing conflicting "expert and inventor testimony" bearing both on "'how those skilled in the art would interpret the claims,'" 31a (citation omitted), 33a, and on "the state of the prior art at the time of the invention." 33a. The Court of Appeals explained that it was "using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language." 36a. The Federal Circuit has frequently observed that interpreting a patent's scope requires a factfinder to "give consideration and weight to several underlying factual questions, including . . . the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991); see also *Silsby v. Foote*, 55 U.S. (14 How.) 218, 226 (1852) ("How could the judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts.").

In the decision below, however, the Federal Circuit overruled a decade of its own precedent and transformed disputed issues of fact into judicially resolvable issues of "law." The Court of Appeals reasoned that, however disputed they may be, factual issues subsumed or mixed in an overall legal question may be withdrawn from the jury and decided by the court or, if decided by the jury, may be freely re-examined by a reviewing court. But the central lesson of *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 470 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 511 (1959), is that an otherwise applicable right to jury trial cannot be lost simply because issues for the jury are intertwined with issues for the court. See also *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872) ("though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may, on this mixed question of law and fact, lay down to the jury which should govern them, . . . the ultimate response to the question must come from the jury").

The Federal Circuit's decision also ignores the second portion of the Seventh Amendment, the Re-Examination Clause, which provides that "no fact tried by jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." See *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.). In this case, the question of infringement was submitted to the jury, which found that respondents had infringed two of the three claims at issue. 13a. The jury was instructed to interpret the patent, and did so, as part of its decision. 16a. But the Federal Circuit held that the jury's verdict amounted to an advisory ruling on "a matter of law," to be re-examined freely by a district court and "reviewed *de novo* on appeal." 30a.

The Federal Circuit's remarkable decision would withdraw from the jury, even *after* it had rendered its verdict, the power to resolve disputes over how one "skilled in the art" would understand a disputed technical term. The Federal Circuit has claimed for itself the authority to decide this question *de novo*, even though it has no first-hand opportunity to evaluate credibility, weigh evidence, or perform any other of the usual tasks essential to factfinding.⁴

In the eighteenth century, arbitrary review by English courts — including the assertion of appellate power by the Privy Council in Westminster — was a principal grievance of the American colonists. Accordingly, the Seventh Amendment reflects a deliberate decision to restrict judicial power and particularly to limit "appellate jurisdiction over matters of fact." Hon. Patrick Higginbotham, *Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power*, 56 TEX. L. REV. 47, 50 (1977). *De novo* review by a distant Federal Circuit is no more appropriate than was review by a distant Privy Council in colonial times.

⁴ "To suggest that appellate judges, precious few of whom are trained in science, will always arrive at the 'true' meaning of words embodying complex concepts endows them with knowledge and enlightenment far beyond those who have training and experience in the field. They are in no position to declare the state of knowledge in the art or that scientific hypotheses are correct as a matter of law." *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, *et al.*, 1995 U.S. App. LEXIS 27366, *39 (Fed. Cir. Sept. 26, 1995) (Mayer, J., concurring in judgment).

If permitted to stand, the decision below would establish a dangerous principle that could not logically be confined to the context of patent claim interpretation or even to patent law. The Federal Circuit's error goes to the fundamental distinction between law and fact and the role of that distinction in the operation of the Seventh Amendment generally. Under the decision below, federal courts may — indeed, *must* — displace juries and arrogate to themselves the power to resolve factual issues whenever those issues are mixed with or immersed in a legal question such as claim interpretation. Until now, it has always been thought that the ultimately legal nature of questions like "negligence" in a tort case, the "reasonableness" of a restraint of trade in an antitrust case, or the "breach" in a contract case does not authorize a judge to strip a jury of the power to decide subsidiary issues of disputed fact. Yet the Federal Circuit's reasoning would justify just such an unconstitutional invasion of the jury's domain.

II. The Federal Circuit maintained that the interpretation of a patent is analogous to the construction of a statute and therefore a matter of law exclusively for the court. But this Court has held that patents are properly analogous to contracts or deeds, not to statutes. See *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (contract); *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (deed). In any event, how a particular term was understood in the relevant community at a given point in time is *precisely* the kind of adjudicative fact that, when legally relevant, is routinely submitted to a jury for resolution *even in the statutory context*. For example, this Court recently held, unanimously, that a jury is required to determine whether a given statement was "material" within the meaning of the federal securities laws, on the ground that this is "a 'mixed question of law and fact' [that] has typically been resolved by juries." *United States v. Gaudin*, 115 S. Ct. 2310, 2314 (1995). This Court has also held that "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995).

Nor can the decision below be justified as promoting predictability in claim interpretation. District court judges are free

to disagree with one another, as are different panels of the Federal Circuit. In any event, "the concerns for the institution of jury trial that led to . . . the Seventh Amendment were not animated by a belief that use of juries would lead to more efficient judicial administration." *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 343 (1979) (Rehnquist, now C.J., dissenting). As former Chief Judge Markey has observed:

However some may view what they see as a "better system," . . . judges are nowhere authorized to exercise their personal predilection by revising or repealing the Seventh Amendment. The arguments supporting denial of a jury demand in complex civil cases are clearly submissible to the Congress or to the States in support of a proposal under Article V of the Constitution; they are not appropriately submissible to judges sworn to uphold that Constitution. . . .

SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1128-29 (Fed. Cir. 1985) (*en banc*) (separate opinion).

To be sure, when the evidence regarding the proper interpretation and construction of a patent claim does not give rise to a *genuine* factual dispute, the judge may rule on the construction of the claim as a matter of law. Summary judgment is available in patent cases as in any other. *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). But when there are disputed factual questions bearing on a federal suit seeking damages for patent infringement, a jury must be called upon to resolve those factual questions — just as in other areas of the law where the underlying right to jury trial is not in doubt.

The judgment of the Court of Appeals should be vacated and the case remanded to permit the Federal Circuit to decide in the first instance whether there is a genuine factual dispute over the meaning of the particular patent claim at issue in this case.⁵

⁵ This Court could not, without undertaking an independent review of the record in this case, affirm the judgment on the alternative ground that there was no genuine factual dispute about the meaning of the term "inventory." Although one judge, writing separately, relied on such reasoning in concurring in the judgment below, see 81a-82a (Rader, J., concurring), the opinion for the court expressly rejected such an approach. See 55a. Accordingly, there was no majority in the Federal Circuit for the proposition that — were the Court of Appeals wrong about the constitutional

ARGUMENT

The pivotal importance of the Seventh Amendment in our constitutional scheme is illustrated by its central role in stimulating the creation of the entire Bill of Rights.⁶ The jury is, in the words of legal historian and Judge Morris Arnold, "the single most important institution in the history of Anglo-American law."⁷ Accordingly, "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).

The Federal Circuit's decision cannot survive such scrutiny. Judge Newman observed that "[t]his holding not only raises a constitutional issue of grave consequence, but the court creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust." 84a (dissenting opinion). She filed a lengthy opinion exhaustively documenting the logical, historical, and constitutional flaws in the Federal Circuit's decision. See 84a-158a. Judge Mayer, writing separately, predicted that the decision would lead to "turbulence and cynicism in patent litigation." 57a (opinion concurring in the judgment). He maintained that the holding "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment" and "marks a sea change in the course of patent law

question — the district court's judgment could be affirmed on the alternate ground suggested by Judge Rader.

⁶ See, e.g., Charles Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 657 (1973) ("the entire issue of a Bill of Rights was precipitated at the Philadelphia Convention by an objection that the document under consideration lacked a specific guarantee of jury trial in civil cases"); see generally *Edmonson v. Leesville Concrete Co.*, 500 U.S. 614, 624 (1991); *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 338-44 (1979) (Rehnquist, now C.J., dissenting); *United States v. Wonson*, 28 F. Cas. 745, 750 (1812) (Story, Circuit Justice); Justice Clark, *The American Jury: A Justification*, 1 VALPARAISO L. REV. 1, 1-7 (1966).

⁷ *The Civil Jury in Historical Perspective*, in THE AMERICAN CIVIL JURY 9-10 (1987).

that is nothing short of bizarre." *Id.* Judge Mayer warned that "today's action is of a piece with a broader bid afoot to essentially banish juries from patent cases altogether." 58a.⁸

If permitted to stand, the decision below would establish a principle threatening the settled role of the jury in resolving factual disputes throughout patent law and in many (and perhaps most) other kinds of federal civil litigation.

I. THE DECISION BELOW INVADES THE JURY'S CONSTITUTIONAL ROLE BY ERASING THE DISTINCTION BETWEEN LAW AND FACT

1. Patents are addressed to those skilled in the art, not to those in the legal community. A patent's construction depends on "how one of ordinary skill in the relevant art at the time of the invention would comprehend the disputed word or phrase in view of the patent claims, specification, and prosecution history."⁹ Patent claims must distinctly describe the invention to those skilled in the art, not to lawyers. 35 U.S.C. § 112. Claims must be non-obvious to those

⁸ This note of caution was not without basis. Judge Nies, a member of the *Markman* majority, had previously argued that "[a] constitutional jury right to determine validity of a patent does not attach to this public grant. Congress could place the issue of validity entirely in the hands of an Article I trial court with particular expertise if it chose to do so." *In re Lockwood*, 50 F.3d 966, 983 (Fed. Cir. 1995) (opinion dissenting from order denying rehearing in banc), cert. granted, 115 S. Ct. 2274 (1995), vacated and remanded, 64 U.S.L.W. 3182 (U.S. Sept. 1, 1995).

Similarly, in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*) (*per curiam*), a substantial minority of the Federal Circuit, each of whom was in the majority in *Markman*, argued that the factual issue of infringement under the doctrine of equivalents (see p. 18, n.27, *infra*) was for the court, not the jury, to decide. Circuit Judge Plager, joined by Chief Judge Archer and Circuit Judges Rich and Lourie, maintained that, "[i]f we go wrong" in withdrawing the matter from the jury, "the Supreme Court, sooner or later, will correct us." *Id.* at 1545 (dissenting opinion).

⁹ *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, et al., 1995 U.S. App. LEXIS 27366, *35-36 (Fed. Cir. Sept. 26, 1995) (Mayer, J., concurring in judgment).

skilled in the art, not to lawyers. *Id.* at § 103. Patents must be sufficiently detailed to enable one skilled in the art — not a lawyer — to practice the invention. *Carnegie Steel*, 185 U.S. at 437.

As the Federal Circuit itself noted in the decision below, "[a] judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed." 50a. Thus, while patent examiners are technically proficient, they are not required to have a law degree. 35 U.S.C. §§ 3-7; 37 C.F.R. §§ 1.101-1.110. Similarly, patent agents without law degrees (but with technical degrees) are licensed by the U.S. Patent and Trademark Office to prosecute patents. 37 C.F.R. § 10.6(b).

What meaning a person skilled in the relevant art would assign to a particular patent term is necessarily a question of empirical fact, verifiable or falsifiable by the weighing of evidence and the evaluation of the credibility of competing testimony. In the words of Learned Hand, "[t]he question [is] how the art understood the term, which [is] plainly a question of fact. . . . It is an issue which we are altogether incompetent to decide upon the merits" *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d Cir. 1950).¹⁰ Indeed, the Federal Circuit has recognized on many occasions that

¹⁰ E.g., *Pall Corp. v. Micron Separations, Inc.*, Nos. 91-1393, *et al.*, 1995 U.S. App. LEXIS 27366, *9-10 (Fed. Cir. Sept. 26, 1995) (whether one of ordinary skill would understand "skinless" in terms of specific pore size and shape or instead as the absence of a visible membrane when viewed through electron microscope); *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993) (whether an "electrical comparator" is the same thing as a computer); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1577 (Fed. Cir. 1992) (whether, in a patent for circuitry in a semiconductor chip, the technical term "overriding the operation" required a current source and a voltage source to be present simultaneously in a circuit); *Tol-O-Matic*, 945 F.2d at 1550 (how much support is implied by term "provide for lateral support" in piston assembly); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987) (whether "bottomless trench" design for electrical wiring covered assemblies in which only key portion of the trench was bottomless); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656-57 (Fed. Cir. 1986) (whether term "electrode" included entire length of silver wire, or just tip); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (whether "recovered liquid hydrocarbon absorbent": (1) "means an undefined absorbent that is capable of recovering" liquid hydrocarbon; or (2) "means that the recovered liquid hydrocarbon is being used as an absorbent").

"interpretation of a claim may depend upon evidentiary material about which there is a factual dispute, requiring resolution of factual issues as a basis for interpretation of the claim." *United States v. Teletronics, Inc.*, 857 F.2d 778, 781 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989).¹¹

Even in the decision under review, the Federal Circuit cited — as bearing on the issue of claim construction — the very kind of evidence that, if the subject of a genuine dispute, must be regarded as peculiarly within the jury's domain: expert testimony, "including

¹¹ See also *Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992) (although claim construction is issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); *Lemelson v. General Mills Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993) (the "underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement"); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (claim "interpretation may depend . . . on evidentiary material which requires resolution of factual issues, such as what occurred during the prosecution history"); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985) (when meaning of claim term is disputed, a "factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction"); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 721-22 n.14 (Fed. Cir. 1984) ("claim construction, dependent on resolution of a factual dispute, does present a jury question").

Pre-Federal Circuit decisions of the regional courts of appeals also recognized that the "proper meaning" of a disputed patent term is "a factual issue to be determined by the jury." *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980); see also *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047, 1060 (4th Cir.) ("if an issue presents a mixed question of fact and law, it may be submitted if the jury is instructed as to the legal standard to be applied"), *cert. denied*, 429 U.S. 980 (1976); *Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works*, 709 F.2d 403, 406 (5th Cir. 1983) ("the interpretation of the phrase [in the patent] was properly a jury determination"); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("In case of a controversy as to the construction of a patent claim, it may usually be true . . . that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved."); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1338 (7th Cir. 1983) ("a factual dispute as to the meaning of a term of art used in the patent claim, the resolution of which required resort to expert testimony, properly would have been submitted to the jury"); *Hall Lab., Inc. v. Economics Lab., Inc.*, 169 F.2d 65, 66-67 (8th Cir. 1948) ("[T]he construction of patent claims where extrinsic evidence is required to determine the meaning of technical terms also involves questions of fact.").

evidence of how those skilled in the art would interpret the claims," 31a (citation omitted); the history of the patent's prosecution in the Patent and Trademark Office, 32a-33a; and other sorts of extrinsic evidence, such as sales literature and testimony of the inventor. 33a.

Resolving disputes over these matters produces a *factual* finding regarding the proper *interpretation* of a patent's terms. This *descriptive* factual finding — what a term actually signifies to the relevant community — in turn informs the *construction* of the document's operative legal effect.¹² To be sure, the latter *normative* determination remains ultimately with the court, but it must — given the Re-Examination Clause — be undertaken in accord with the jury's legally relevant, and oftentimes decisive, findings of fact.

2. In its decision below, the Federal Circuit rejected that conclusion, as well as the Seventh Amendment principles that compel it. The court asserted that, because the ultimate question of patent claim *construction* is a "legal issue," any subsidiary factual questions of claim *interpretation* must be decided by a judge rather than a jury. This reasoning is both demonstrably fallacious and inherently uncontainable. That the legal construction of a patent's scope is, in the end, necessarily a matter of law manifestly does not imply that a judge rather than a jury may decide every issue of disputed fact that arises during the course of claim interpretation — or that a judge may ignore the Re-Examination Clause and determine *de novo* what a patent claim in fact means in the relevant community. Otherwise, all questions of fact that are in the end subsumed in an issue of law — e.g., negligence, causation, or unreasonableness of a restraint of trade — would be tried exclusively to the court.

The Court of Appeals' decision ignores the difference between (a) the traditional Seventh Amendment inquiry into what kinds of *lawsuits* fall outside the historic category of "suits at common law,"

¹² See 3 Arthur L. Corbin, CORBIN ON CONTRACTS § 534 (1960) ("By 'interpretation of language' we determine what ideas that language induces in other persons. By 'construction of the contract,' as that term will be used here, we determine its legal operation — its effect upon the action of courts and administrative officials."); RESTATEMENT (SECOND) OF CONTRACTS § 200 and Comment c (1981) (describing the distinction between "construction" and "interpretation" as reflecting the difference between the "meaning" of a term and its "legal effect"); see also 86a-92a (Newman, J., dissenting).

such that no jury trial right attaches; and (b) the entirely novel inquiry (which is incompatible with the Seventh Amendment) into what kinds of *factual disputes*, embedded within lawsuits undeniably falling inside the historic jury-trial category,¹³ nonetheless appear so "legal" in character that those facts may be decided by the court rather than the jury.

The first inquiry is a familiar one that focuses on the nature of the litigation, including both the cause of action involved and the remedy sought. See *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990); *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989). But the second, newly minted inquiry is incoherent from start to finish, inasmuch as *every* factual issue that arises in any trial must of necessity arise because it has some relevance to — that is, some logical bearing upon — a question of law that in turn governs, or at least contributes to, the resolution of the ultimate dispute.

Even under the first, conventional kind of Seventh Amendment inquiry, this Court has made clear that the right to jury trial on factual issues cannot be lost simply because those issues are submerged in legal or equitable questions to be resolved by a court. Thus, after lower courts had held that the presence of an equitable issue could eliminate the need to try a lawsuit before a jury,¹⁴ this Court intervened to clarify that, when claims for damages are joined with a request for equitable relief, the right to jury trial, "including all issues common to both claims, remains intact." *Curtis v. Loether*, 415 U.S. 189, 196 n.11 (1974) (discussing *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959)).

Just as lower courts, pre-*Beacon Theatres*, had erroneously held that a "dash of equity" could extinguish the right to jury trial, so the

¹³ Judge Newman, in dissent below, ably showed that patent infringement actions were tried before a jury at common law, 118a-129a, a conclusion that the majority did not dispute. 44a. See generally *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Royer v. Schultz Brewing Co.*, 135 U.S. 319, 325 (1890); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327, 330-31 (1869).

¹⁴ E.g., 9 Charles Alan Wright & Arthur Miller, FEDERAL PRACTICE & PROCEDURE § 2302.1 (1973 & 1995 supp.).

Federal Circuit, ignoring *Beacon Theatres* and *Dairy Queen*, has now held that the presence of a legal question, suitably mixed with the facts in dispute, could do the same. This error is even more egregious than that which led this Court to issue its course correction in *Beacon Theatres*, for "it would hardly take extraordinary ingenuity for a lawyer to find" questions of law mixed with questions of fact "at every turn in the road." *Sugarman v. Dougall*, 413 U.S. 634, 657 (1973) (Rehnquist, now C.J., dissenting). Thus, the Federal Circuit committed a truly fundamental constitutional error by failing to recognize that legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right whenever the controversy in which the dispute arises is jury-triable under the Seventh Amendment — regardless of how the facts fit into, or mix with, the legal matrix of the overall controversy.

3. The Federal Circuit's decision violates *both* clauses of the Seventh Amendment. As one scholar has commented, transforming issues of "fact" into "law" is "drastic in that it amounts to a direct judicial assault on the prerogatives of fact finders."¹⁵ The "classification of ultimate facts as questions of law amounts to a manipulation of the law-fact doctrine to take questions from the jury or to subject the trial level's resolution of questions to free appellate review."¹⁶ This Court has repeatedly made clear that the first clause of the Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico Railroad Co.*, 165 U.S. 593, 596 (1897); *see also Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 498 (1931).

The decision below also violates the second clause of the Seventh Amendment in cases like this one where a jury has already been entrusted with the responsibility of deciding disputed factual issues, such as the meaning that the relevant scientific community would

¹⁵ Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 1018 (1986).

¹⁶ *Id.* at 1028.

assign to a highly technical patent claim term. Here, the jury was instructed to "determine the meaning of the claims . . . using the relevant patent documents" and "other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art." 13a. The Federal Circuit subsequently held that it was free to re-decide that very question.

But the Re-Examination Clause, which this Court has long held to be a "substantial and independent clause" that is even "more important" than the preceding portion of the Amendment, *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.), "not only preserves th[e] jury trial] right but discloses a studied purpose to protect it from *indirect impairment* through possible enlargements of the power of reexamination existing under the common law." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935) (emphasis added); *see also Colgrove v. Battin*, 413 U.S. 149, 155 n.6 (1973).

The Re-Examination Clause was inserted into the Seventh Amendment in order to address "the vexing problem of appellate review of questions of fact." Wolfram, *supra* n.6, at 727. Indeed, the Seventh Amendment as a whole strikes a balance between the power of the jury and the power of the courts — particularly "appellate courts." Higginbotham, *supra*, at 50. "[T]he right to a jury trial and the corresponding limitation on appellate courts' review of fact were foremost in the minds of the Framers." J. Wilson Parker, *Free Expression and the Function of the Jury*, 65 B.U. L. REV. 483, 498 (1985).

The interference with the colonists' right to jury trial had been "one of the important grievances leading to the break with England." *Parkland Hosiery*, 439 U.S. at 340 (Rehnquist, now C.J., dissenting). Among the colonists' complaints were the extension of the jurisdiction of the reorganized courts of admiralty and vice-admiralty¹⁷ and the assertion of appellate review by the Privy Council

¹⁷ 11 W. Holdsworth, *A HISTORY OF ENGLISH LAW* 110 (1966); *see also Duncan v. Louisiana*, 391 U.S. 145, 152 (1968) ("Royal interference with the jury trial was deeply resented."); Carl Ubbelohde, *THE VICE-ADMIRALTY COURTS AND THE AMERICAN REVOLUTION* 210 (1960) ("the colonists came to believe passionately about this loss of jury trial"). Although these courts originally dealt with criminal offenses, "their jurisdiction was also extended to many areas of the civil law."

in London, which claimed the authority to disallow acts of colonial legislatures and overturn verdicts of colonial juries and judgments of colonial courts. 1 Homer Carey Hockett, *THE CONSTITUTIONAL HISTORY OF THE UNITED STATES* 55 (1939) (Council reviewed some 265 colonial cases). The colonists found this practice "expensive, dilatory, and vexatious." Roscoe Pound, *THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY* 77 (1957). The Council rejected attempts by the colonies to preserve the finality of their own judicial judgments.¹⁸ Such arbitrary review contributed to the colonists' belief that they were the victims of a remote, "centralized administration at Westminster which continually neglected or even positively injured [their] interests." *Id.* at 71; see also Bernard Bailyn, *THE ORIGINS OF AMERICAN POLITICS* 67-70 (1968).

The lesson was not forgotten during the framing of the Constitution and Bill of Rights. Opponents of the Constitution argued that "[e]very new tribunal erected for the decision of facts, without the intervention of a jury, . . . is a step toward establishing aristocracy." 4 *THE COMPLETE ANTI-FEDERALIST* 214 (H. Storing ed. 1981). Hamilton assured skeptics that the extension of "appellate jurisdiction" to "matters of fact" would not work "an implied supersedure of the trial by jury." *THE FEDERALIST* NO. 83, at 509 (H. Lodge ed. 1888). The Judiciary Act of 1789 stressed the jury's province over factual issues¹⁹ and flatly prohibited appellate review of these issues.²⁰

Parkland Hosiery, 439 U.S. at 341 (Rehnquist, now C.J., dissenting). Accordingly, "[t]he extensive use of vice-admiralty courts by colonial administrators to eliminate the colonists' right of jury trial was listed among the specific offensive English acts denounced in the Declaration of Independence." *Id.* at 340.

¹⁸ Colonial legislatures sought to bar review altogether, limit the time for appeals to the Privy Council, or limit the cases in which they might be brought. See Hockett, *supra*, at 54; Pound, *supra*, at 77. The Privy Council disregarded such attempts, reviewing some 50 cases on petition after colonial courts had refused to grant leave to appeal. See Hockett, *supra*, at 55 n.12.

¹⁹ "And the trial of issues in fact, in the district courts, in all causes except civil causes of admiralty and maritime jurisdiction, shall be by jury." 1 Stat. 77; see also 1 Stat. 81 (circuit courts); 1 Stat. 82 (Supreme Court).

²⁰ 1 Stat. 84-85; see also Parker, 65 B.U. L. REV. at 499 ("the congressional debate surrounding the Judiciary Act of 1789 shows the concern of the founding

The Federal Circuit's assertion of a *de novo* power to review determinations turning on credibility and the weighing of evidence flies in the face of this historical tradition. Indeed, nowhere else in the law does an appellate court wield such a singular power, and there is no indication that Congress, in creating the Federal Circuit, imagined that this Court of Appeals would possess it. In fact, Congress was assured that "the problem being addressed is at the appellate level, where the concern is the law, and only very rarely, if ever, the facts."²¹ The Committee reports warned that the Federal Circuit would not be permitted to supplement its own authority.²² Yet the decision under review represents a dramatic expansion of the Federal Circuit's power.

4. Not surprisingly, the Federal Circuit's decision is in square conflict with decisions of this Court, which have long recognized that underlying factual disputes regarding the construction of a patent claim are to be resolved by a jury where it is the trier of fact. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), for example, this Court concluded that the trial court properly "left . . . matter[s] of

fathers that elimination of the jury would result in a shift of power, not to the trial judge, but to the appellate courts"); Charles Warren, *New Light on the History of the Federal Judiciary Act of 1789*, 37 Harv. L. Rev. 49, 102-04 (1923) (discussing narrow scope of "writ of error").

²¹ *Hearings on the Federal Courts Improvement Act of 1979 Before the Senate Judiciary Subcommittee on Improvements in Judicial Machinery*, 96th Cong., 1st Sess. 114 (1979) (statement of Chief Judge Markey); see also H.R. Rep. No. 312, 97th Cong., 1st Sess. 18-19 (1981) ("the United States Court of Appeals for the Federal Circuit is an Article III court at the same level as the existing circuit courts of appeals. The new court will function like these other appellate courts . . . [T]he proposed new court is not a 'specialized court.'"); S. Rep. No. 275, 97th Cong., 1st Sess. 2, 6 (1981) (the Federal Circuit is an "Article III court that is similar in structure to the twelve other courts of appeals. . . . [It] will not be a 'specialized court'. . . ."), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 12, 16.

²² See S. Rep. No. 275, 97th Cong., 1st Sess. 4 (1981) ("[I]t is not the Committee's judgment that broader subject matter jurisdiction is intended for this court," and "any additional subject matter for the United States Court of Appeals for the Federal Circuit will require not only serious future evaluation, but new legislation."), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 14 (emphasis added).

fact to the jury" in construing a patent claim. *Id.* at 225.²³ Similarly, in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), this Court held that a prior patent and related expert testimony on the issue of "diversity or identity" were improperly withheld from the jury, and described the issue as a "mixed question of law and fact" that "must be submitted to the jury, if there is so much resemblance as raises the question at all." *Id.* at 455. In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the trial court "construed" the claim in a general manner and left it for the jury to fill in the specifics. This Court affirmed the trial court's refusal to define the patent claim in its entirety, explaining that "where the whole substance of the invention may be copied in a different form, it is the duty of the courts and juries to look through the form for the substance of the invention — for that which entitled the inventor to his patent, and which the patent was designed to secure." *Id.* at 343 (emphasis added).²⁴

²³ *Silsby* involved an appeal from a jury trial regarding a patent for an improvement in regulating the draft of stoves. The trial court determined that the patent covered "a combination of such of the described parts as were combined and arranged for producing a particular effect, viz., to regulate the heat of the stove." 55 U.S. (14 How.) at 225. But this legal construction of the patent claim still left some factual dispute as to the meaning of the patent's terms: what parts were necessary to regulate the heat of a stove? Accordingly, the trial court left to the jury the initial question of precisely which parts were covered by the claim as construed by the court. The defendants objected, "desir[ing] the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination." *Id.* But this Court rejected that challenge: "How could the Judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* at 226.

²⁴ The Federal Circuit maintained (at 34a) that cases like *Silsby* are no longer applicable in the wake of 35 U.S.C. § 112, which requires patentees to set out specifications of their claims. See Part II-B, *infra*. But the statute represented less of a change than the court thought, since even the first Patent Act, in 1790, required that letters patent "describ[e] the said invention or discovery, clearly, truly, and fully." See 74a-75a (Mayer, J., concurring in the judgment); 131a-135a (Newman, J., dissenting). Moreover, the majority's logic is a *non sequitur*. Even if the adoption of § 112 reduced the incidence of genuine factual disputes of the kind that arose in *Silsby*, it would not alter the fact that, when such disputes occur, they must be resolved by the jury. See *Granfinanciera*, 492 U.S. at 51 (even Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury").

Only when interpretation of patent claims presents no factual question has this Court permitted federal judges to construe them as a matter of law.²⁵ A noted commentator explained that, "[w]hen the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into and becomes an element in the interpretation of the Claim."²⁶

5. The submergence of factual questions within an ultimately legal issue is not limited to claim interpretation. Patent law is replete with issues that are ultimately *legal* in nature, but which contain subsidiary *factual* questions that must be resolved by a jury when it is the trier of fact. Thus, the novel principle announced by the Federal Circuit threatens the role of the jury in a wide range of patent cases — and in federal civil litigation generally, for there is no logical basis to limit the principle to patent suits.

This Court has recognized that, "[w]hile the ultimate question of patent validity is one of *law*, the § 103 condition [whether one of ordinary skill would find the patent 'nonobvious'] . . . lends itself to several basic *factual* inquiries." *Graham v. John Deere Co.*, 383

²⁵ See, e.g., *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1903) ("it is apparent from the face of the instrument that extrinsic evidence is not needed"); *Heald v. Rice*, 104 U.S. 737, 749 (1881) ("if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art . . . then the question of identity is one of pure construction, and not of evidence"); *Brown v. Piper*, 91 U.S. 37, 41, 44 (1875) (although evidence had been taken at trial, "[w]e think the patent was void on its face, and that the court might have stopped short at that instrument"); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858) (there was only one construction of the patent "which the language of this specification will admit"); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848) ("without the aid of experts and machinists, [we have] no difficulty in ascertaining, from the language used here, the meaning of the patent").

²⁶ 3 William C. Robinson, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 1037 (1890) (emphasis added) (hereafter "ROBINSON ON PATENTS"); see also A.H. Walker, *TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA* § 536 (4th ed. 1904) ("Where the question of infringement depends on the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left for the jury; and the dependent question of infringement should also be left for the jury to decide.").

U.S. 1, 17 (1966) (emphasis added). Those inquiries concern: "(1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art at the time when the invention was made; and (4) objective evidence of nonobviousness." *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 989 (Fed. Cir. 1988).

Similarly, this Court has held that the question of infringement under the doctrine of equivalents²⁷ is an issue of fact to be submitted to the jury. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609-10 (1950) ("A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including tests and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence."). The Federal Circuit recently reaffirmed that settled rule in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1521 (Fed. Cir. 1995) (*en banc*) (*per curiam*), although the court came within two votes of departing from it. Thus, under the decision below, a dispute regarding claim interpretation in an action alleging literal infringement is deemed to involve an issue of law, while interpretation of the same claim language under the doctrine of equivalents is left to the jury.

Other components of a patent's legal validity turn on additional underlying questions of fact. These include anticipation, *see, e.g.*, *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1573 (Fed. Cir. 1984), and prior public use or sale. *See, e.g.*, *U.S. Envtl. Prods. v. Westall*, 911 F.2d 713, 715 (Fed. Cir. 1990).²⁸

²⁷ The doctrine of equivalents holds that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same [for patent infringement purposes], even though they differ in name, form, or shape." *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877).

²⁸ The legal issue of a patent's enforceability also includes subsidiary factual questions. *See Therma-Tru*, 44 F.3d at 994-95 (reversing district court's finding that patent was unenforceable because "[t]he trial judge appears to have viewed himself as a jury of one, finding the facts of materiality and intent and applying the law to those facts. . . . Although the district court stated that 'the court served as factfinder' with respect to materiality and intent, the court may not make findings in conflict

In short, there is no principled way to distinguish the process of fact-finding used to resolve disputes regarding claim interpretation from the fact-finding employed in these other contexts in patent law. The precedential dangers of the Federal Circuit's decision are plain.

II. THE BASES OF THE FEDERAL CIRCUIT'S DECISION ARE FLAWED

A. The Seventh Amendment Cannot Be Circumvented by Resorting to A Strained Analogy Between Patents and Statutes

A principal basis of the Federal Circuit's decision was an ill-considered analogy between patents and statutes. 51a-52a. The court's reasoning was flawed.

1. The analogy between patents and statutes is misplaced. Patents are not "baby statutes," 80a n.8 (Mayer, J., concurring in the judgment), and the Patent and Trademark Office is not some "sort of junior-varsity Congress." *Mistretta v. United States*, 488 U.S. 361, 427 (1988) (Scalia, J., dissenting). For example, although a legislature is open and accountable to all, *see, e.g.*, *Bi-Metallic Inv. Co. v. State Bd. of Equalization*, 239 U.S. 441, 445-46 (1915), the patent process is essentially private. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877) ("patents are procured ex parte").

The Federal Circuit observed that patents are usually "enforceable against the public." 51a. But, of course, so are property rights and private contracts.²⁹ Moreover, the enforceability

with those of the jury [citing *Beacon Theatres*]. . . . In this case, the determinations of the jury and judge were simultaneous. However, this does not authorize judicial findings independent of and contrary to the facts found by the jury in reaching its verdict."); *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212-13 (Fed. Cir. 1987) (where factual issues relating to a legal claim for patent infringement are common with those relating to a defense of unenforceability based on inequitable conduct by the patentee, the jury must be allowed to decide the question of patent validity and the court's findings regarding inequitable conduct must be made in light of the jury's decision).

²⁹ For example, almost all States recognize that third parties may not tortiously interfere in a private contractual relationship. *See* RESTATEMENT (SECOND) OF

of patents against third parties is dictated by rules of issue preclusion, not by the nature of a patent claim.³⁰ Thus, under the decision below, two different panels of the Federal Circuit would be free, on their *de novo* review, to provide two contradictory interpretations of the same patent claim if two different infringers were involved in the two cases. If the first infringer were not a party to the first case, it could not be bound by that judgment. See, e.g., *Martin v. Wilks*, 490 U.S. 755, 762 (1989)

2. Given the flaws in the analogy between patents and statutes, this Court has viewed patents as instead analogous to contracts or privately written deeds to property. Any factual disputes bearing on ambiguities in these written instruments are resolved by the jury, not the court.³¹

As this Court has long recognized, a patent resembles a contract between the inventor and the government.³² In return for full

TORTS § 766 (1979); 43 Am. Jur.2d *Interference* §§ 12, 23, 29, 30, 31, 40, 57 (1968 & 1994 supp.); Annot., *Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties*, 6 A.L.R.4th 195 (1994). In addition, the Federal Circuit's attempt to distinguish contract enforcement as an essentially "private" activity is unsustainable in light of the last half-century of state action doctrine. See, e.g., *Barrows v. Jackson*, 346 U.S. 249, 254 (1953); *Shelley v. Kraemer*, 334 U.S. 1, 19-20 (1948).

³⁰ Under *Triplett v. Lowell*, 297 U.S. 638 (1936), patent validity could be relitigated in successive actions. It was only this Court's decision in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971), that altered the rule of mutuality of estoppel. See *Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967, 1977 (1993).

³¹ See, e.g., Samuel Williston, A TREATISE ON THE LAW OF CONTRACTS § 616, at 649, 652 (3d ed. 1961) ("The general rule is that interpretation of a writing is for the court. . . . Where, however, the meaning of a writing is uncertain or ambiguous, and parol evidence is introduced in aid of its interpretation, the question of its meaning should be left to the jury"); see also *Reed v. Proprietors of Locks & Canals on Merrimac River*, 49 U.S. (8 How.) 274, 289 (1850) (jury's task to interpret vague or ambiguous deed).

³² See, e.g., *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (noting, in discussing construction of a patent, that "[t]he understanding of a party to a contract has always been regarded as of some importance in its interpretation"); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993) ("While there may be underlying fact questions

disclosure of the best mode of the invention in sufficient detail to enable one skilled in the relevant art to practice it and thus improve upon it, the government grants the patentee a restricted monopoly for a period of time. See *Hilton Davis*, 62 F.3d at 1529 (Newman, J., concurring). The sort of extrinsic evidence used in interpreting contracts is the same kind of evidence used in interpreting patent claims: custom and usage of the trade and course of dealing between the parties (akin to prior art), level of skill in the art, and events in the Patent and Trademark Office.

Alternatively, a patent may be thought of as a form of deed which sets out the metes and bounds of the intellectual property the inventor owns for the term and puts the world on notice either to avoid trespass or to purchase all or part of the property right it represents.³³ Just as juries interpret contested boundary descriptions, so they must decide similar issues where the boundary surrounds a patent claim rather than a land or mining claim. See *Reed*, 49 U.S. at 289 ("A deed may be vague, ambiguous, and uncertain in its description of boundary; and even when it carefully sets forth the lines and monuments, disputes often occur as to where those lines and monuments are situated on the ground; and it necessarily becomes a fact for the jury to decide, whether the land in controversy is included therein, or, in other words, was intended by the parties so to be.").

3. In any event, the Federal Circuit's analogy did not prove what the Court of Appeals assumed it did. The process of interpreting a patent's scope, when the issue is what the relevant scientific community would understand a particular term to mean at the time of the patent's issuance, involves weighing evidence and evaluating credibility bearing on what ideas the patent's language induces in other persons. It is simply incoherent to treat that question as though

involved, the ultimate conclusion about the meaning and scope of a claim is, *like contract interpretation*, a question of law") (emphasis added); 1 ROBINSON ON PATENTS at §§ 15, 20 (explaining the longstanding analogy between patents and contracts, which originated in England in 1800 and was adopted in this country in 1831).

³³ See, e.g., *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

it involved a *legal* one — *i.e.*, the effect that *ought* to be given to a particular written instrument. The process involves resolution of a dispute over adjudicative facts — precisely the kind of task that is entrusted to the jury, even in cases arising under federal statutes.

Consider, for example, a federal statute analogous to the patent at issue in *Silsby v. Foote* — that is, a federal statute that created a civil cause of action for persons injured by defects in parts of stoves shipped in interstate commerce if those parts are "necessary to regulate the heat of the stove." See p.16, n.23, *supra*. A defendant in a case brought under such a statute would be entitled to have a jury consider the defense that the particular element of the stove that had injured the plaintiff was *not* one that was "necessary to regulate the heat of the stove," so long as there was a genuine factual dispute over the matter. See *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 550 (1990); *Curtis v. Loether*, 415 U.S. at 196 n.11.

The example is not merely hypothetical. The securities laws require a jury to determine, as a "mixed question of law and fact," whether a given statement was "material" within the meaning of relevant federal statutes. *United States v. Gaudin*, 115 S. Ct. 2310, 2314 (1995). "[T]he materiality inquiry, involving as it does 'delicate assessments of the inferences a "reasonable [decision-maker]" would draw from a given set of facts and the significance of those inferences to him . . . [is] peculiarly on[e] for the trier of fact.'" *Id.* at 2314-15 (quoting *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438, 450 (1976)). Similarly, in admiralty law, "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995); see also *McDermott Intern., Inc. v. Wilander*, 498 U.S. 337, 355 (1991) ("Member of a crew" and 'seaman' are statutory terms," but "seaman status under the Jones Act is a question of fact for the jury"). Other federal statutes operate in similar fashion.³⁴

³⁴ For example, 15 U.S.C. § 1221(a) requires juries to determine whether an entity "acts for" an automobile manufacturer or is "under [its] control" — and thus is subject to liability in suits by dealers. See, e.g., *Colonial Ford, Inc. v. Ford Motor Co.*, 592 F.2d 1126, 1129 & n.3 (10th Cir.), *cert. denied*, 444 U.S. 837 (1979). Copyright law vests the jury with authority to determine "substantial and

With respect to patents as with respect to many statutes, the pre-existing substantive law, ultimately under the control of Congress, makes the interpretation of the terms of art employed in the instrument turn on what those schooled in the relevant fields would take those terms to mean at a given time. To the degree that the construction of a statute is instead deemed, as a matter of law, to be independent of the probable or actual understanding of those governed by it, this separation of legal construction from factual interpretation must, not only as a matter of common sense but indeed as a matter of fundamental fairness and due process, be derived from a pre-existing substantive rule of construction that is clear enough to give fair warning to all those who might be held legally accountable for assuming the contrary. See *Marks v. United States*, 430 U.S. 188, 191 (1977); *Connally v. General Constr. Co.*, 269 U.S. 385, 391 (1939).

Accordingly, the frequent irrelevance of adjudicative factfinding in statutory construction is a function not of anything magical about statutes that those instruments might have in common with patents, but rather of pre-existing rules of construction informing the world that statutes will not always be taken to mean what their addressees in fact suppose — rules that have no counterpart in patent construction and rules that no federal court would have constitutional authority to promulgate.³⁵ Even if a patent could properly be

material similarity" and other mixed questions of fact and law in infringement actions. See, e.g., *Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190, 1196 (D. Del. 1974); *Blunt v. Patten*, F. Cas. No. 1579 (C.C.N.Y. 1828). Suits under 42 U.S.C. § 1983 involve a host of factual determinations submerged within legal questions as well. See, e.g., *Brisk v. Miami Beach*, 726 F. Supp. 1305, 1306 n.3 & 1309 (S.D. Fla. 1989) (application of qualified immunity in Fourth Amendment § 1983 case is a mixed question of law and fact that should be submitted to a jury); *Medcalf v. Kansas*, 626 F. Supp. 1179, 1188 (D. Kan. 1986) (whether failures of training and supervision amounted to gross negligence was a question of fact to be decided by jury in § 1983 case); *Morgan v. Labiak*, 368 F.2d 338, 340 (10th Cir. 1966) (reasonableness of force used by police officer is a question of fact for the jury).

³⁵ Cf. Michael C. Dorf, *A Comment on Text, Time and Audience Understanding in Constitutional Law*, 73 WASH. L.Q. 983, 983 & n.1 (1995) (discussing how the legal landscape might change if the courts interpreted statutes and constitutional provisions to reflect average citizens' understanding of their language).

analogized to a statute, therefore, interpretation of a patent's meaning and scope in the course of a damage suit for patent infringement would necessarily remain a matter for a jury to decide.

4. Nor could the judgment below be defended on the ground that patents involve matters of "public right." *Crowell v. Benson*, 285 U.S. 22, 50-51 (1932). Accepting such an argument would call into question the right to jury trial not merely with respect to claim interpretation, but with regard to *all* aspects of patent litigation. See n.8, *supra*. Even if this Court were willing to reach the question of whether patents could be described as involving "public rights,"³⁶ and even if this Court were willing to depart from its previous unwillingness to make constitutional principle turn on "doctrinaire reliance on formal categories" of "public" and "private" rights,³⁷ the "public rights" doctrine has nothing to do with this case. Whatever Congress' power might be to assign patent infringement suits to administrative agencies for resolution, see *Granfinanciera*, 492 U.S. at 42 n.4; *Northern Pipeline Construction Co. v. Marathon Pipe Line Co.*, 458 U.S. 50, 70 (1982) (plurality opinion), Congress has obviously taken no such action. Accordingly, even assuming *arguendo* that patents confer purely public rights, litigation concerning those rights, when it is brought in an Article III court, continues to be subject to the protections of the Seventh Amendment.

³⁶ Compare *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604, modified on reh'g, 771 F.2d 480 (Fed. Cir. 1985) (patent involves public right), with *Pacemaker Diagnostic Clinic of America, Inc. v. Instromedix, Inc.*, 725 F.2d 537, 541 (9th Cir.) (*en banc*), cert. denied, 469 U.S. 824 (1984) (proceeding from contrary premise). In *Ex parte Bakelite Corp.*, 279 U.S. 438, 452 (1929), this Court described public rights cases involving as "claims against the United States" for "money, land, or other things." *Id.* at 452. In *Granfinanciera*, this Court defined "private right" as "the liability of one individual to another under the law as defined," in contrast to cases that "arise between the Government and persons subject to its authority." 492 U.S. at 50 n.8 (quoting *Crowell*, 285 U.S. at 50, 51). These definitions would exclude from the "public rights" category a suit by one private party against another for patent infringement, just as a private suit for trespass on a government land grant would not be a "public rights" case.

³⁷ *Thomas v. Union Carbide Agricultural Prods. Co.*, 473 U.S. 568, 587 (1985); see also *CFTC v. Schor*, 478 U.S. 833, 853 (1986) ("this Court has rejected any attempt to make determinative for Article III purposes the distinction between public rights and private rights").

Chauffeurs, 494 U.S. at 565 n.4. There is no occasion for this Court to decide here whether Congress has the constitutional authority to assign patent disputes to administrative tribunals, when Congress has declined to exercise any such power it might have in that regard.

B. The Decision Below Cannot Be Defended By Assuming That 35 U.S.C. § 112 Requires Claims to Be Written So That They Are Not Ambiguous to Lawyers

The Federal Circuit believed that 35 U.S.C. § 112³⁸ "has as its purpose the avoidance of the kind of ambiguity that allows introduction of extrinsic evidence in the contract law analogy." 49a. There is no basis for supposing that § 112 could be used to avoid the constitutional question this case poses. Any such argument would ignore this Court's holding — now a basic rule of patent law — that patents are addressed to those skilled in the art, not to lawyers. Because the degree of precision required for a given claim will depend on the subject matter involved, claims may at times contain some measure of (often unavoidable) ambiguity due to the nature of the invention — but will not be found fatally indefinite on that account so long as one skilled in the relevant art could reasonably know the bounds of the claim. *Carnegie Steel Co.*, 185 U.S. at 437 ("The specification of the patent is not addressed to lawyers, or even to the public generally, but to [those skilled in the art], and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently

³⁸ Section 112 provides, in pertinent part, that a patent specification

shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor in carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

definite to sustain the patent.")³⁹

Prior to the decision under review, the Federal Circuit had long recognized that interpreting a patent claim requires a factual inquiry into how one of ordinary skill at the time of the invention would have understood the term, and that resulting factual disputes are matters for the jury. See n.11, *supra*. Even in its decision below, the Federal Circuit acknowledged that § 112 does not eliminate the "need for extrinsic evidence" in interpreting patent claims. 50a.

Indeed, § 112 itself creates the need for juries to find facts and resolve evidentiary disputes in order to establish how much detail and clarity a claim should be required to have. Such evidentiary questions typically concern the prior art, the particular invention, and how the claims would be read by those of ordinary skill in the relevant art.⁴⁰ For example, "[a]lthough the question of whether [a] specification contains a sufficient disclosure under 35 U.S.C. § 112 para. 1 is one of law, compliance with the written description aspect of that requirement is a question of fact." *Utter v. Hiraga*, 845 F.2d

³⁹ See also *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) ("The degree of precision necessary for adequate claims is a function of the nature of the subject matter."); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987) (noting that claims satisfied § 112, even though they were "not precise," because they were "as precise as the subject matter permits" and "reasonably apprise[d] those skilled in the art"). *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 136 (2d Cir.), *cert. denied*, 358 U.S. 884 (1958) ("the [patent] claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can do no more").

⁴⁰ See, e.g., *Credle v. Bond*, 25 F.3d 1566, 1576 (Fed. Cir. 1994) (stating rule that determining whether claim is indefinite requires analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification); *Hormone Research Found. v. Genentech, Inc.*, 904 F.2d 1558, 1567 (Fed. Cir. 1990) (reversing grant of summary judgment on § 112 because of existence of disputed issues of fact), *cert. dismissed*, 499 U.S. 955 (1991); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) ("A decision on whether a claim is invalid under [§ 112] requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.").

993, 998 (Fed. Cir. 1988).⁴¹ In addition, "although enablement" — *i.e.*, whether the patent is sufficiently clear to enable someone skilled in the art to make and use the claimed invention — "is ultimately a question of law," the Federal Circuit "has recognized that there may be underlying factual issues involved." *Spectra-Physics v. Coherent*, 827 F.2d 1524, 1533 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987).⁴² Section 112 also requires that a patent specification disclose the "best mode" contemplated by the inventor of carrying out the invention — a mandate that generates still more issues of fact resolvable by a jury.⁴³

Section 112 thus does not eliminate the need for a jury to resolve factual disputes relating to claim interpretation. Indeed, it creates additional issues to be submitted to the jury.

C. No Policy Concerns Could Possibly Justify Violating The Seventh Amendment

1. Even if it were possible for concerns rooted in policy or utility to justify ignoring commands of constitutional principle, there could be no policy reason for tolerating the Federal Circuit's abrogation of the Seventh Amendment. The Federal Circuit apparently was motivated by the desire to liberate patent litigation from what it took to be the "unpredictability" of jury verdicts. Yet prior to *Markman*,

⁴¹ See also *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 865 (Fed. Cir. 1993) ("Whether the written description requirement has been met is a question of fact."); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (same).

⁴² See also *Christian v. Colt Industries Operating Corp.*, 822 F.2d 1544, 1564 (Fed. Cir. 1987) (noting that the assertion that disclosures "do not enable one skilled in the art to practice the inventions" need to be proven with "testimony" and "evidence"), *vacated and remanded on other grounds*, 486 U.S. 800 (1988); *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446, 1453-54 (Fed. Cir. 1984) ("The question of whether the disclosure of a patent satisfies the enablement requirement of § 112 . . . is a question of law. However, that issue may involve subsidiary questions of fact . . .") (citation omitted), *cert. denied*, 471 U.S. 1136 (1985).

⁴³ See *Therma-Tru Corp. v. Peachtree Doors, Inc.*, 44 F.3d 988, 993 (Fed. Cir. 1995) (observing that whether patentee satisfied "best mode" requirement of § 112 "is a question of fact" and approving jury instruction on the issue).

the Federal Circuit (and previously the regional courts of appeals) had often held that underlying factual questions regarding claim construction were to be decided by a jury. See n.11, *supra*. There is no evidence that this system was unworkable.

In any event, courts could take simple steps to address this perceived problem without violating the Seventh Amendment. Trial judges can exclude expert testimony if it fails the standards outlined in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993). They can make complex issues more accessible to jurors.⁴⁴ And, of course, they can grant summary judgment or judgment as a matter of law if there is no *genuine* factual dispute as to claim interpretation (or any other issue). See, e.g., *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1034 (Fed. Cir. 1992) ("Without factual disputes, claim interpretation proceeds as a matter of law."); *Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1448 (Fed. Cir. 1991) (in the absence of a factual issue, proper interpretation of a claim is "a question of law freely reviewable by this court on appeal"); *Palumbo*, 762 F.2d at 974 ("If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law.").

There is simply no basis in the Constitution, or in any positive legal enactment, for carving an ill-defined "patent exception" into the Seventh Amendment comparable to the amorphous "complexity exception" that lower courts have properly rejected.⁴⁵ Disputes about scientific evidence, expert testimony, and technological issues are hardly unique to patent cases. After all, *Daubert* was a products liability case. And the need for "predictability" is no greater in patent cases than it is in many other commercial disputes, or in

⁴⁴ See, e.g., *Manual for Complex Litigation (Third)* §§ 21.633, 22.45 (1995) (recommending special verdicts or interrogatories); Fed. R. Evid. 706 (court-appointed experts); Brookings Institution, CHARTING A FUTURE FOR THE CIVIL JURY 18-20 (1992) (allowing jurors to take notes and pose questions through the judge; using information technology to give jurors access to transcripts and exhibits to aid in comprehension).

⁴⁵ E.g., *In re Financial Securities Litig.*, 609 F.2d 411, 427-31 (9th Cir. 1979), cert. denied, 446 U.S. 929 (1980); *Kian v. Mirro Aluminum Co.*, 88 F.R.D. 351, 355 (E.D. Mich. 1980); *Radial Lip Mach., Inc. v. International Carbide Corp.*, 76 F.R.D. 224, 227-29 (N.D. Ill. 1977).

litigation generally. Yet different juries are permitted to reach different interpretations of the same contract, for example, or different conclusions about whether a given act was negligent.

2. Nor is there any basis for assuming that transforming claim interpretation into a legal issue will produce uniformity. Initially, the task of claim construction will rest with federal district judges, who surely lack the time and resources available to become patent experts and who generally do not possess the requisite technical background to interpret obscure scientific terms. Indeed, the Federal Circuit had occasion to reverse the construction of patent claims by a district judge who "candidly express[ed] considerable difficulty in understanding the chemistry and law involved in the case." *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995). In another recent case, the Federal Circuit held that the jury had applied the correct construction of patent claims, but that the district court had adopted an erroneous construction. *Laitram Corp. v. NEC Corp.*, 62 F.3d 1388, 1394 (Fed. Cir. 1995). These examples hardly inspire confidence in the ability of district courts to sort out conflicting evidence regarding patent claims.

The "predictability" argument thus rests on the utterly unrealistic premise that the Federal Circuit has both the ability to engage in a *de novo* review of the record in every patent case and the expertise to identify the single "correct" meaning of patent claims. Yet patents are drafted for those skilled in the pertinent art, not for judges. As Judge Mayer has observed, "[t]o suggest that appellate judges, precious few of whom are trained in science, will always arrive at the 'true' meaning of words embodying complex concepts endows them with knowledge and enlightenment far beyond those who have training and experience in the field. They are in no position to declare the state of knowledge in the art or that scientific hypotheses are correct as a matter of law." *Pall Corp.*, 1995 U.S. App. LEXIS 27366 at *39 (opinion concurring in judgment). In the *Pall* case itself, the Federal Circuit chose between two competing constructions of a patent, each of which was supported by expert testimony. After reviewing the record, Judge Mayer concluded that "there is little for the uninitiated to choose between the contending interpretations. As far as I can see, this court's action is based on mere preference, thus illustrating the artificiality of *Markman*." *Id.* at *37-38.

The Federal Circuit has launched a constitutional experiment that is as unwise as it is illegitimate. This Court should bring that experiment to a decisive end.

CONCLUSION

For the foregoing reasons, the judgment of the Court of Appeals should be vacated and the case remanded.

Respectfully submitted.

FREDERICK A. LORIG
BRIGHT & LORIG
633 West 5th Street
Los Angeles, CA 90274
(213) 627-7774

JOHN E. PRESTON
VICTORIA T. MCGHEE
LITTON INDUSTRIES
21240 Burbank Blvd.
Woodland Hills, CA 93167

LAURENCE H. TRIBE
Counsel of Record
JONATHAN S. MASSEY
KENNETH J. CHESEBRO
Hauser Hall 420
1575 Massachusetts Ave.
Cambridge, MA 02138
(617) 495-4621

Counsel for Amicus Curiae

November 9, 1995

No. 95-26

Supreme Court, U.S.

FILED

NOV 9 1995

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF FOR EXXON CORPORATION,
EXXON CHEMICAL PATENTS, INC., AND
EXXON RESEARCH AND ENGINEERING COMPANY
AS AMICI CURIAE
IN SUPPORT OF PETITIONERS

DONALD B. CRAVEN
Counsel of Record
GERALD GOLDMAN
JAMES P. TUIE
JAMES R. LOVELACE
MILLER & CHEVALIER, Chartered
Metropolitan Square
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 626-5800

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTEREST OF THE AMICI CURIAE	1
INTRODUCTION AND SUMMARY OF ARGUMENT	2
ARGUMENT	6
I. UNDER THE TRADITIONAL AND AGREED-UPON TEST FOR CONSTRUING PATENTS, THE INTERPRETATION OF CLAIMS FREQUENTLY GIVES RISE TO DISPUTES OVER UNDERLYING FACTUAL ISSUES THAT MUST BE RESOLVED BY THE TRIER OF FACT AND REVIEWED ON APPEAL UNDER A DEFERENTIAL STANDARD.....	6
A. Notwithstanding the Legal Nature of the Ultimate Claim Construction Question, Legitimate Disputed Factual Issues Will Arise....	6
B. The Federal Circuit's Efforts to Explain Away the Existence of Factual Issues in Claim Construction Are Unpersuasive	11
II. THE APPROACH TO CLAIM CONSTRUCTION ADOPTED BELOW IMPROPERLY VESTS THE FACT FINDER'S ROLE IN THE FEDERAL CIRCUIT AND JEOPARDIZES THE ACCURATE AND CERTAIN PROTECTION OF PATENTS	15
CONCLUSION	20

TABLE OF AUTHORITIES

CASES	Page
<i>Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.</i> , 887 F.2d 1070 (Fed. Cir. 1989)	8
<i>Allied-Bruce Terminix Cos. v. Dobson</i> , 115 S. Ct. 834 (1995)	14
<i>Anderson v. City of Bessemer City</i> , 470 U.S. 564 (1985)	16
<i>City of Chicago v. Environmental Defense Fund</i> , 114 S. Ct. 1588 (1994)	14
<i>Curtis v. Loether</i> , 415 U.S. 189 (1974)	20
<i>Daubert v. Merrill Dow Pharmaceuticals, Inc.</i> , 113 S. Ct. 2786 (1993)	19, 20
<i>Dennison Manufacturing Co. v. Panduit Corp.</i> , 475 U.S. 809 (1986)	4, 10, 11
<i>Exxon Chemical Patents, Inc. v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995)	19
<i>First Options of Chicago, Inc. v. Kaplan</i> , 115 S. Ct. 1920 (1995)	16
<i>Genentech, Inc. v. Wellcome Foundation Ltd.</i> , 29 F.3d 1555 (Fed. Cir. 1994)	6
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	4, 10, 11
<i>Graver Tank & Mfg. Co. v. Linde Air Prods. Co.</i> , 336 U.S. 271 (1949)	16
<i>Graver Tank & Mfg. Co. v. Linde Air Prods. Co.</i> , 339 U.S. 605 (1950)	17
<i>Harries v. Air King Prods. Co.</i> , 183 F.2d 158 (2d Cir. 1950)	4, 8, 9, 14
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995), petition for cert. filed, — U.S.L.W. — (U.S. Nov. 6, 1995) (No. 95-728)	6
<i>Hoover Group, Inc. v. Custom Metalcraft, Inc.</i> , 66 F.3d 299, 1995 U.S. App. LEXIS 26350 (Fed. Cir. Sept. 19, 1995)	19
<i>In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litig.</i> , 831 F. Supp. 1354 (N.D. Ill. 1993)	4, 9
<i>Inwood Labs., Inc. v. Ives Labs., Inc.</i> , 456 U.S. 844 (1982)	13, 16
<i>Lavender v. Kurn</i> , 327 U.S. 645 (1946)	14

TABLE OF AUTHORITIES—Continued

	Page
<i>Lemelson v. General Mills, Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993)	6
<i>Lucas Aerospace, Ltd. v. Unison Indus., L.P.</i> , 890 F. Supp. 329 (D. Del. 1995), modified on other grounds, No. 93-525, 1995 U.S. Dist. LEXIS 13361 (D. Del. Sept. 5, 1995)	13, 14
<i>Mason v. Tampa G Mfg. Co.</i> , No. 95-1184, 1995 U.S. App. LEXIS 28368 (Fed. Cir. Oct. 12, 1995)	19
<i>Morton International, Inc. v. Cardinal Chemical Co.</i> , 5 F.3d 1464 (Fed. Cir. 1993)	6
<i>Pall Corp. v. Micron Separations, Inc.</i> , 66 F.3d 1211, 1995 U.S. App. LEXIS 27366 (Fed. Cir. Sept. 26, 1995)	17, 18
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	7
<i>Pierce v. Underwood</i> , 487 U.S. 552 (1988)	16
<i>Rogers v. Missouri Pac. R.R.</i> , 352 U.S. 500 (1957)	13
<i>Tennant v. Peoria & P.U. Ry. Co.</i> , 321 U.S. 29 (1944)	13
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854)	6
<i>Zenith Radio Corp. v. Hazeltine Research, Inc.</i> , 395 U.S. 100 (1969)	16
STATUTES	
35 U.S.C. § 103	4, 10
35 U.S.C. § 112	7
LEGISLATIVE MATERIALS	
H.R. Rep. No. 312, 97th Cong., 1st Sess. 37 (1981) ..	15
MISCELLANEOUS	
Fed. R. Civ. P. 52(a)	16
Henry J. Friendly, <i>Federal Jurisdiction: A General View</i> 157 (1973)	17
Gerald Gunther, <i>Learned Hand: The Man and The Judge</i> 138 (1994)	8
U.S. Const. amend. VII	2, 3, 7

IN THE
Supreme Court of the United States

OCTOBER TERM, 1995

No. 95-26

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,
v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF FOR EXXON CORPORATION,
EXXON CHEMICAL PATENTS, INC., AND
EXXON RESEARCH AND ENGINEERING COMPANY
AS AMICI CURIAE
IN SUPPORT OF PETITIONERS

INTEREST OF THE AMICI CURIAE

The amici curiae hold, directly or indirectly, numerous patents of critical importance to their businesses, and they frequently have become involved in substantial, complex patent infringement suits, including one recently decided by the Federal Circuit. As a consequence, they have vital interests in preserving the integrity of the patent system and in ensuring that sound constitutional and jurisprudential principles govern the litigation of patent disputes.

Those interests are directly affected by the court of appeals' broad rulings in the decision under review.

In that decision, a majority of the Federal Circuit, sitting en banc, held that disputes over the literal meaning and scope of patent claims give rise solely to questions of law, involve no factual issues implicating a litigant's Seventh Amendment rights, and are subject to *de novo* review on appeal. Those principles, the majority proclaimed, not only are consistent with the Seventh Amendment, but also will serve the interests of both patent holders and their competitors by promoting predictable and accurate claim construction. But the amici believe that precisely the opposite is the case. The principles adopted by the Federal Circuit are at odds with the requirements of the Seventh Amendment and are inimical to the just and predictable adjudication of patent disputes.

Counsel for the parties have consented to the filing of this brief, as reflected by the letters filed with the Clerk of the Court.

INTRODUCTION AND SUMMARY OF ARGUMENT

Patent infringement suits for damages, it is unanimously agreed, were decided by juries in 18th Century English courts of law. In fact, the Federal Circuit conceded below that, in light of that history, the Seventh Amendment provides a right to a jury trial in infringement actions for money damages. Pet. App. 44a. The court of appeals proceeded, however, to eviscerate that constitutional right by holding that "part of the infringement inquiry, construing and determining the scope of claims in a patent, is strictly a legal question for the court." *Id.* That holding goes a long way toward "ejecting juries from infringement cases" because it is generally recognized that "to decide what the claims mean is nearly always to decide the case." *Id.* at 57a (Mayer, J., concurring in the judgment).

As convincingly shown in the certiorari petition (at 13-17) and in Judge Mayer's concurrence (Pet. App. 65a-68a) and Judge Newman's dissent (*id.* at 115a-35a), the decision of the majority below clashes directly with this Court's Seventh Amendment jurisprudence. Because juries in 18th Century England decided analogous issues bearing on the scope of patents in infringement cases and similar causes of action, the Seventh Amendment preserves the right to have a jury adjudicate all of the controverted factual issues that arise in construing a patent claim. While the amici agree with that historical Seventh Amendment analysis, it is not the topic of this brief. Rather, the focus here is on additional reasons for overturning the Federal Circuit's decision.

The amici show below that the essential premise underlying the majority's decision—namely, that patent construction gives rise only to issues that are purely legal in nature—is wrong as a matter of logic and precedent. As decisions by this Court and other courts show, the construction of patent claims necessarily entails factual inquiries that frequently give rise to disputed issues that can be answered only by resort to trial testimony and other extrinsic evidence. The amici also show below that subjecting the trial court's findings on these issues to *de novo* review ignores the inherent limitations of appellate courts and undermines the accurate and predictable adjudication of infringement actions.

I.

A. Although the courts have traditionally viewed claim construction as raising, in an overall sense, a legal question, it does not follow that disputed factual issues are completely absent from the interpretation of a patent. The test to be applied in determining the scope and meaning of a patent requires a determination "of what one of ordinary skill in the art at the time of the invention would have understood the term[s] to mean." *Id.* at 48a. This test entails a specific inquiry into inherently factual

matters, such as the level of ordinary skill in the relevant technical or scientific community and the meaning of certain terminology to that community at a particular point in time. Those matters often are the subject of dispute, the resolution of which properly turns on the assessment of expert testimony and other extrinsic evidence by a finder of fact. *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d Cir. 1950) (L. Hand, J.) (describing the inquiry as "plainly a question of fact" subject to "clearly erroneous" appellate review); see also *In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litig.*, 831 F. Supp. 1354, 1359 (N.D. Ill. 1993) (Easterbrook, J.).

B. The effort of the majority below to classify all aspects of claim construction as legal in nature squarely conflicts with this Court's teachings in two cases involving the test of non-obviousness, a condition of patentability. See 35 U.S.C. § 103. Although "the ultimate question" of non-obviousness may be a legal one, it involves several "subsidiary determinations" of a factual nature that are reviewed on appeal under "the clearly-erroneous standard." *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986). One of those subsidiary "factual inquiries" is "the level of ordinary skill in the pertinent art." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Because the identical inquiry is made in the claim construction context, *Dennison* and *Graham* compel reversal here.

C. While conceding that claim construction will often require the consideration of expert testimony and other extrinsic evidence, the majority below refused to come to grips with the logical corollary that the admission of such evidence unavoidably creates the opportunity for factual disputes over the understanding of those skilled in the art. It is pure fantasy to pretend that the trial court, in assessing the quality of such evidence, does not engage in classic fact-finding activities—evaluating credibility and weighing the relative strength and probity of the evidence.

D. The majority's analogy of claim construction to statutory interpretation is ill-conceived. Statutory interpretation requires judges to construe the language of the statute and, in certain circumstances, to analyze other legislative materials—an activity that they are fully equipped to perform without hearing expert testimony or other extrinsic evidence. By contrast, a court cannot determine on its own the meaning of a highly technical patent to one of ordinary skill in the art at a particular point in time. If that meaning is disputed by the parties, the court must hear evidence and engage in fact-finding to resolve the dispute.

II.

The new legal regime for deciding infringement cases ushered in by the decision below will upset the proper roles of trial and appellate courts, undermine the accuracy of claim interpretations, and weaken the stability of the patent system. The blanket declaration that all aspects of claim construction involve exclusively legal issues improperly liberates the Federal Circuit to reformulate claim interpretations without regard to the evidence introduced at trial showing how one skilled in the art would have understood the patent at the relevant point in time. In any event, the inferences to be drawn and the findings to be made based on the trial evidence are the domain of the fact finder and should be reviewed on appeal under a deferential standard. In light of the often complicated and technical nature of the testimony in patent litigation, appellate review on a cold written record provides an especially inadequate basis for assessing the evidence.

According to the majority, patent holders and their competitors will benefit from interpretations by judges "trained in the law" applying "established rules of construction." Pet. App. 28a-29a. But legal training and rules of construction will not answer how one of ordinary skill in the art at the relevant time would have understood the patent claim. That can be determined only as a re-

sult of a factual analysis of the relevant evidence. Moreover, by heightening the prospects of judicially devised interpretations unanchored in the evidence regarding the understanding of those skilled in the art, the majority below has injected greater uncertainty into the patent system.

ARGUMENT

I. UNDER THE TRADITIONAL AND AGREED-UPON TEST FOR CONSTRUING PATENTS, THE INTERPRETATION OF CLAIMS FREQUENTLY GIVES RISE TO DISPUTES OVER UNDERLYING FACTUAL ISSUES THAT MUST BE RESOLVED BY THE TRIER OF FACT AND REVIEWED ON APPEAL UNDER A DEFERENTIAL STANDARD

A. Notwithstanding the Legal Nature of the Ultimate Claim Construction Question, Legitimate Disputed Factual Issues Will Arise

This litigation involves an action for patent infringement in which the plaintiffs seek money damages. As the Federal Circuit “ha[s] repeatedly said, a determination of patent infringement is a two-step analysis.” *Genentech, Inc. v. Wellcome Foundation Ltd.*, 29 F.3d 1555, 1561 n.6 (Fed. Cir. 1994); *accord* Pet. App. 20a-21a; *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993). “The first step” of the analysis is “to construe the [patent] claims,” *Morton International, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1468 (Fed. Cir. 1993), in order “to determine [their] proper scope and meaning.” *Genentech*, 29 F.3d at 1561 n.6. The second step requires a determination “whether an accused device or process is within the scope of the properly interpreted claim.” *Id.*

The second analytical step—the infringement determination—indisputably raises a question of fact. *Winans v. Denmead*, 56 U.S. (15 How.) 330, 337 (1854); *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995) (*en banc*), *petition for*

cert. filed, — U.S.L.W. — (U.S. Nov. 6, 1995) (No. 95-728). The issue presented here, however, is whether the first “part of the infringement inquiry, construing and determining the scope of the claims in a patent,” may present factual issues requiring jury determinations under the Seventh Amendment. Pet. App. 44a. That step in the process, the majority below broadly held, *never* gives rise to such factual questions because it purportedly presents “strictly a legal question for the [trial] court” subject to *de novo* review on appeal. *Id.* & n.13.

To reach those conclusions, the majority was forced to overrule numerous precedents. Before the decision below, the Federal Circuit had repeatedly held that, “when the meaning of a term in a claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and the construction of the claim should be left to the trier or jury under appropriate instruction.” *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *accord* Pet. App. 59a-61a (Mayer, J., concurring in the judgment) (citing cases); *id.* at 135a-44a (Newman, J., dissenting) (citing cases); *see also id.* at 21a-25a (majority opinion acknowledging inconsistency in Federal Circuit precedents).

The majority’s revamped approach to claim construction is fundamentally unsound. While claim construction is ultimately a question of law, underlying factual issues must be resolved in interpreting the scope and meaning of a patent. That conclusion flows directly from the standard for claim construction, which is not in dispute. That standard establishes a “test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.” *Id.* at 48a; *cf.* 35 U.S.C. § 112 (“The specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . .”). By its terms, the test requires an inquiry into how particu-

lar persons at a particular point in time would have understood the patent claim.

As the majority below acknowledged, a judge “is not the hypothetical person skilled in the art to whom a patent is addressed” and “is not usually a person conversant in the particular technical art involved.” Pet. App. 50a. Citing numerous decisions of this Court and other courts, the majority accordingly conceded that it will at times be necessary to hear expert testimony and other extrinsic evidence to decide an issue of claim construction. *Id.* at 31a, 33a-36a, 50a. Indeed, the trial court may “us[e] certain extrinsic evidence that the court finds helpful” and “reject[] other evidence as unhelpful . . . en route to pronouncing the meaning of claim language as a matter of law.” *Id.* at 36a. In short, as recognized by the Federal Circuit:

The purpose of expert testimony is to provide assistance to the court in understanding, when the claims are technologically complex or linguistically obscure, ~~how~~ a technician in the field, reading the patent, would understand the claims.

Id. at 35a, quoting *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 887 F.2d 1070, 1076 (Fed. Cir. 1989) (dissenting opinion) (emphasis omitted).

This approach to construing patent claims often requires an analysis of complex science or engineering questions, as well as an appreciation of the technical terminology used in the discipline. To resolve those types of questions, judges need to consider the testimony of experts and other extrinsic evidence.

Judge Learned Hand, “one of the Nation’s great patent judges” (Gerald Gunther, *Learned Hand: The Man and the Judge* 138 (1994)), highlighted this characteristic of patent litigation in *Harries v. Air King Products Co.*, 183 F.2d 158 (2d Cir. 1950). In that case, the trial court had to determine as part of the infringement inquiry “how

the art understood” certain patent claims. *Id.* at 164. That issue—which in Judge Hand’s view involved “plainly a question of fact” subject to “clearly erroneous” review on appeal—was one that the court was “altogether incompetent to decide” since “even the terminology [was] beyond [its] acquaintance.” *Id.* For that reason, expert testimony was indispensable to a proper adjudication, notwithstanding the inherent imperfections of partisan testimony. He stated: “While Congress sees fit to set before us tasks which are so much beyond our powers, suitors must be content that we shall resort to the testimony of experts, though they are concededly advocates with the inevitable bias that advocacy engenders.” *Id.* Thus, expert testimony plays an essential role in achieving a fair and accurate adjudication in patent cases involving complex subjects and technical terminology beyond the ken of judges.

More recently, Judge Easterbrook, sitting as the trial judge in a patent infringement case, struck a similar theme. He noted that, although the ultimate scope of a patent claim may be “an issue of law,” “judges should not pretend that all nominally ‘legal’ issues may be resolved without reference to facts.” *In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litig.*, 831 F. Supp. 1354, 1359 (N.D. Ill. 1993). Because patent claims “are not self-defining,” it would be “folly to suppose” that their “language,” particularly in scientifically or technologically complex areas, would have “only [one] possible understanding” to both a judge and one skilled in the art. *Id.* “What seems clear to a judge may read otherwise to a skilled designer. That is why,” Judge Easterbrook explained, “we ha[ve] . . . trial[s]” in these types of cases. *Id.*

Thus, while claim construction may be considered, in an ultimate sense, to be a legal issue, disputed fact questions will arise during the interpretive process that can be resolved only on the basis of expert testimony or other extrinsic evidence. Those disputed issues must be resolved

by a trier of fact, whose findings may properly be considered on appeal only under a clearly erroneous or similarly deferential standard of review.

This is precisely the teaching of this Court in two closely analogous cases. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the defendant in an infringement action argued that the patent was invalid because it failed to satisfy the test of non-obviousness, which is one of the conditions of patentability. See 35 U.S.C. § 103. That test, expressed in language strikingly similar to the test at issue here, requires a determination whether “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made to a person having ordinary skill in the art.*” *Id.* (emphasis added). While this Court characterized that question, like claim construction, as “one of law,” it also explained that the non-obviousness test “lends itself to several basic factual inquiries”—“the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. In *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986), the Court elaborated that, regardless of whether “the ultimate question” is legal or factual, the “subsidiary determinations” that must be made under the test for non-obviousness are undeniably factual in nature and should be reviewed on appeal under “the clearly-erroneous standard.”

This Court’s decisions in *Graham* and *Dennison* are controlling here. They hold that the level of ordinary skill in the pertinent art is a question of fact even if it arises under what is ultimately a question of law. That same inquiry is an integral element of claim construction, because concededly claim construction must be conducted from the viewpoint of one of ordinary skill in the art at

the relevant time. It necessarily follows, therefore, that interpreting a patent claim involves the resolution of a factual issue, which may itself become the subject of dispute. *Graham* and *Dennison* thus contradict the Federal Circuit’s premise that claim construction does not involve factual issues, thereby requiring reversal of the decision below.

B. The Federal Circuit’s Efforts to Explain Away the Existence of Factual Issues in Claim Construction Are Unpersuasive

The Federal Circuit’s refusal to recognize any factual dimension to claim construction rests on two propositions. First, the majority reasoned that extrinsic evidence in patent construction, even though necessary, does not give rise to any genuine factual dispute because it merely “inform[s] the court about the language in which the patent is written” and that the court’s consideration of such evidence does not involve the “crediting [of] certain evidence over other evidence.” Pet. App. 36a, 50a. Second, the majority analogized claim construction to statutory interpretation—“a matter of law strictly for the court.” *Id.* at 51a. Neither of these propositions withstands analysis.

1. As noted above, the majority itself acknowledged the need for extrinsic evidence to address the standard of how the patent was understood by those skilled in the art at the relevant time. But the decision below fails to recognize the logical implications of that concession—namely, that factual disputes will arise that can properly be resolved only by a trier of fact, subject to a deferential standard of review. The majority dismisses the potential for factual disputes on the ground that extrinsic evidence plays an informational role only; it is needed, the majority asserts, because of the “unfamiliarity of the court with the terminology of the art to which the patent is addressed.” *Id.* at 50a. Thus, under

the majority's view, witnesses providing extrinsic evidence in a patent infringement case are nothing more than talking dictionaries instructing the court as to the proper meaning of the terms used in a patent claim.

This is a crabbed and unrealistic view of the role of extrinsic evidence in the claim construction process. Extrinsic evidence is necessary because the touchstone for interpreting the claim is the understanding of a person "of ordinary skill in the art at the time of the invention." *Id.* at 48a. Such evidence is not limited to the abstract interpretation of the specific terms in which the claim is cast but instead encompasses proof of "how a technician, in the field, reading the patent, would understand the claims." *Id.* at 35a (internal quotation marks omitted). Moreover, the evidence is presented by interested participants in the adversary process and not as a neutral tutorial. It is inevitable, therefore, that the parties' presentations will be conflicting and that disputes will arise regarding the understanding of those skilled in the art.

The majority's assertion that, in considering the parties' conflicting evidence, the trial court "is not crediting certain evidence over other evidence or making factual evidentiary findings" simply defies reality. *Id.* at 36a. The majority acknowledged that the trier of fact must consider conflicting testimony and assess what is "helpful" and what is "unhelpful." *Id.* When it engages in that activity, what else can it be doing other than "crediting certain evidence over other evidence"? For example, testimony elicited on cross-examination of the defendant's witnesses in an infringement action that supports the plaintiff's construction of the claim would likely be credited as "helpful." On the other hand, testimony that is self-contradictory or impeached by documentary evidence may be rejected as "unhelpful." And the witness's demeanor and similar considerations may well provide important guidance in determining whether his or her testimony should be regarded as "helpful." Such judgments in a

patent case are no different from those that a trier of fact would make in resolving any other kind of factual issue.

Indeed, "the jury . . . weighs the contradictory evidence and inferences, judges the credibility of witnesses, receives expert instructions, and draws the ultimate conclusion as to the facts. The very essence of its function is to select from among conflicting inferences and conclusions that which it considers most reasonable." *Tenant v. Peoria & P.U. Ry. Co.*, 321 U.S. 29, 35 (1944); see also *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 856 (1982) ("Determining the weight and credibility of the evidence is the special province of the trier of fact."); *Rogers v. Missouri Pac. R.R.*, 352 U.S. 500, 504 (1957).

The decision below simply ignores these litigation realities. Judge Schwartz of the District of Delaware aptly reacted to the majority's description of the trial court's treatment of extrinsic evidence as being "somewhat startling" and creating a "fiction." *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 890 F. Supp. 329, 333-34 n.7 (D. Del. 1995), modified on other grounds, No. 93-525, 1995 U.S. Dist. LEXIS 13361 (D. Del. Sept. 5, 1995). Judge Schwartz explained:

As I understand Markman, because claim construction presents a purely legal question, trial judges must ignore all non-transcribable courtroom occurrences such as a witness's body language, inability to maintain eye contact when confronted with a telling question, hesitance or delay in giving an answer, an affirmative answer in a voice revealing the truthful answer is "no," or the changing demeanor of a witness when shifting from sure to treacherous footing. . . . [But w]hen two experts testify differently as to the meaning of a technical term, and the court embraces the view of one, the other, or neither while construing a patent claim as a matter of law, the

court has engaged in weighing evidence and making credibility determinations.

Id. at 333 n.7.

In short, contrary to the Federal Circuit's assertions, where a trial court hears extrinsic evidence to understand the meaning of the patent claim to particular persons at a particular point in time and chooses to rely on some of the evidence and to disregard other evidence, it is not making legal determinations that can be reviewed *de novo* on appeal. Instead, it is engaging in a classic exercise of fact-finding. See *Lavender v. Kurn*, 327 U.S. 645, 652-53 (1946).

2. The second analytical linchpin of the decision below is its analogy of claim construction to statutory interpretation. See Pet. App. 51a-52a. That analogy, however, is wide of the mark.

When possible, this Court uses the "plain meaning" approach to statutory construction and confines itself to interpreting the statutory text. See, e.g., *City of Chicago v. Environmental Defense Fund*, 114 S. Ct. 1588, 1591-93 (1994). Even on those occasions when the Court goes beyond the statutory text to consider legislative history in the form of Congressional reports and other documents, the materials subject to examination are equally available in the trial and appellate courts and can be best construed by generalist judges, whose training and experience qualify them for that task. See, e.g., *Allied-Bruce Terminix Cos. v. Dobson*, 115 S. Ct. 834, 839-40, 842 (1995).

This is not at all the situation when a judge must determine what a complex technical patent meant to one skilled in the art at a particular point in time. That exercise requires, in the words of Judge Hand, "resort to the testimony of experts," who may differ regarding the existence of primary facts, or to other extrinsic evidence such as articles and other scientific writings, which may give rise to conflicting inferences. *Harries*, 183 F.2d at 164.

Thus, the majority's analogy to statutory construction is no more persuasive than its analysis of the trial court's use of extrinsic evidence. Neither justification succeeds in transmogrifying a question of fact into a question of law.

II. THE APPROACH TO CLAIM CONSTRUCTION ADOPTED BELOW IMPROPERLY VESTS THE FACT FINDER'S ROLE IN THE FEDERAL CIRCUIT AND JEOPARDIZES THE ACCURATE AND CERTAIN PROTECTION OF PATENTS

Under the decision below, at least as applied in subsequent cases, the Federal Circuit effectively has taken responsibility for making all of the factual determinations that are necessary to construe patent claims. The majority accomplished this by re-labeling factual determinations as "legal" issues that are reviewable *de novo*. Pet. App. 44a & n.13. As a result, panels of appellate judges have asserted free rein to second guess determinations made at the trial level that were based on an evaluation of conflicting testimony and other evidence and that, accordingly, have been traditionally subject only to deferential review.

Although Congress intended in establishing the Federal Circuit to centralize appeals of patent infringement cases, it did not intend that tribunal to perform the function of trial courts. Indeed, Congress specifically recognized that "factual issues in a patent case must be tried and decided by the trial judge or a jury in precisely the same manner as such issues are tried in any other kind of a lawsuit. The technical aspects of a patent case are factual issues Thus, it is the settled practice of the circuit courts of appeals in patent cases to honor and respect" the findings of fact below. H.R. Rep. No. 312, 97th Cong., 1st Sess. 37 (1981). Under the Court of Appeals for the Federal Circuit Act of 1981, this practice was not to change. *Id.* at 37-38.

The Federal Circuit's assumption of the responsibilities properly performed by the trier of fact disserves the fair and accurate adjudication of patent infringement claims. As this Court has recognized, a trier of fact who has heard the witnesses and seen the other extrinsic evidence first-hand is better equipped to make factual findings than an appellate court, which must rely upon the cold written record from the court below. "[O]nly the trial judge can be aware of the variations in demeanor and tone of voice that bear so heavily on the listener's understanding of and belief in what is said." *Anderson v. City of Bessemer City*, 470 U.S. 564, 575 (1985). Moreover, "[t]he district court may have insights not conveyed by the record into such matters as whether particular evidence was worthy of being relied upon." *Pierce v. Underwood*, 487 U.S. 552, 560 (1988); see also *First Options of Chicago, Inc. v. Kaplan*, 115 S. Ct. 1920, 1926 (1995).

It is precisely because trial courts are better suited than courts of appeals to engage in fact-finding that appellate courts owe deference to factual findings made at the trial level. Indeed, the "clearly erroneous" standard of Fed. R. Civ. P. 52(a) "recognizes and rests upon the unique opportunity afforded the trial court judge to evaluate the credibility of witnesses and to weigh the evidence." *Inwood Labs.*, 456 U.S. at 855 (citing *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969)); see also *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 275 (1949) (noting "the advantages possessed by the trial court in appraising the significance of conflicting testimony"). Thus, "appellate courts must constantly have in mind that their function is not to decide factual issues *de novo*." *Zenith*, 395 U.S. at 123; see also *First Options*, 115 S. Ct. at 1926.

The differentiation in the respective roles played by the fact finder and appellate court is particularly vital in complex matters like patent infringement cases, in which there often is conflicting expert testimony concerning difficult and intricate issues of fact. Thus, this Court has

properly emphasized in patent cases—"where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations"—that an appellate court is not "to even essay an independent evaluation" of the expert testimony, which "is the function of the trial court" in its capacity as the finder of fact. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 611 (1950); see also *id.* at 610. As Judge Newman succinctly explained in her dissenting opinion below, "when the technologic issues are complex, appellate fact finding is probably the least effective path to accurate decisionmaking Appellate briefs and fifteen minutes per side of attorney argument are not designed for *de novo* findings of disputed technologic questions." Pet. App. 85a; accord Henry J. Friendly, *Federal Jurisdiction: A General View* 157 (1973).

At bottom, the effort below to reclassify all claim construction issues as questions of law subject to *de novo* review reflects a policy judgment that patent cases are best left in the hands of judges "trained in the law." Pet. App. 28a-29a. According to the majority, judges applying "established rules of construction to the language of the patent claim" are more likely than trial fact finders to "arrive at the true and consistent scope of the patent owner's right to be given legal effect." *Id.*

The majority's approach, however, is misguided because claim construction does not and cannot turn simply on the application of judicially created canons. Canons of construction cannot answer the test of what one of ordinary skill in the art at the relevant time would have understood the patent to embrace. Moreover, that test is fraught with underlying issues that are factual in nature and thus can only be accurately resolved by finders of fact based on a consideration of the evidence. Contrary to the majority's approach, that requires a trial in the district court with only deferential review by the Federal Circuit. See *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1995 U.S. App. LEXIS 27366, *39 (Fed. Cir.

Sept. 26, 1995) (Mayer, J., concurring) ("To suggest that appellate judges, precious few of whom are trained in science, will always arrive at the 'true' meaning of words embodying complex concepts endows them with knowledge and enlightenment far beyond those who have training and experience in the field. They are in no position to declare the state of knowledge in the art or that scientific hypotheses are correct as a matter of law.").

The majority's endorsement of judge-made interpretations rather than fact finder determinations based on the evidence will undermine not only the accuracy of claim interpretations but also the stability of the patent system. The test of the understanding of those of ordinary skill in the art has provided a guiding principle on which patent writers and readers have long been able to depend. While paying lip service to that principle, the ruling below does serious damage to its application in practice by papering over the factual disputes it raises. The result can only be uncertainty in the construction of countless patent claims already written and confusion about how to write patents for the future.

In fact, by virtue of the Federal Circuit's application of the decision below, trial court adjudications now stand a far greater chance of being overturned merely because an appellate panel, despite having seen and heard none of the witnesses, disagrees with the trial court's construction of the patent claim. Moreover, parties will view the appeal as a clean slate on which they can re-litigate all claim construction issues, thereby rendering the trial a superfluous exercise. As Judge Mayer stated in his opinion below, "[t]he effect of this case is to make of the judicial process a charade, for notwithstanding any trial level activity, this court will do pretty much what it wants under its *de novo* retrial." Pet. App. 68a (concurring in the judgment); see also *id.* at 104a (Newman, J., dissenting) (decrying the "'omniscience of the learned man' theory of dispute resolution in the Federal Circuit").

The consequences of the decision below already are apparent. In *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995), a divided panel of the court of appeals applying the decision below engaged in unfettered *de novo* review of the district court's construction of a patent claim. The panel stated: "No matter when or how a judge performs the *Markman* task, on appeal we review the issue of claim interpretation independently without deference to the trial judge." *Id.* at 1556. The panel then adopted an interpretation of the claim that had been advanced by neither party at any point in the litigation nor by any witness in trial testimony. *Id.* at 1564-65 (Nies, J., dissenting). Instead, the court's decision was based solely on the appellate judges' parsing of the words of the claim without any regard to the extensive extrinsic evidence presented at trial concerning what those skilled in the art would have understood the claim to mean. See also, e.g., *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 1995 U.S. App. LEXIS 26350, *14 (Fed. Cir. Sept. 19, 1995) (reversing trial court's claim construction based solely on patent claim, drawings, and specification, without addressing disputed extrinsic evidence); *Mason v. Tampa G Mfg. Co.*, No. 95-1184, 1995 U.S. App. LEXIS 28368, *10-11 (Fed. Cir. Oct. 12, 1995) (construing patent based solely on panel's examination of patent claim, drawings, and specification without any ruling on construction by trial court and without reference to extrinsic evidence).

Finally, to the extent that the decision below is motivated by the fear of irrational jury decisions, trial judges have mechanisms at hand for dealing with groundless jury determinations. As this Court recently observed in another case involving scientific evidence:

In the event the trial court concludes that the scintilla of evidence presented supporting a position is insufficient to allow a reasonable juror to conclude that the position more likely than not is true, the court remains free to direct a judgment, Fed. Rule Civ.

Proc. 50(a), and likewise to grant summary judgment, Fed. Rule Civ. Proc. 56.

Daubert v. Merrill Dow Pharmaceuticals, Inc., 113 S. Ct. 2786, 2798 (1993); *see also id.* (decrying "pessimis[m] about the capabilities of the jury, and of the adversary system generally"); *Curtis v. Loether*, 415 U.S. 189, 198 (1974). Certainly, the use of such "conventional devices" is preferable to the "wholesale" assumption of fact-finding powers by the court of appeals. *See Daubert*, 113 S. Ct. at 2798.

CONCLUSION

The judgment of the court of appeals should be vacated and the case remanded for reconsideration in light of the petitioner's entitlement to a jury determination of the factual issues underlying claim construction and the deference owed to such determinations by the appellate court.

Respectfully submitted,

DONALD B. CRAVEN

Counsel of Record

GERALD GOLDMAN

JAMES P. TUIE

JAMES R. LOVELACE

MILLER & CHEVALIER, Chartered
Metropolitan Square

655 Fifteenth Street, N.W.

Washington, D.C. 20005

(202) 626-5800

November 1995

NOV 24 1995

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

—v.—

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**MOTION FOR LEAVE TO FILE OUT-OF-TIME
AMICUS CURIAE BRIEF OF THE AMERICAN
BOARD OF TRIAL ADVOCATES**

Robert G. Vial
Counsel of Record
Daphne A. Burns
Counsel for Amicus Curiae
American Board of Trial
Advocates
1717 Main Street, Suite 4400
Dallas, Texas 75201
(214) 712-4400

BEST AVAILABLE COPY

3/28

No. 95-26

IN THE
Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
and ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari To The United States
Court of Appeals For The Federal Circuit

**MOTION FOR LEAVE TO FILE OUT-OF-TIME
AMICUS CURIAE BRIEF OF THE AMERICAN
BOARD OF TRIAL ADVOCATES**

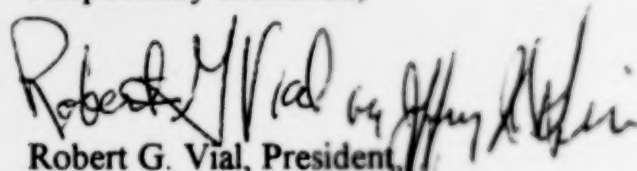
The American Board of Trial Advocates (ABOTA) respectfully moves for leave to file out-of-time its *Amicus Curiae* brief in this case.

No timely brief was filed because, as *Amicus Curiae*, ABOTA was unaware of this Court's order expediting this case. In accordance with Rule 29.2, ABOTA filed its brief by express mail with proof of service and bearing a postmark of November 9, 1995, the last day for filing in this case.

Although its *Amicus Curiae* brief was filed after the expiration of the time prescribed by this Court's order,

ABOTA respectfully requests that this Court exercise its discretion and power, in the interests of justice, to entertain its brief in these circumstances. *See United States v. Ohio Power Co.*, 353 U.S. 98 (1957).

Respectfully submitted,



Robert G. Vial, President,

Counsel of Record

Daphne A. Burns

Counsel for Amicus Curiae

American Board of Trial Advocates

1717 Main Street, Suite 4400

Dallas, Texas 75201

(214) 712-4400

November 22, 1995

No. 95-26

13

Supreme Court, U.S.

FILED

DEC 8 1995

CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

—v.—

WESTVIEW INSTRUMENTS, INC.
and ALTHON ENTERPRISES, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF MATSUSHITA ELECTRIC
CORPORATION OF AMERICA AND MATSUSHITA
ELECTRIC INDUSTRIAL CO., LTD. AS AMICI
CURIAE IN SUPPORT OF RESPONDENTS**

MORTON AMSTER

JOEL E. LUTZKER*

**Counsel of Record*

DAVID H. KAGAN

AMSTER, ROTHSTEIN & EBENSTEIN

90 Park Avenue

New York, New York 10016

(212) 697-5995

BEST AVAILABLE COPY

37 PP

TABLE OF CONTENTS

	PAGE
TABLE OF AUTHORITIES	iii
IDENTITY AND INTEREST OF AMICI CURIAE....	1
SUMMARY OF THE ARGUMENT.....	1
ARGUMENT.....	3
I. AS IMPLICITLY RECOGNIZED BY THE MARKMAN DECISION, SERIOUS PROBLEMS HAVE PREVAILED IN THE TRIAL OF PATENT CASES TO JURIES	3
A. Increased Use Of Juries In Complex Patent Trials Has Increased The Likelihood Of Arbitrary Results	3
B. Absent Procedural Safeguards And Guidance, Juries Are Likely To Misunder- stand And Misconstrue Technical Issues Presented To Them.....	6
II. ALLOWING JURIES AND NOT THE COURT TO DETERMINE THE ULTIMATE MEANING OF A CLAIM THWARTS THE CONSTITU- TIONAL AND CONGRESSIONAL MANDATES UNDERLYING THE PATENT LAWS AND IS AT ODDS WITH THIS COURT'S PRIOR DECISIONS.....	9
A. The Constitutional Mandate Establishing The Patent System Requires That Claims Be Precise And Capable Of Predictable Determination By The Interested Public	9

B. The Ultimate Meaning Of A Claim Is A Matter Of Law For The Court To Determine Based Upon the Documentary Record	13
III. IN THE RARE CASE WHERE AN UNDERLYING EVIDENTIARY DISPUTE ARISES REGARDING THE DETERMINATION OF THE MEANING OF A TECHNICAL CLAIM TERM, THE MATTER SHOULD BE RESOLVED, IF TRIABLE TO A JURY, BY NARROWLY FOCUSED SPECIAL VERDICTS OR SPECIAL INTERROGATORIES.....	17
A. Special Verdicts And Special Interrogatories Help Ensure That The Jury Process Is Rational, Reviewable And Predictable	17
B. This Court Should Now Exercise Its Supervisory Authority And Require The Use Of Rule 49 Verdicts In Patent Cases Absent Special Circumstances	23
C. The Use of General Verdicts In Complex Patent Litigation Raises Serious Due Process Questions.....	25
IV. CONCLUSION.....	27

TABLE OF AUTHORITIES

Cases	PAGE
<i>Albemarle Paper Co. v. Moody</i> , 422 U.S. 405 (1975) .	23
<i>Atlantic Works v. Brady</i> , 107 U.S. 192 (1882).....	10
<i>Bank of U.S. v. Halstead</i> , 23 U.S. (10 Wheat.) 51 (1825)	24
<i>Baumstimler v. Rankin</i> , 677 F.2d 1061 (5th Cir. 1982)	20
<i>Bio-Rad Lab, Inc. v. Nicolet Instrument Corp.</i> , 739 F.2d 604 (Fed. Cir. 1984)	21
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870) ...	13, 14
<i>Cafeteria & Restaurant Workers Union v. McElroy</i> , 367 U.S. 886 (1961)	25
<i>Collins Licensing v. American Tel. and Tel. Co.</i> , 28 U.S.P.Q. 2d 1847 (Fed. Cir. 1993), rev'g No. 7-90-CV-201 (W.D.Tex. filed March 27, 1992).	4
<i>Connell v. Sears, Roebuck & Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)	22
<i>Control Components, Inc. v. Valtek, Inc.</i> , 609 F.2d 763 (5th Cir. 1980)	21
<i>Control Components, Inc. v. Valtek, Inc.</i> , 616 F.2d 892 (5th Cir.), cert. denied, 449 U.S. 1022 (1980)....	21
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	13
<i>Curtiss-Wright Corp. v. General Elec. Co.</i> , 446 U.S. 1 (1980)	23
<i>Dual Mfg. & Eng'g, Inc. v. Burriss Indus., Inc.</i> , 619 F.2d 660 (7th Cir.) (en banc), cert. denied, 449 U.S. 870 (1980)	6

	PAGE
<i>E.I. du Pont de Nemours & Co. v. Berkley & Co., Inc.</i> , 620 F.2d 1247 (8th Cir. 1980)	21
<i>Fidelity & Deposit Co. of Md. v. United States</i> , 187 U.S. 315 (1902)	18
<i>Galloway v. United States</i> , 319 U.S. 372 (1942)	18
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	10, 11, 21
<i>Great Plains Chem. Co., Inc. v. Micro Chem., Inc.</i> , 549 F. Supp. 1348 (D. Colo. 1982)	7
<i>Greenholtz v. Inmates of the Neb. Penal and Correctional Complex</i> , 442 U.S. 1 (1979)	25
<i>Griffin v. Illinois</i> , 351 U.S. 12 (1956)	26
<i>Hanna v. Plummer</i> , 380 U.S. 460 (1965)	18
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	13, 14
<i>ILC Peripherals Leasing Corp. v. International Business Machs. Corp.</i> , 458 F. Supp. 423 (N.D. Cal. 1978), <i>aff'd</i> , 636 F.2d 1188 (9th Cir. 1980), <i>cert. denied</i> , 452 U.S. 972 (1981)	6, 7
<i>In Re Innotron Diagnostics</i> , 800 F.2d 1077 (Fed. Cir. 1986)	23
<i>Intellicall, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384 (Fed. Cir. 1992)	15
<i>Lemelson v. General Mills, Inc.</i> , 968 F.2d 1202 (Fed. Cir. 1992), <i>cert. denied</i> , ___ U.S. ___, 122 L.Ed.2d 131 (1993)	4, 6
<i>Litton Systems, Inc. v. Honeywell, Inc.</i> , No. CV 90- 4823, 1995 U.S. Dist. LEXIS 729 (C.D. Cal. Jan. 4, 1995)	4
<i>Manufacturing Research Corp. v. Graybar Elec. Co., Inc.</i> , 679 F.2d 1355 (11th Cir. 1982)	21

	PAGE
<i>Matthews v. Eldridge</i> , 424 U.S. 319 (1976)	25
<i>McNabb v. United States</i> , 318 U.S. 332 (1942)	23
<i>Pacific Mut. Life Ins. Co. v. Haslip</i> , 499 U.S. 1 (1991)	26
<i>Perkin-Elmer Corp. v. Computervision Corp.</i> , 732 F.2d 888 (Fed. Cir.), <i>cert. denied</i> , 469 U.S. 857 (1984)	21
<i>Permutit Co. v. Graver Corp.</i> , 284 U.S. 52 (1931)	14
<i>Peters v. Kiff</i> , 407 U.S. 493 (1972)	24, 25
<i>Railroad Dynamics, Inc. v. A. Stucki Co.</i> , 727 F.2d 1506 (Fed. Cir.), <i>cert. denied</i> , 469 U.S. 871 (1984)	19
<i>Roberts v. Sears, Roebuck & Co.</i> , 723 F.2d 1324 (7th Cir. 1983)	20, 21, 22, 23
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970)	7, 25
<i>SCM Corp. v. Xerox Corp.</i> , 463 F. Supp. 983 (D. Conn. 1978)	7
<i>Schriber-Schroth Co. v. Cleveland Trust Co.</i> , 311 U.S. 211 (1940)	15
<i>Skidmore v. Baltimore & O.R. Co.</i> , 167 F.2d 54 (2d Cir. 1945), <i>cert. denied</i> , 335 U.S. 816 (1948)	18
<i>Senmed, Inc. v. Richard-Allan Medical Indus., Inc.</i> , 888 F.2d 815 (Fed. Cir. 1989)	8
<i>Structural Rubber Prods. Co. v. Park Rubber Co.</i> , 749 F.2d 707 (Fed. Cir. 1984)	15, 18, 19
<i>Texas Instruments, Inc. v. Cypress Semiconductor Corp.</i> , No. 3:90-CV-150-H (N.D. Tex. filed Aug. 23, 1995)	4, 6

	PAGE
<i>Thiel v. Southern Pac. Co.</i> , 328 U.S. 217 (1945)	24
<i>Thomas v. Arn</i> , 474 U.S. 140 (1985)	24
<i>Tights, Inc. v. Stanley</i> , 441 F.2d 336 (4th Cir.), <i>cert. denied</i> , 404 U.S. 852 (1971)	6
<i>United Gas Public Serv. Co. v. Texas</i> , 303 U.S. 123 (1937)	25
<i>Walker v. New Mexico & S.Pac. R.R.</i> , 165 U.S. 593 (1897)	18
<i>Wardlaw v. Halliburton Co.</i> , No. 93-1322, 1994 U.S. App. LEXIS 30524 (Fed. Cir. Oct. 31, 1994)	4, 8
<i>Weinar v. Rollform Inc.</i> , 744 F.2d 797 (Fed. Cir. 1984), <i>cert. denied</i> , 470 U.S. 1084 (1985)	22, 23
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	12
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853) ...	13
<i>Winans v. New York & Erie R.R.</i> , 62 U.S. (21 How.) 88 (1858)	13, 15
<i>Withrow v. Larkin</i> , 421 U.S. 35 (1975)	25
Constitutions, Statutes and Rules	
Art. I, § 8, cl. 8	1, 3, 4, 10, 11
Fed. R. Civ. P. 49	17, 18
35 U.S.C. § 102	20
35 U.S.C. § 103	20
35 U.S.C. § 112 (1984)	12
35 U.S.C. § 154(a)(1) (1995)	9

	PAGE
Other Authorities	
Martin J. Adelman, <i>The New World of Patents Created by the Court of Appeals for the Federal Circuit</i> , 20 U. Mich. J.L. Ref. 979 (1987)	7, 8
* The Advisory Commission On Patent Law Reform, <i>A Report to the Secretary of Commerce</i> (1992) ..	3, 6, 7, 8
* Advisory Committee on Industrial Innovation, <i>Final Report</i> (1979)	9
Edmund L. Andrews, <i>Rich in the 90's on Ideas Hatched in the 50's</i> , N.Y. Times, Nov. 13, 1992 ..	4
Edmund L. Andrews, <i>A "White Knight" Draws Cries of "Patent Blackmail,"</i> N.Y. Times, Jan. 14, 1990 ..	3
John R. Brown, <i>Federal Special Verdicts: The Doubt Eliminator</i> , 44 F.R.D. 338 (1967)	19
Warren E. Burger, <i>Is Our Jury System Working?</i> , Reader's Dig., Feb. 1981	7
* Director of Admin. Office of U.S. Courts, <i>Ann. Reps.</i> (1980-1995)	4, 5
Samuel M. Driver, <i>The Special Verdict—Theory and Practice</i> , 26 Wash L.R. 21 (1957)	19
Douglas W. Ell, Note, <i>The Right to an Incompetent Jury: Protracted Commercial Litigation and the Seventh Amendment</i> , 10 Conn. L. Rev. 775 (1978)	8
Elizabeth A. Faulkner, <i>Using the Special Verdict to Manage Complex Cases and Avoid Compromise Verdicts</i> , 21 Ariz. St. L.J. 297 (1989)	19
Steven I. Friedland, <i>Legal Institutions: The Competency and Responsibility of Jurors in Deciding Cases</i> , 85 Nw. U.L. Rev. 190 (1990)	7

* Material has been lodged with the Clerk of the Court.

	PAGE
Simson L. Garfinkel, <i>Software Makers Row Over Patents</i> , Christian Science Monitor, Sept. 12, 1989	4
* <i>Global Competition, The New Reality: The Report of the President's Commission on Industrial Competitiveness</i> , Vol. I (1985)	9
H.R. Rep. No. 312, 97th Cong., 1st Sess. (1981)	3, 12
Laura A. Kiernan, <i>Burger Sees Complex Trials Beyond Capacity of Jurors</i> , Wash. Post, Aug. 8, 1979	7
Charles T. McCormick, <i>Jury Verdicts Upon Special Questions in Civil Cases</i> , 2 F.R.D. 176 (1941) ...	19
<i>Modern Federal Jury Instructions</i> (Matthew Bender 1993)	5
* 2 William C. Robinson, <i>The Law of Patents for Useful Inventions</i> , § 731 (1890)	13
* Gary M. Ropski, <i>Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation (Part I)</i> , 58 J. Pat. Off. Soc'y. 609 (1976)	4
* Gary M. Ropski, <i>Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation (Part II)</i> , 58 J. Pat. Off. Soc'y. 673 (1976)	19
* F.M. Scherer, <i>Industrial Market Structure and Economic Performance</i> (2d ed. 1980)	10
Gary Slutsker and David C. Churbuck, <i>Whose Invention Is It Anyway?</i> , Forbes, Aug. 19, 1991 .	3
* Special Committee of Jury Comprehension, A.B.A. Litig. Sec., <i>Jury Comprehension in Complex Cases</i> (1989)	8

* Material has been lodged with the Clerk of the Court.

	PAGE
* George J. Stigler, <i>The Organization of Industry</i> (1980)	10

* Material has been lodged with the Clerk of the Court.

IDENTITY AND INTEREST OF AMICI CURIAE

Upon consent of the parties,¹ amici curiae Matsushita Electric Corporation of America and Matsushita Electric Industrial Co., Ltd. (collectively "Panasonic") submit this brief in support of the position of respondents. Panasonic manufactures, distributes and sells a large range of electronic products and components. Panasonic is the owner of over 5,900 U.S. patents and ranks within the top ten recipients of U.S. patents annually. Although Panasonic has no direct interest in the outcome of this appeal, it participates in the technology marketplace as an innovator, a licensor, a licensee, a manufacturer and a litigant. In each of these roles, it has an interest in ensuring that the system for resolving patent disputes is rational, predictable and reviewable.

SUMMARY OF THE ARGUMENT

As recognized by this Court, the patent system must reconcile two fundamental competing interests. On one side, it must provide meaningful incentives to innovation. On the other side, it must assure that patents cannot be used to deprive the public and other innovators from use of that which should be in the public domain. Since the claims of a patent define the limits of the patent monopoly, claim certainty is the pivot upon which the patent system is balanced. How the issues on this appeal are decided will directly determine how that balance will be maintained in keeping with the constitutional mandate to promote the progress of the useful arts (Art. I, § 8, cl. 8), while preserving the Seventh Amendment right to trial of factual issues to a jury.

Recognizing that uncertainty concerning the scope of the exclusionary rights conferred by patents deters innovation, this Court has long held that claim construction is ultimately a matter of law. As technology becomes increasingly com-

¹ Letters evidencing the consent of the parties have been filed with the Clerk of the Court.

plex, it is more essential than ever that this Court require that lower courts adhere to this bedrock principle and assure that only *bona fide* factual issues are presented to juries for their determination. Under no circumstances should juries be permitted to usurp the role of the trial court to determine the ultimate meaning of the claims.

First and foremost, claim construction depends upon the documentary record. Section 112 of the patent statute requires that patents distinctly claim the subject matter which the applicants regard as their invention. To be valid, a claim must be clearly understood by persons of ordinary skill in the art based upon the patent specification and prosecution history. This statutory requirement necessarily limits the potential areas for material evidentiary dispute concerning the meaning of claims.

Since patents are written to persons skilled in the technical art, a rare evidentiary dispute may exist regarding the technical meaning of a claim term. This appeal asks this Court to determine how such a dispute will be resolved—whether by the courts as a matter of law, or by juries as a matter of fact. In answering this question, this Court should be cognizant of the uniformly recognized difficulties of juries in dealing with the complex legal and technical issues presented in patent cases and the challenges faced by appellate courts in reviewing their verdicts. If factual issues exist that are triable to the jury, this Court should require that they be determined by special verdicts or special interrogatories. This procedure is authorized by the Federal Rules of Civil Procedure and is clearly consistent with the Seventh Amendment.

Special verdicts and special interrogatories should be required under this Court's supervisory power in complex patent cases. Special verdicts help ensure rational and reviewable jury determinations by dividing the factual issues into discrete and understandable pieces and providing a proper record for review on appeal. Thus, special verdicts accom-

plish the necessary certainty required by Art. I, § 8, cl. 8, while satisfying the Seventh Amendment.

ARGUMENT

I. AS IMPLICITLY RECOGNIZED BY THE MARKMAN DECISION, SERIOUS PROBLEMS HAVE PREVAILED IN THE TRIAL OF PATENT CASES TO JURIES

A. Increased Use Of Juries In Complex Patent Trials Has Increased The Likelihood Of Arbitrary Results

The Federal Circuit's *Markman* decision must be viewed in the context of the Circuit's twelve year effort to fulfill its congressional mandate to bring uniformity and predictability to the patent system. See H.R. Rep. No. 312, 97th Cong., 1st Sess. 11 (1981). In spite of this legislative goal, increasingly, there has been a widespread realization that decisions in complex patent trials by juries have become arbitrary games of chance in which the merits are circumvented. The Advisory Commission on Patent Law Reform, *A Report to the Secretary Of Commerce* 107 (1992) (hereinafter "Advisory Commission Report") ("In many cases, the [patent] litigation process becomes at best a rough form of dispensing justice, and at worst, a process which is no better than a gamble."² Recent

² See also Advisory Commission Report, *supra*, at 109 ("If the trend toward use of juries in patent cases continues, many Commission members believe that a serious threat to the patent system itself could be developing"); Gary Slutsker and David C. Churbuck, *Whose Invention Is It Anyway?*, *Forbes*, Aug. 19, 1991, at 114. ("[T]he patent system has become a lottery in which one lucky inventor gets sweeping rights to a whole class of inventions, and stymies development by inventors"); Edmund L. Andrews, *A "White Knight" Draws Cries of "Patent Blackmail,"* *N.Y. Times*, Jan. 14, 1990, § 3, at 5 (the upshot of allowing juries to handle more patent cases is a "judicial lottery [—] an often unpredictable system that can yield huge rewards for those who are sufficiently aggressive"; "[t]he courts have also allowed juries to handle more decisions, and many have proven eager to side with inventors against large

reversals of enormous jury verdicts in patent cases by the federal courts confirm this reality.³

As a result, the very constitutional purpose of the patent system, "[t]o promote the Progress of . . . useful Arts," Art. I, § 8, Cl. 8, is at risk and important segments of our increasingly technology driven economy are disrupted. At the same time that there is increasing skepticism about the use of the juries in complex patent trials, there has been a dramatic rise in the number of jury trials in patent disputes. Throughout most of the history of patent litigation, juries had been rarely used. By the 1990's, the proportion of jury trials in patent cases had exploded almost tenfold from its level even as recently as the 1970's.⁴ Compare Gary M. Ropski, *Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation (Part I)*, 58 J. Pat. Off. Soc'y 609, 609-11 (1976)

companies."); see also Edmund L. Andrews, *Rich in the 90's on Ideas Hatched in the 50's*, N.Y. Times, Nov. 13, 1992, at A1 ("Increasingly, companies are deciding that it is safer to buy peace for a few million dollars up front than to run the chances of losing 10 times as much in a [patent] jury trial."); Simson L. Garfinkel, *Software Makers Row Over Patents*, Christian Science Monitor, Sept. 12, 1989, at 8 (software industry expert claimed that companies like REFAC "are just buying patents to see if they can shake some money free").

³ See, e.g., *Wardlaw v. Halliburton Co.*, No. 93-1322, 1994 U.S. App. LEXIS 30524 (Fed. Cir. Oct. 31, 1994) (reversing a \$10 million judgment); *Collins Licensing v. American Tel. and Tel. Co.*, 28 U.S.P.Q.2d 1847 (Fed. Cir. 1993) (reversing \$35 million judgment), rev'g No. 7-90-CV-201 (W.D.Tex. filed March 27, 1992); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202 (Fed. Cir. 1992), cert. denied, ___ U.S. ___, 122 L.Ed.2d 131 (1993) (reversing \$70 million judgment); *Litton Systems, Inc. v. Honeywell, Inc.*, No. CV 90-4823, 1995 U.S. Dist. LEXIS 729 (C.D. Cal. Jan. 4, 1995) (rejecting a \$1.2 billion damages award); *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, No. 3:90-CV-150-H (N.D. Tex. filed Aug. 23, 1995) (rejecting \$5.8 million jury verdict).

⁴ There has also been a corresponding overall rise in the number of patent cases filed with the federal courts. See Director of Admin. Office of U.S. Courts, *Ann. Reps.* for the following years: 1980-1995. In 1992 alone, 1,474 patent cases were filed as opposed to 1,171 in 1991, a 26 percent increase over the prior year. *Id.*, Table C-2, at 180 (1993).

with Director of Admin. Office of U.S. Courts, *Ann. Reps.* (1991-1995).

At issue in this appeal is the appropriate role, if any, of the jury in the interpretation and application of patent claims. In answering this question, it is essential that this Court assure that the recognized role of the judge in determining the ultimate scope and meaning of the claims is preserved. This issue comes to this Court based on a jury trial in which claim construction was originally left to the jury's decision by general verdict.

The all too common procedure of submitting ultimate legal issues to juries for resolution by general verdict must be curtailed and modified to prevent the patent system from completely becoming a "judicial lottery." The predictability and order on which the patent system depends (*See*, Section IIA, *infra*) is lost when juries are given wide berth to decide complex issues involving questions of law or mixed questions of fact and law such as the scope and meaning of a patent claim. These dangers are particularly acute when juries are asked to render their decisions by general verdict.⁵

⁵ Prior to the *Markman* decision, submission of patent cases to juries by general verdict was the norm. An examination of model jury instructions and verdicts for patent cases reveals that juries are commonly asked to determine claim scope in rendering a general verdict of infringement rather than the claims being construed by the courts as a matter of law. To determine infringement, juries are often only asked to decide whether the accused device comes within any of the claims of plaintiff's patent. See, e.g., *Modern Federal Jury Instructions* 5-65, 9-120, 11-60 (Matthew Bender 1993) (5th, 9th and 11th Circuits). In the *Markman* trial below, the jury was given one simple question to determine infringement, namely, "Do the products manufactured by defendant Westview infringe any of the following claims of plaintiff Markman's patent?" See Joint Appendix at 282.

B. Absent Procedural Safeguards And Guidance, Juries Are Likely To Misunderstand And Misconstrue Technical Issues Presented To Them

Under the present system, juries face almost insurmountable challenges when confronted with complex scientific and technical evidence and issues which commonly arise in patent litigation. The definition of patent rights through civil litigation may be a uniquely complex and time-consuming process which places extraordinary demands on the fact finder in comprehending the principles of patent law, as well as the technical and scientific elements of the invention. Advisory Commission Report, *supra*, at 107. See, e.g., *Lemelson*, 968 F.2d 1202 (jury verdict reversed on grounds that the jury had reached inherently inconsistent conclusions regarding the alleged uniqueness of the patent in issue); *Texas Instruments*, No. 3:90-CV-150-H (jury verdict reversed because the jurors had either failed to follow the law or were hopelessly confused).

A typical jury has little or no experience in the technical or legal issues which are presented in most patent cases. See, e.g., *ILC Peripherals Leasing Corp. v. International Business Machs. Corp.*, 458 F. Supp. 423, 448 (N.D. Cal. 1978), *aff'd*, 636 F.2d 1188 (9th Cir. 1980), *cert. denied*, 452 U.S. 972 (1981) (in a complex case in which highly technical and financial issues were to be decided, only 1 out of 11 jurors had even limited technical education). Thus, most jury members are likely to be intimidated by and unfamiliar with the technical evidence which confronts them in patent litigation. Advisory Commission Report, at 107. See, e.g., *Dual Mfg. & Eng'g, Inc. v. Burris Indus., Inc.*, 619 F.2d 660, 667 (7th Cir.) (*en banc*), *cert. denied*, 449 U.S. 870 (1980) (the court observed that for this reason "members of the Patent Bar have wisely avoided jury trials in patent litigation") (citations omitted); *Tights, Inc. v. Stanley*, 441 F.2d 336, 342 (4th Cir.), *cert. denied*, 404 U.S. 852 (1971) (patent cases can involve "opaque technicalities" such as scientific theories, mechan-

ical devices, and complex compounds which might confuse juries); *Great Plains Chem. Co., Inc. v. Micro Chem., Inc.*, 549 F. Supp. 1348 (D. Colo. 1982). ("This case is a monument to the risk of futility in asking a jury to decide a complex patent case."); cf. *Ross v. Bernhard*, 396 U.S. 531, 538 n.10 (1970) (the Supreme Court tacitly recognized that juries had "practical abilities and limitations"); *ILC Peripherals Leasing Corp.*, 458 F. Supp. at 447 (even though "[t]he jurors were conscientious and diligent, . . . their past experience had not prepared them to decide a case involving technical and financial questions of the highest order").⁶

⁶ Frequently during jury selection, a venireman who is perceived to have training in technology, or relevant education and experience will be challenged by one of the parties. Advisory Commission Report, *supra*, at 107; Steven I. Friedland, *Legal Institutions: The Competency and Responsibility of Jurors in Deciding Cases*, 85 Nw. U.L. Rev. 190, 193 (1990). This is because inevitably one party will perceive its case as being technically weak and that it is to its advantage to use peremptory challenges to rid the panel of any juror likely to bring an informed technical understanding of the issues. Martin J. Adelman, *The New World of Patents Created by the Court of Appeals for the Federal Circuit*, 20 U. Mich. J.L. Ref. 979, 1004 (1987); Laura A. Kiernan, *Burger Sees Complex Trials Beyond Capacity of Jurors*, Wash. Post, Aug. 8, 1979, at A4 (Chief Justice Warren Burger was quoted as saying "[e]xperienced business and professional people, accountants, professors of economics, statisticians or others competent to cope with complex economic or scientific questions are often taken off juries by lawyers"). See also Warren E. Burger, *Is Our Jury System Working?*, Reader's Dig., Feb. 1981, 126, 129 ("When lawyers are allowed in on [the jury selection] process they often pervert the quest for an impartial jury with questions that seek not so much to identify bias as to divine sympathies and thus obtain a favorable jury.").

A statistical study of the jury selection in *SCM Corp. v. Xerox Corp.*, 463 F. Supp. 983 (D. Conn. 1978), confirms that there is an inherent systematic bias in the jury selection process. The study made the following significant findings: over half of the available jurors were excused for cause; members of the jury population with relevant skills and background were more likely to be excused; those who had education beyond high school were more likely to be challenged; and the jurors charged with resolving the case had an average education of the tenth grade.

Consequently, jurors are often incapable of fully understanding the issues or the evidence involved in complex cases, and therefore, cannot decide such cases rationally in accordance with the facts and the applicable rules of law. *See e.g., Wardlaw*, No. 93-1322, 1994 U.S. App. LEXIS 30524 (no reasonable jury could have concluded that plaintiff's patent was infringed under the doctrine of equivalents); *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815 (Fed. Cir. 1989) (jury's interpretation of the patent claims could not be sustained legally); *see also* Adelman, *supra*.⁷

Given the daunting difficulties facing juries in deciding patent cases, it is imperative that jury trials be conducted with proper procedural safeguards and guidance so as to reduce the likelihood that the process will result in irrational, unreviewable, and unpredictable decisions. Advisory Commission Report, *supra*, at 109 ("the Commission notes that some means *must* be employed to ensure consistent and accurate results in jury trials") (*emphasis added*). For the system to operate efficiently and predictably, legal issues must be maintained for decision by the courts and triable factual issues

Douglas W. Ell, Note, *The Right to an Incompetent Jury: Protracted Commercial Litigation and the Seventh Amendment*, 10 Conn. L. Rev. 775 (1978).

⁷ The Special Committee on Jury Comprehension of the American Bar Association's Litigation Section undertook an in-depth examination of jury decision making in complex cases. Special Committee of Jury Comprehension, A.B.A. Litig. Sec., *Jury Comprehension in Complex Cases*, (1989). The study confirmed other research by demonstrating juror difficulty in understanding and applying judicial instructions. *Id.* at 43-52. The study reveals that jury comprehension is affected by the juror's own personal familiarity with the problem in issue. *Id.* at 25-26. In a sexual harassment trial, the jurors expressed familiarity with the interpersonal events involved, and the large volume of evidence presented was not a problem. *Id.* at 26. In contrast, in a trade secrets case, jurors indicated that they had trouble deciding one of the claims because of the large volume of evidence they had to consider. *Id.* at 25 (most jurors reported that they were overwhelmed by the technical nature of the evidence in trying to decide complex technical cases).

must be manageably presented to the jury for its resolution. Failure to do so jeopardizes the constitutional and statutory interests in the patent grant.

II. ALLOWING JURIES AND NOT THE COURT TO DETERMINE THE ULTIMATE MEANING OF A CLAIM THWARTS THE CONSTITUTIONAL AND CONGRESSIONAL MANDATES UNDERLYING THE PATENT LAWS AND IS AT ODDS WITH THIS COURT'S PRIOR DECISIONS

A. The Constitutional Mandate Establishing The Patent System Requires That Claims Be Precise And Capable Of Predictable Determination By The Interested Public

It is well recognized and understood that the competitive conditions created by our free enterprise system are the very lifeblood of the American economy. It is further recognized that industrial innovation is essential to the nation's welfare through the productivity gains, economic growth, new jobs and higher standard of living that result from technological progress.⁸

The U.S. patent system is designed to promote technological innovation by providing clear and enforceable rights of ownership to the subject matter that is properly described and identified in the claims of a patent. The patent confers the potent right on its owner to exclude all others from making, using or selling that which is properly defined by the claims. 35 U.S.C. § 154(a)(1) (1995). Since technological innovation is often dependent upon the expenditure of substantial amounts of time, effort and capital resources, the patent system encourages and rewards these efforts through the economic incentive provided by the right to exclude. As this

⁸ See Advisory Committee on Industrial Innovation, *Final Report*, at 6 (1979); *Global Competition, The New Reality: The Report of the President's Commission on Industrial Competitiveness*, Vol. 1, at 2-3 (1985).

Court stated in *Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966), "[t]he patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it is a reward, an inducement to bring forth new knowledge."

The founding fathers, including Thomas Jefferson, recognized the importance of encouraging inventors with the incentives that private monopolies provide, but they also understood that patent monopolies come at a price. Article I, § 8, Cl. 8 prohibits "the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." *Graham*, 383 U.S. at 6. The framers recognized that because patents grant to their owners the ability to monopolize the production, use and sale of the subject matter described by the patent claims, these private monopoly rights may reduce or eliminate competition, resulting in restricted output and higher prices to consumers. *Graham*, 383 U.S. at 7-10. See also F.M. Scherer, *Industrial Market Structure and Economic Performance*, 442, 450 (2d ed. 1980); George J. Stigler, *The Organization of Industry*, 123-25 (1980).

For these reasons, the founding fathers were careful to authorize the establishment by Congress of a patent system that carefully balanced the inducements of invention provided by private monopolies against the concomitant harm to competition. As this Court stated in *Atlantic Works v. Brady*, 107 U.S. 192, 200 (1882), in warning of the harm of unwarranted patent rights:

Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advance-

ment of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

The constitutional balance requires that "the things which are worth to the public the embarrassment of an exclusive patent," must outweigh the restrictive effect of the limited patent monopoly. *Graham*, 383 U.S. at 10-11.

Thus, Art. I, § 8, Cl. 8, of the U.S. Constitution is both a grant and a limitation on the power of Congress. The grant is to establish laws to encourage and reward individual effort by means of private patent monopolies. The limitation is to the particular end of "promot[ing] the Progress of Science and useful Arts." *Graham*, 383 U.S. at 9.

In order to provide the appropriate stimulus to invention, it is essential that the law protect through the mechanism of the patent monopoly only that which the inventor properly claims and defines as his invention, and no more. Uncertainty concerning the enforceable scope of patent claims chills the progress of the useful arts because innovators and entrepreneurs will be more reluctant to invent and invest when they are unable to reasonably evaluate the benefits of patent rights and the risks of infringement.

Efficient business and industry upon which our economy depends is dependent upon the creation of a stable body of law that can be precisely applied to determine what the public is excluded from using by the patent claim, and what remains to be freely used by the public unmolested. Because of the huge amounts of capital resources that can depend on where the boundary will ultimately be drawn, it is essential that businesses can rely on the rational application of the legal principles by the courts. These were the very concerns and objectives that motivated Congress to revise the patent laws in 1952. *Graham*, 383 U.S. at 18. (The purpose of the

1952 revision was to foster "uniformity and definiteness"). These same concerns also motivated Congress to form the Court of Appeals for the Federal Circuit which has exclusive appellate jurisdiction over patent matters. *See* H.R. Rep. No. 312, 97th Cong. 1st Sess. 11 (1981) ("[T]he uniformity in the law that will result from the centralization of patent appeals in a single court will be a significant improvement from the standpoint of the industries and businesses that rely on the patent system. Business planning becomes easier as more stable and predictable patent law is introduced.").

In order to strike the balance envisioned by the constitutional framers, the statutory scheme established by Congress requires that a patent claim submitted by the patentee and allowed by the Patent and Trademark Office shall "distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (1984). This particularity requirement ensures that the patentee's right to exclude is appropriately limited and that the patent claim provides the required notice to the public. As stated in *White v. Dunbar*, 119 U.S. 47, 52 (1886):

The [patent] claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this Court that it is unnecessary to pursue the subject further.

When the metes and bounds of a patent claim are not reliably and predictably determined by the federal courts, the lines of intellectual property ownership become blurred. When this occurs, companies may be deterred from entering markets that should be open to competition, or may face lawsuits brought by competitors seeking to gain market share, stifle competition, or collect damages and royalties to which

they are not lawfully entitled. A patent system in which the scope of a patent cannot be predictably determined by the application of established principles does not comply with Constitutional or congressional mandates.

B. The Ultimate Meaning Of A Claim Is A Matter Of Law For The Court To Determine Based Upon the Documentary Record

This Court has long made clear that claim construction is a matter of law to be determined by the trial court. *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1870); *Winans v. New York & Erie R.R.*, 62 U.S. (21 How.) 88, 100 (1858); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848); *see also* 2 William C. Robinson, *The Law of Patents for Useful Inventions*, § 731, at 481 (1890).

Winans v. Denmead, 56 U.S. at 338, leaves no doubt regarding the proper responsibility of the courts in determining the ultimate scope and meaning of a claim. *Winans* was a patent jury trial in which this Court was presented with the question of whether infringement was for the court or the jury to decide. In settling this issue, this Court unequivocally stated that claim construction is a matter of law for the trial judge:

On such a trial [for infringement], two questions arise. The first is, what is the thing patented; the second, has the thing been constructed, used or sold by the defendants.

The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.

Id. at 338. Thereafter, in *Coupe*, 155 U.S. at 579, this Court recounted its cases on point and summarized them as follows:

The doctrine of the cases is aptly expressed by Robinson . . . as follows: "Where the defense denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judges whether the invention so defined covers the art or article employed by the defendant."

That claims be construed as a matter of law by the trial court is necessary in order "that the public, while the term continues, may be able to understand what the patent is, and refrain from its use, unless licensed." *Hogg*, 47 U.S. at 484. *Accord*, *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931).

That is not to say that the determination of the ultimate scope and meaning of a claim by the court as a matter of law may not require the resolution of material evidentiary disputes. Because claims are written to one of ordinary skill in the art, evidentiary disputes may arise regarding the interpretation of a technical term to a worker skilled in the art.

But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions and other manufactured products, which have their existence *in pais*, outside of the documents themselves; and which are commonly described by terms of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them right; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention.

Bischoff, 76 U.S. at 815.

However, a material evidentiary issue can only arise in connection with claim interpretation where a party initially meets its high threshold burden of introducing evidence that a disputed claim term has a special technical meaning to one of ordinary skill in the applicable art *and* demonstrating that this special technical meaning is not inconsistent with the documentary record relied upon by the Patent and Trademark Office and the public. It is the responsibility of the trial judge to act as the gatekeeper and discern whether specific triable evidentiary issues are actually present with respect to the issue of claim construction. *See Winans v. New York & Erie R.R.*, 62 U.S. at 100. ("The testimony of experts which was rejected had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent"); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 714 (Fed. Cir. 1984) ("[D]uring the course of a trial it is incumbent on the court to discern what material, factual issues are actually present in the case.").

Thus, in order to determine whether a material evidentiary issue exists, the trial judge must make an initial determination as to whether a disputed claim term is urged to have a special technical meaning and, if so, whether the proffered meaning is *consistent* with the documentary record. *See, Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940). *See also Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992) ("The litigation-induced pronouncements of [the inventor], coming nearly at the end of the term of his patent, have no effect on what the words of that document in fact do convey and have conveyed during its term to the public.") (citing *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984)). Accordingly, prior precedent of this Court and elsewhere dictates that a material evidentiary issue as to claim construction only arises where two independent criteria are met: first, the judge must deter-

mine whether there is a genuine evidentiary dispute as to whether the claim term has a special technical meaning; and second, the judge must then determine whether the proffered definitions are *consistent* with the documentary record.

An issue raised by the parties to this appeal is whether material and genuine evidentiary disputes concerning technical meanings of claim terms are purely legal disputes, in which case they are to be decided by the trial judge as a matter of law, or whether they represent discrete factual issues to be decided by the jury.⁹

However, this case does not necessarily present the issue of whether subsidiary fact issues regarding the meaning of technical terms should be submitted to the jury. Indeed, applying the rules of patent construction to the Markman patent demonstrates that there were no genuine and material evidentiary disputes with respect to the interpretation of the claims. The patent here pertains to a system for dry cleaning establishments to track customer clothing. The issue before the district court was whether the claim term "inventory" referred to only articles of clothing or whether it also included cash in the till. This dispute as to the meaning of the term "inventory" is precisely the type of dispute that the trial judge must resolve as a matter of law since the term does not have a technical meaning in the relevant art and therefore must be construed in accordance with the documentary record and ordinary English usage.

⁹ We do not take a position on this question since, we contend, the record contains no genuine and material evidentiary dispute regarding the meaning of the claim term "inventory" as used in the Markman Patent. However, if this Court finds it necessary to reach this issue and concludes that there were factual issues, we provide our views as to how those narrow factual issues should be tried so as to properly preserve the appropriate role of judge and jury and ensure that the ultimate meaning of a claim always remains a question of law for the trial judge. See Section III, *infra*.

III. IN THE RARE CASE WHERE AN UNDERLYING, EVIDENTIARY DISPUTE ARISES REGARDING THE DETERMINATION OF THE MEANING OF A TECHNICAL CLAIM TERM, THE MATTER SHOULD BE RESOLVED, IF TRIABLE TO A JURY, BY NARROWLY FOCUSED SPECIAL VERDICTS OR SPECIAL INTERROGATORIES

When issues of fact and law are tried to a jury, it is essential that the courts institute safeguards consistent with the Seventh Amendment to ensure that the legal issues are determined by the court and that only triable factual questions are determined by the jury. When the jury is allowed to render a general verdict in a patent case, the jury may usurp the court's role of determining the ultimate scope of the claims as a matter of law. The use of special verdicts or special interrogatories ensures that the judge and jury properly perform their respective roles.

A. Special Verdicts Or Special Interrogatories Help Ensure That The Jury Process Is Rational, Reviewable And Predictable

Rule 49 of the Federal Rules of Civil Procedure authorizes the use of special verdicts or special interrogatories in civil cases.¹⁰ Rule 49 verdicts provide a process by which juries' decisions of evidentiary fact may be distinguished from the application of law to fact and from the courts' determination of law. To achieve this purpose, Rule 49 verdicts should place narrowly framed, fact specific questions to the jury.¹¹

¹⁰ Rule 49(a) authorizes the use of special verdicts, while Rule 49(b) authorizes the use of special interrogatories. Where special verdicts under Rule 49(a) are used, the jury only renders written findings upon each issue of fact. Where special interrogatories under Rule 49(b) are used, the jury renders a general verdict and also answers written interrogatories on specific issues of fact necessary to the verdict.

¹¹ In the case of special verdicts, in order to properly direct the jury's fact finding role, little or no explanation of the substantive law is necessary or, indeed, desirable:

(footnote continued)

Rule 49, Fed. R. Civ. P., is consistent with the Seventh Amendment, which this Court has held requires only "that questions of fact in common law actions shall be settled by a jury," *Walker v. New Mexico & S. Pac. R.R.*, 165 U.S. 593, 596 (1897). On this basis, this Court has upheld the use of directed verdicts and summary judgment where there are no triable issues of fact to be decided by the jury. *Galloway v. United States*, 319 U.S. 372, 396 (1942) (upholding directed verdicts); *Fidelity & Deposit Co. of Md. v. United States*, 187 U.S. 315, 320 (1902) (upholding summary judgment). Indeed, this Court's promulgation of a Rule is "a prima facie judgment that the Rule in question transgresses neither the terms of the [Rules] Enabling Act nor constitutional restrictions." *Hanna v. Plummer*, 380 U.S. 460, 471 (1965).

The practical experiences of the Federal Circuit led it to recognize that Rule 49 verdicts are ideally suited to complex patent litigation. This recognition is based on the conclusion that absent procedural safeguards, the danger of juror confusion concerning both technology and law is particularly acute and carries with it the likelihood of material harm to the public interest fostered by the patent system.¹² The Federal Circuit, therefore, has favored the use of special verdicts:

When using the special verdict, the judge need not—should not—give any charge about the substantive legal rules beyond what is reasonably necessary to enable the jury to answer intelligently the questions put to them.

Skidmore v. Baltimore & O.R. Co., 167 F.2d 54, 66, (2d Cir. 1945), *cert. denied*, 335 U.S. 816 (1948).

¹² Since nearly its inception, the Federal Circuit has been keenly aware of the problems presented by the trial of patent cases to juries. In *Structural Rubber*, 749 F.2d at 718, it recognized that:

Concerns have been expressed by the patent bar that a jury trial creates a black box into which patents are thrown and emerge intact or invalid by an unknown and unknowable process. The trial of a patent case, in which the judge and jury perform appropriate functions and which provides a record that clearly delineates the basis for the decision, not only allay these concerns, but is also the right of the litigants.

Because of the many factual variables which may enter into . . . a general verdict, it is a formidable task to draft unobjectionable instructions which lay out alternative mandatory general verdicts if specific facts are found. However, [the use of special verdicts under] Fed. R. Civ. P. 49(a), provides a viable alternative

Resort to Rule 49(a) greatly simplifies the instructions which must be given and clearly separates the respective functions of judge and jury The utilization of Rule 49(a) appears to us as a particularly useful tool in conserving judicial resources and in effectuating the Congressional policy expressed in the patent laws.

Structural Rubber, 749 F.2d at 723-24. *Accord*, *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1517 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984) ("Failure to submit detailed fact interrogatories will not in every case result in the need for a new trial. Rule 49, Fed. R. Civ. P. The practice is nonetheless strongly recommended as an appropriate means of guiding a jury, increasing the reliability of its verdict, and facilitating the judicial role following a jury trial"). *See generally*, Samuel M. Driver, *The Special Verdict - Theory and Practice*, 26 Wash L.Rev. 21 (1957), Elizabeth A. Faulkner, Note, *Using the Special Verdict to Manage Complex Cases and Avoid Compromise Verdicts*, 21 Ariz. St. L.J. 297 (1989); Charles T. McCormick, *Jury Verdicts Upon Special Questions in Civil Cases*, 2 F.R.D. 176 (1941); John R. Brown, *Federal Special Verdicts: The Doubt Eliminator*, 44 F.R.D. 338 (1967); Gary M. Ropski, *Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation (Part II)*, 58 J. Pat. Off. Soc'y. 673 (1976).

The experiences of the regional circuits prior to the creation of the Federal Circuit led them to place an even stronger emphasis on the unique need for special verdicts in patent cases and, in the case of the Seventh Circuit, to require their

use. In its parting words of advice to the newly created Federal Circuit, the Seventh Circuit issued an *en banc* decision in which, using its supervisory powers, it reiterated that special verdicts were mandated in patent jury trials. *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1340 (7th Cir. 1983) (*en banc*) (citing *Dual Mfg. & Eng'g, Inc.*, 619 F.2d 660).

In *Roberts*, the Seventh Circuit was faced with the appeal of a judgment following a jury trial in which the patent in suit was found valid and infringed and over eight million dollars in damages were awarded. The case was presented to the jury to render what the trial court characterized as "special verdicts" on willfulness, infringement, anticipation (i.e., validity under 35 U.S.C. § 102) and obviousness (i.e., validity under 35 U.S.C. § 103). *Roberts*, 723 F.2d at 1328. The Seventh Circuit ruled that the "special verdicts" framed for jury determination were in fact impermissible, broad, general verdicts on issues which mixed fact and law. Accordingly, "[t]he trial court abdicated its control over the legal issue," *Id.* at 1342, and a new trial was required:

The verdict form utilized was "special" only in the sense that the legal issue of patent validity was broken down into components of obviousness and anticipation. Proper special verdicts, however, are to be addressed only to the subsidiary questions of fact that compose the *Graham* tripartite inquiry upon which the legal determination of validity must rest, not to the obviousness and anticipation components of patent validity themselves.

Id. at 1340.

The Fifth, Eighth and Eleventh Circuits reached similar conclusions regarding the use of special verdicts in complex patent cases. See *Baumstimler v. Rankin*, 677 F.2d 1061, 1071-72 (5th Cir. 1982) ("[w]hile the use of special interrogatories is left to the sound discretion of the trial judge, failure to utilize this method in a patent case places a heavy

burden of convincing the reviewing court that the trial judge did not abuse his discretion"); *Manufacturing Research Corp. v. Graybar Elec. Co., Inc.*, 679 F.2d 1355, 1365 (11th Cir. 1982); *E.I. du Pont de Nemours & Co. v. Berkley & Co., Inc.*, 620 F.2d 1247, 1256, n.5 (8th Cir. 1980). See also, *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 774 (5th Cir. 1980) (Rubin, J., concurring in part and dissenting in part) (use of general verdicts is a "Serbonian bog that threatens to engulf patent litigation"); *Control Components, Inc. v. Valtek, Inc.*, 616 F.2d 892 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980) (dissent from denial of rehearing *en banc*) (submission of obviousness to jury by general verdict is inconsistent with *Graham v. John Deere Co.*, 383 U.S. 1 (1966)).

The perils of general verdicts in patent litigation are two fold. Not only is the presentation of complex mixed issues of law and technical fact likely to result in juror bewilderment and error, but because of the limitations and fictions utilized on review of general verdicts, these errors are frequently beyond the courts' powers to detect and correct.

When a court is presented with a naked general verdict involving mixed issues of law and fact or the application of law to fact, an erroneous verdict may be effectively unreviewable because it is impossible to unscramble the issues of law from the issues of fact in order to analyze and assess whether the decision of the jury was both legally correct and based upon non-reversible factual findings. See, *Roberts*, 723 F.2d at 1343. This is so because on review of a general verdict "[i]n the absence of special interrogatories, [the Federal Circuit] presume[s] the existence of factual findings and legal conclusions necessary to support the verdict reached by the jury." *Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 607 (Fed. Cir. 1984), *overruled on other grounds by Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984). Because the facts actually found by the jury are

never known outside the jury room, a jury's general verdict on patent infringement or validity can be affirmed even where, in truth, it is based upon a legally prohibited claim meaning.¹³ In such circumstances, the benefits of the use of special verdicts or special interrogatories seem beyond dispute.¹⁴ *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983) (the practice of allowing a jury to return a naked general verdict leaves a wide area of uncertainty on review causing grave concerns over use of general verdicts in patent cases). Unfortunately, Rule 49 verdicts are all too rarely employed based upon present notions of the discretionary nature of their use. *See Weiner v. Rollform Inc.*, 744 F.2d 797, 809-10 (Fed. Cir. 1984), *cert. denied*, 470 U.S. 1084 (1985).

¹³ Both patent infringement and patent validity require as a threshold issue that the meaning of the patent claims be determined. Accordingly, any undetected error or claim interpretation necessarily corrupts the entire jury verdict in a patent trial. *See Roberts*, 723 F.2d at 1338-39:

Initially, we note that the jury was required to interpret the scope and identity of the Roberts patent claim. That was asking too much of the jury. Construction of the patent claim, a prerequisite to the determination of validity and infringement, is a matter of law for the court. Only a factual dispute as to the meaning of a term of art used in the patent claim, the resolution of which required resort to expert testimony, properly would have been submitted to the jury. *Super Prods. Corp. v. D P Way Corp.*, 546 F.2d 748, 756 (7th Cir. 1976). Because the trial court's construction of Roberts' claim was necessary to the jury's resolution of the factual disputes on the differences between the subject matter of the claim and the prior art, that error has shadowed the entire decisional process.

¹⁴ Petitioner, respondent, and another amici in support of petitioner have themselves recognized and supported the use of special verdicts or special interrogatories to resolve what they characterize as factual issues underlying claim interpretation. *See*, Brief for Petitioners at 40 n.21, Brief of Litton Systems, Inc. at 28 n.44, and Joint Appendix at 284.

B. This Court Should Now Exercise Its Supervisory Authority And Require The Use Of Rule 49 Verdicts In Patent Cases Absent Special Circumstances

Although Fed. R. Civ. P. 49 provides that the district courts "may require" special verdicts, or interrogatories, the discretion thus vested in the trial courts has limits. In cases such as this, "a district court's exercise of discretion is to be judged in the 'interest of sound judicial administration.'" *Curtiss-Wright Corp. v. General Elec. Co.*, 446 U.S. 1, 10 (1980) (citing *Sears Roebuck & Co. v. Mackey*, 351 U.S. 427, 437 (1956)). *See Albemarle Paper Co. v. Moody*, 422 U.S. 405, 416 (1975). ("However, such discretionary choices are not left to the courts' 'inclination, but to its judgment; and its judgment is to be guided by sound legal principles.' *United States v. Burr*, 25 F. Cas. 30, 35 (C.C. Va. 1807) (Marshall, C.J.).")

Prior to the establishment of the Federal Circuit, the Seventh Circuit, when confronted with the difficulties in reviewing patent appeals, exercised its supervisory authority and mandated the use of special verdicts. *Roberts*, 723 F.2d at 1340-41. Other circuits indicated a strong preference that special verdicts be utilized in these circumstances. (*See* Section III A, *supra*) Likewise, the Federal Circuit recognized the benefits of special verdicts but felt that it did not have the power to mandate their use. *Weinar*, 744 F.2d at 809-10.¹⁵

This Court unquestionably has the supervisory power over the administration of justice in federal courts. *McNabb v. United States*, 318 U.S. 332, 341 (1942). This supervisory power is inherent to this Court and includes the power "to mandate 'procedures deemed desirable from the viewpoint of

¹⁵ In various opinions, the Federal Circuit has indicated that it is not vested with the supervisory powers that the regional circuits may exercise. *In Re Innotron Diagnostics*, 800 F.2d 1077, 1083 (Fed. Cir. 1986)

sound judicial practice although in nowise commanded by statute or by the Constitution.' " *Thomas v. Arn*, 474 U.S. 140, 146-47 (1985), (citing *Cupp v. Naughten*, 414 U.S. 141, 146 (1973). See *Bank of U.S. v. Halstead*, 23 U.S. (10 Wheat.) 51, 61 (1825) (Marshall, C.J.) ("Congress might regulate the whole practice of the courts, if it was deemed expedient so to do; but this power is vested in the courts; and it never has occurred to anyone that it was a delegation of legislative power.").

This Court's supervisory power extends to civil cases and has been exercised to ensure that juries in federal civil cases are fair and impartial. *Thiel v. Southern Pac. Co.*, 328 U.S. 217, 220 (1945). See *Peters v. Kiff*, 407 U.S. 493, 500 n.9 (1972) (recognizing the exercise of supervisory power in *Thiel*). Supervisory power "rests on the firmest ground when used to establish rules of judicial procedure." *Thomas*, 474 U.S. at 147 n. 5. Requiring the use of special verdicts in patent cases is just such a rule of judicial procedure.

Special verdicts further "sound judicial administration" and should be required in patent cases absent special circumstances demonstrating that the claim construction issue is simple and straightforward; and that the scope of the claim can be easily explained by the trial judge and readily understood by the jury. Anything less fails to address the constitutional and statutory requirement that patent claims provide clear notice to the public, the difficulties confronted by juries in deciding patent cases, and the serious due process questions raised by the submission of complex patent cases for jury decision by general verdict. (See Section III C, *infra*).

In *Thiel*, this Court held that supervisory authority was necessary to ensure that a representative and impartial jury was empanelled. Here, the need to ensure that a rational and reviewable decision is rendered by the jury similarly requires the exercise of supervisory authority.

C. The Use of General Verdicts In Complex Patent Litigation Raises Serious Due Process Questions

A "fair trial in a fair tribunal is a basic requirement of [procedural] due process." *Withrow v. Larkin*, 421 U.S. 35, 46 (1975) (citing *In re Murchison*, 349 U.S. 133, 136 (1955)). The function of the due process clause is to promote procedures that "minimize the risk of erroneous decisions." *Greenholtz v. Inmates of the Neb. Penal and Correctional Complex*, 442 U.S. 1, 13 (1979) See *Matthews v. Eldridge*, 424 U.S. 319, 335 (1976); *Peters*, 407 U.S. at 501 (there is a "due process right to a competent and impartial tribunal").

To our knowledge, this Court has not addressed whether the Due Process Clause is violated when mixed issues of law and fact are presented to a jury for resolution by general verdict.¹⁶ Given the complexity of the legal issues regarding claim construction and of the facts presented in most patent cases and further given the "practical abilities and limitations of juries," *Ross*, 396 U.S. at 538 n.10, serious due process concerns may exist when juries are asked to decide patent cases by general verdict.

In *Matthews*, 424 U.S. at 334, this Court recognized that " '[d]ue process,' unlike some legal rules, is not a technical concept with a fixed content unrelated to time, place, and circumstances.' *Cafeteria & Restaurant Workers Union v. McElroy*, 367 U.S. 886, 895 (1961)." Accordingly, the Court in *Matthews* set forth a method for determining the nature and extent of required procedures when due process concerns are implicated. As stated by Justice O'Connor:

¹⁶ In *United Gas Public Serv. Co. v. Texas*, 303 U.S. 123, 140-41 (1937), this Court considered whether on the record before it there was a constitutional violation by submission of complex *factual* issues to a jury by general verdict and concluded that there was not. This differs from the case at hand which questions the submission of the ultimate *legal* meaning of a claim to a jury as part of a general verdict of infringement.

Matthews described a sliding scale test for determining whether a particular set of procedures was constitutionally adequate. We look at three factors: (1) the private interest at stake; (2) the risk that existing procedures will wrongly impair this private interest, and the likelihood that additional procedural safeguards can effect a cure; and (3) the governmental interest in avoiding these additional procedures. Matthews, *supra*, at 335, 47 L Ed 2d 18, 96 S Ct 893.

Pacific Mut. Life Ins. Co. v. Haslip, 499 U.S. 1, 53 (1991) (O'Connor, J. dissenting). Here, there are clear private interests of patentees and defendants at stake; the risk that the existing procedures will wrongly impair these private interests is very high (*see* Section I, *supra*); procedural safeguards are readily available to effect a cure (*see* Section III A, *supra*); and the governmental interest in avoiding these procedures is non-existent.

Special verdicts resolve due process concerns both at the trial level and on appeal. Special verdicts "minimize the risk of erroneous decisions" at the trial level by ensuring that the judge and jury properly perform their respective roles. Special interrogatories also facilitate effective review at the appeal level by ensuring that the findings of fact and conclusions of law are properly demarcated so that the appellate court can apply the appropriate and respective standard of review to each. *See Griffin v. Illinois*, 351 U.S. 12, 20 (1956) (due process at appellate level is required).

IV. CONCLUSION

The judgment below should be affirmed and this Court should provide clear direction to the federal trial courts concerning the allocation of legal and factual issues between judge and jury in patent trials.

Respectfully submitted,

MORTON AMSTER
JOEL E. LUTZKER*

**Counsel of Record*

DAVID H. KAGAN
AMSTER, ROTHSTEIN & EBENSTEIN
90 Park Avenue
New York, New York 10016
(212) 697-5995

Counsel for Amici Curiae
Matsushita Electric Corporation
of America and Matsushita
Electric Industrial Co., Ltd.

December 8, 1995

Library of Congress
FBI
JAN 1971

Department of the United States
Justice

MEMORANDUM FOR

Attorney General

FROM: [illegible]

Subject: [illegible]

DATE: [illegible]

FOR THE ATTORNEY GENERAL
[illegible]

RECEIVED [illegible]

U.S. DEPARTMENT OF JUSTICE

BEST AVAILABLE COPY

TABLE OF CONTENTS

OPINIONS BELOW	1
INTEREST OF AMICUS	2
SUMMARY OF ARGUMENT	2
ARGUMENT	3
1 THE CONSTRUCTION OF THE CLAIM IS USUALLY THE ONLY INFRINGEMENT QUESTION	3
2 IN THE 1800'S, COURTS GAVE INSTRUCTIONS ON THE CONSTRUCTION OF PATENTS WHICH WERE DIRECTED VERDICTS	5
3 JURIES VOTE OVERWHELMINGLY THAT PATENTS ARE INFRINGED.	8
CONCLUSION	13

TABLE OF AUTHORITIES

Statutes

Patent Act of 1836, ch 357, § 6, 5 Stat. 117 (July 4, 1836)	11
Patent Act of 1870, ch. 230, § 26, 16 Stat. 198 (July 8, 1870)	11
35 U.S.C. § 112	11

Cases

<i>Aro Mfg. Co. v. Convertable Top Replacement Co.</i> 365 U.S. 336 (1961)	11
<i>Case v. Brown</i> , 69 U.S. (2 Wall.) 320 (1864)	6
<i>Corning v. Burden</i> , 56 U.S. (15 How.) 252 (1853)	5
<i>Garratt v. Seibert</i> , 131 U.S. cxv (1874)	6
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 247 (1877)	11
<i>O'Reilly et al. v. Morse, et al.</i> , 56 U.S. 62 (1853)	4
<i>Prouty and Mears v. Ruggles</i> , 41 U.S. (16 Pet.) 336 (1842)	5
<i>Seymour et al. v. McCormick</i> , 60 U.S. (19 How.) 96 (1856)	6
<i>Wright v. Herring Curtiss</i> , 211 Fed. 564 (2nd Cir. 1914)	4

No. 95-26

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1995

MARKMAN, et. al.

Petitioners

v.

WESTVIEW INSTRUMENTS, et. al.

Respondents

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR AMICUS CURIA, JOHN T. ROBERTS
SUGGESTING AFFIRMANCE

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") is reported at 52 F.3d 967. The decision of the United States District Court for the Eastern District of Pennsylvania ("District Court") is reported at 20 USPQ2d 1955.

INTEREST OF AMICUS

Amicus files this brief to bring to the attention of the Court certain matters, believed to be relevant, which are outside the record below. For this reason, it is believed neither the parties, nor other amici will address these matters. The brief is submitted with the written consent of the parties, filed herewith.

Amicus takes no position on the merits of this case. The suggestion for affirmance is limited to the fact that 11 of 12¹ judges below decided the correct answer to the issue presented (Does the claimed term "inventory" cover "cash"), was NO. Should a majority of this Court reach an opposite conclusion, then amicus would suggest a reversal.

The interest of amicus is that of a patent lawyer, who believes that properly limited patents do indeed serve the public interest, but do not do so when extended to cover devices not invented by the patentee.

SUMMARY OF ARGUMENT

In the normal patent case there is only one infringement question. To construe the claim is to decide who wins the infringement issue. In the early days of the United States, trial judges have gave infringement instructions which amounted to a directed verdict, when

¹ The 12th Judge did not explicitly disagree, but urged the case should be returned to the District Court to add the rather clearly implied statement that he found "there was no substantial evidence..."

there was no question of the accused structure and the only question was the construction of the claims. Patent jury cases are becoming more common, and juries vote overwhelmingly that patents are infringed. For over a century Congress has required a patent to "distinctly claim" the invention; and this Court has stated that Courts cannot enlarge the patent beyond the scope of the claims. The actions of juries are often in conflict with those historic limitations on patent rights.

ARGUMENT

1. THE CONSTRUCTION OF THE CLAIM IS USUALLY THE ONLY INFRINGEMENT QUESTION

The Federal Circuit opinion includes the now mandatory statement that infringement analysis entails two steps, (first, determining the meaning and scope of the patent claims; second comparing the construed claim to the accused device).

No amount of repetition makes this statement universally true. Indeed it is generally untrue. In the majority of the cases, and this appears to be one, the construction of the claim is the only infringement issue. As expressed by Judge Mayer below at 989:

"...to decide what the claims means is nearly always to decide the case."

Take two instances famous in history. In each of these cases, the only infringement question was:

"Does the Morse patent cover the Colombian (O'Reilly) Telegraph which uses marks and signs differing from the Morse Code?"²

"Does the Wright patent cover an aeroplane in which the pilot may sometimes regain level flight without rudder control?"³

In neither case did the court formulate the issue exactly in these words, and the above questions may oversimplify. They illustrate the point however that deciding what the claim means decides who wins the case.

When there is no issue about the actual structure⁴ of the accused device, there is only the one question. Usually, if not nearly always, there is no issue about the accused structure. There was no issue about the structure of the Columbian telegraph, Glen Curtiss' aeroplane, or any of the accused devices in the cases in the next section.

² This Court thought so in *O'Reilly et al. v. Morse, et al.*, 56 U.S. 62 (1853).

³ Five Judges thought so, (including a young District Judge, Learned Hand, in a companion case) see *Wright v. Herring Curtiss*, 211 Fed. 564 (2nd Cir. 1914). Despite this decision, the Wrights had more difficulty enforcing their United States patent than their European patents, and but for World War II, the Wright Flyer might today still be in England.

⁴ or composition or process

As there is only one question, the next issue is who decides that question. It is simply not something which can be bifurcated. If the jury could have decided the Morse patent did not cover telegraphs using signs different from the Morse Code, they and they alone would have decided the entire issue.

2. IN THE 1800'S, COURTS GAVE INSTRUCTIONS ON THE CONSTRUCTION OF PATENTS WHICH WERE DIRECTED VERDICTS.

In *Prouty and Mears v. Ruggles*, 41 U.S. (16 Pet.) 336, 340 (1842) the Circuit Judge had instructed the jury:

"That upon the true construction of the patent, it is for a combination, and a combination only. That the combination ... consists of three things..."

This was a single issue case, as the patentee had asked for an instruction that two elements were enough, and the defendant offered no evidence. The jury duly found for the defendant, and this Court affirmed.

In *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1853) the Circuit Judge had instructed the jury:

"That the machine used by defendant is an infringement (if it operates by the same process although it differs in construction)"

There was no disputed fact. The defendants machine differed from that disclosed in the patent in construction although it operated by the same process (converting puddlers' balls into blooms...!). This Court felt this was a

single issue case, where a preclusive instruction was proper.⁵

In *Seymour et al. v. McCormick*, 60 U.S. (19 How.) 96 (1856) the Circuit Judge had instructed the jury that Claim 2 of the 1845 patent was for teeth and fingers for seizing the grain. The jury returned a verdict⁶ as instructed and this Court affirmed.

In *Case v. Brown*, 69 U.S. (2 Wall.) 320 (1864) the Circuit Judge had instructed the jury, "...The plaintiff cannot claim double dropping (of a seed planter), that is a result or effect." The jury duly returned a verdict for defendant, and the patentee appealed on the ground that the Judge had withdrawn the "question of fact"⁷ from the jury (the same result). Justice Grier affirmed stating:

"The instruction there quoted is a correct exposition of the law, and if it produced a verdict in favor of the defendant, the plaintiff has no right to complain."

In *Garratt v. Seibert*, 131 U.S. cxv (1874) the Circuit

⁵ This Court felt that the instruction should have been "not an infringement", as it held that processes were not patentable. In due time this Court agreed with the Circuit Judge on this point also.

⁶ The verdict was for the patentee, as the defendant was urging a broader construction, to avoid costs, if the patent contained an (unasserted) invalid claim.

⁷ This brief has consciously refrained from using the terms "question of fact" or "question of law" as they appear to obscure, not illuminate, the issues presented. As used above, the term simply assumes the desired result, an example of circular reasoning.

Judge instructed the jury that claim 2 covered only the lubricator and did not include the heating apparatus, also disclosed in the patent. The jury found the defendant, who used the lubricator only, to infringe.

Justice Strong stated that the question presented was whether Claim 2 included the heating apparatus an part of the combination. He then stated that the answer to that question determined whether or not there was an infringement. The Court then construed the claim and affirmed the judgement.

In each of these cases, there was a "one issue" infringement question. In each of them, the trial judge instructed the jury in a manner which directed a single verdict. In each of these cases, this Court approved of this type of instruction.

Necessarily, this Court believed that in each of these cases, the only infringement question, the scope of the claim, belonged solely in the province of the trial court, and not to the jury.

Amicus suggests, based on the Federal Circuit decisions, and the District Court opinion, the above "one step" analysis applies here, as there is no doubt about the accused structure. Amicus further suggests that this Court should limit its decision to this classic and usual situation, and not attempt to formulate a universal rule, applicable to all cases, including the minority, where there may be doubt about the structure of the accused device.

The results of the last 15 years show that juries cannot be relied on to perform this function of determining the proper scope of patent claims.

3. JURIES VOTE OVERWHELMINGLY THAT PATENTS ARE INFRINGED.

In the past 15 years, juries have returned infringement verdicts over 200 times.⁸ Of these the juries have found that the patents are infringed 85% of the time,⁹

⁸ The list, verdicts from about 1980 to 1993, has been compiled by the author and his associates over several years. The number of entries today stands at 186.

⁹ Patents Jury Found Infringed "patent (source)"
3,900,886 (CA CV 90-2323); 3,351,836 (ED Mich CA 78-70740); 3,574,374 (ED Mich CA 78-70740); 3,581,178 (ED Mich CA 78-70740); 3,582,747 (ED Mich CA 78-70740); 3,602,790 (ED Mich CA 78-70740); 3,796,936 (ED Mich CA 78-70740); 3,875,401 (D Minn CA 87-4847; 88-1624); 4,002,899 (D Minn CA 87-4847; 88-1624); 3,860,935 (D Minn. CA 87-4847; 88-1624); Re.29,599 (D Minn. CA 87-4847; 88-1624); ??? (1987 US Dist LEXIS); 4,166,388 (1993 US App LEXIS 1915); 4,497,520 (1991 US Dist LEXIS 15891); 4,900,171 (1992 US Dist LEXIS 752); ??? (20 USPQ2d 1367); ??? (15 USPQ2d 1159); ??? (15 USPQ2d 1154); 3,342,422 (8 USPQ2d 1669); 3,351,836 (31 USPQ2d 1746); 3,462,964 (11 USPQ2d 1735); 3,498,621 (5 USPQ2d 1535); 3,574,374 (31 USPQ2d 1746); 3,581,178 (31 USPQ2d 1746); 3,602,790 (31 USPQ2d 1746); 3,659,915 (19 USPQ2d 1838); 3,664,269 (28 USPQ2d 1352); 3,702,076 (15 USPQ2d 1453); 3,807,409 (8 USPQ2d 1299); 3,864,102 (11 USPQ2d 1375); 3,877,307 (15 USPQ2d 1453); 3,941,993 (15 USPQ2d 1241); 3,952,311 (32 USPQ2d 1603); 4,149,513 (26 USPQ2d 1401); 4,198,756 (12 USPQ2d 1081); 4,254,529 (13 USPQ2d 1607); 4,301,040 (12 USPQ2d 1916); 4,330,280 (25 USPQ2d 1870); 4,374,798 (19 USPQ2d 1881); 4,384,853 (25 USPQ2d 1870); 4,391,590 (25 USPQ2d 1870); 4,438,842 (15 USPQ2d 1074);

4,450,512 (2 USPQ2d 1779); 4,459,302 (20 USPQ2d 1836); 4,529,034 (14 USPQ2d 1210); 4,549,302 (20 USPQ2d 1836); 4,554,574 (27 USPQ2d 1784); 4,592,353 (29 USPQ2d 1533); 4,600,014 (32 USPQ2d 1040); 4,694,244 (29 USPQ2d 1533); 4,703,173 (22 USPQ2d 1551); 4,736,743 (29 USPQ2d 1533); 4,787,938 (21 USPQ2d 1321); 4,798,729 (31 USPQ2d 1173); 4,844,957 (22 USPQ2d 1551); 5,017,391 (31 USPQ2d 1173); Re.33,206 (27 USPQ2d 1521); 3,190,326 (229 USQP 43); 3,247,736 (223 USQP 533); 3,282,312 (229 USQP 43); 3,459,199 (218 USQP 31); 3,674,562 (216 USQP 687); 3,860,003 (227 USQP 786); 3,973,282 (218 USQP 433); 4,243,864 (230 USQP 501); 5,015,516 (156 FRD 806); 4,165,184 (5 F.3d 1557); 4,318,619 (5 F.3d 1557); 3,660,163 (547 F.Supp. 401); 3,837,292 (579 F.Supp. 353); 3,246,751 (593 F.Supp. 1275); 3,609,694 (593 F.Supp. 1275); 4,065,264 (611 F.Supp. 964); 4,138,288 (611 F.Supp. 964); ??? (614 F.Supp. 1368); 3,789,832 (630 F.Supp. 581); ??? (678 F.2d 746); 3,966,396 (679 F.2d 1023); Re.27,757 (696 F.Supp. 1033); 4,029,401 (703 F.Supp. 408); ??? (704 F.2d 1133); 4,034,918 (713 F.2d 1347); 3,524,680 (723 F.2d 1553); 4,066,423 (736 F.2d 666); 3,319,515 (739 F.2d 604); 3,644,125 (744 F.2d 797); 4,117,644 (744 F.2d 797); 4,197,194 (748 F.Supp. 1078); 3,843,051 (749 F.2d 707); 4,117,977 (749 F.2d 707); 4,363,820 (757 F.Supp. 1030); 4,545,933 (757 F.Supp. 1030); 4,600,588 (757 F.Supp. 1030); 4,814,688 (757 F.Supp. 1088); 4,831,282 (757 F.Supp. 1088); 4,905,189 (757 F.Supp. 1088); 3,904,506 (758 F.2d 613); 3,925,182 (758 F.2d 613); 4,544,203 (774 F/S 1277); 4,305,467 (774 F.2d 478); 3,846,347 (787 F.2d 1545); 4,248,975 (787 F.2d 1545); 3,535,844 (797 F.2d 1504); 4,752,603 (798 F.Supp. 213); 4,766,075 (798 F.Supp. 213); 4,853,330 (798 F.Supp. 213); 3,901,501 (799 F.2d 734); 3,815,586 (806 F.2d 1565); Re.30,867 (806 F.2d 1565); 4,245,343 (813 F.2d 1196); 4,310,343 (814 F.2d 628); 3,918,565 (818 F.Supp. 707); 4,376,328 (827 F.2d 1524); 4,378,600 (827 F.2d 1524); 4,221,071 (847 F.2d 1573); 3,803,660 (849 F.2d 585); 4,846,326 (855 F.Supp. 1101); 3,414,254 (862 F.2d 283); 3,485,120 (862 F.2d 267); 3,907,332 (868 F.2d 1226); 3,736,968 (872 F.2d 978); 3,746,656 (872 F.2d 978); 3,825,960 (873 F.2d 1422); 3,833,948 (873 F.2d 1422); 4,109,844 (888 F.2d 815); 4,560,168 (904 F.2d 676); 4,062,141 (927 F.2d 1552); 4,024,535 (932 F.2d 939); 4,185,167 (932 F.2d 939); 3,941,082 (952 F.2d 1320); Re.32,106 (968 F.2d 1202); 4,286,925 (984 F.2d 410); Re. 32,292 (991 F. 2d 753); 4,656,605 (993 F.2d 858); 4,727,513 (993 F.2d 858); 5,550,540 (24 USPQ2d 1493);

and not infringed 15% of the time¹⁰.

Two questions are presented by this information. The first is whether the sample is valid or biased. Excluded are all jury cases settled after verdict but before appeal, except those few known to the compilers. There are surely 20, but probably not 50 of these verdicts. There are probably a dozen more verdicts, where some reference is contained in some reported (but unfound) opinion. If the omitted verdicts vary in percentage at all from the listed ones, the percentage of the total patents found infringed would not appear to change substantially.

The second question presented is what is the significance of this information¹¹ to the Court in this case. There might be little significance, but for the first point

4,103,001 (231 USQP 593)

¹⁰ Patents Jury Found Not Infringed "patent no. (source)"

4,029,401 (703 F.Supp. 408); 3,581,399 (12 USPQ2d 1081); 3,709,231 (12 USPQ2d 1554); 4,195,862 (31 USPQ2d 1526); 4,333,660 (14 USPQ2d 1077); 4,392,553 (3 USPQ2d 1876); 4,684,150 (31 USPQ2d 1526); 5,044,659 (31 USPQ2d 1526); 5,098,117 (31 USPQ2d 1526); 5,581,399 (12 USPQ2d 1081); 3,748,015 (216 USQP 760); 3,821,763 (216 USQP 760); 3,910,434 (216 USQP 563); Re.31,904 (5 F.3d 1557); 3,709,231 (718 F.Supp. 1403); 4,110,210 (730 USQP 753); 4,226,706 (730 USQP 753); 3,308,590 (744 F.2d 797); Re.30,366 (799 F.2d 734); 4,344,261 (848 F.2d 179); Re.31,746 (870 F.2d 1546); 3,852,579 (872 F.2d 978); 4,664,020 (945 F.2d 1546); 4,628,910 (946 F.2d 850); 4,664,020 (20 USPQ2d 1332);

¹¹ It would have no significance if patentees brought only strong cases, if the accused refused to settle most weak cases, or if the patentees cases were almost always better presented. Amicus suggests that these are not supportable propositions.

made above. Infringement overwhelmingly involves only a single question.

On the assumption that there is some testimony or other evidence which supports infringement, and if the jury is allowed to answer the sole question, the defence of non-infringement, as a practical matter, is simply removed from the case.¹² From this several consequences flow.

For 125 years the patent law has explicitly required patentees to "distinctly claim" their inventions.¹³ Even earlier in 1836, the law required patent applications to be examined, which also required the application to "particularly specify and point out the part, improvement or combination, which he claims as his invention".¹⁴ It is the claim which is examined for patentable novelty, or unobviousness.

For over a century, this Court has repeatedly stated that patents are limited to their claims, *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 247, 278 (1877) (... "courts have no right to enlarge a patent beyond the scope of the claims..."); *Aro Mfg. Co. v. Convertible Top Replacement Co.* 365 U.S. 336, 339 (1961) ("if anything is settled in

¹² While some JMOLs are granted, and some jury verdicts are reversed on appeal, this is a very weak and uncertain reed, to the actual litigant facing a patent infringement suit before a jury.

¹³ Patent Act of 1870, ch. 230, § 26, 16 Stat. 198 (July 8, 1870); now 35 U.S.C. § 112

¹⁴ Patent Act of 1836, ch 357, § 6 5 Stat. 117 (July 4, 1836)

patent law...the combination patent covers only the totality of elements in the claim.")

If juries are at liberty to "construe" the claims, one consequence is that both the will of Congress will be frustrated, and the above quoted statements of this Court will be rendered somewhat hollow.

A second and more serious consequence also flows from this situation. Lawyers retained by those accused of infringement must share this dismal prospect with them. This Court may assume that the prospects on invalidity are equally dim (actually they appear slightly worse).

Thus in most patent jury cases, both the validity and infringement issues are practically unavailable, and the only realistic issue is damages. For recent patents where the real issue is the injunction over the next 15+ years, even the damage issue is not available, and there is no choice but to abandon the new product, or pay the asking price for a license.

This added cost falls entirely on the shoulders of those businesses who are designing and building new products. Either this endeavor is terminated, or the costs are necessarily passed on to the consuming public.

From the turn of the century until a few decades ago, the United States built the products which the world desired. In the last few decades, with rare exceptions, what Americans want, let alone what the rest of the world wants, is supplied by foreign industry. The effect of this turnabout

on the future well being of Americans is apparent.

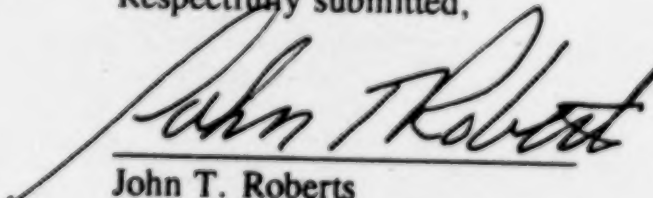
Other amici are here urging this Court to both confirm and expand the role of juries in patent cases. If that occurs, it will impose one more burden on "the progress of the useful arts", which over history has done so much for the United States, but is unarguably already failing in that important task.

CONCLUSION

This appears a good case for application of the rule that appellate courts should review the holdings, not the rhetoric, of opinions. All of the judges at the Federal Circuit appeared to agree that, when there is only one correct answer to a properly framed infringement question, the judge should answer that question, and rule accordingly.

This Court should first ask itself if the decision of Judge Katz correctly applied the above rule. If this Court concludes that Judge Katz did so, the judgement below should be affirmed.

Respectfully submitted,



John T. Roberts
1825 Eye Street, NW, Suite 400
Washington, D.C. 20006
202 429 2029
Counsel for Amicus

UNITED STATES DEPARTMENT OF JUSTICE

CRIMINAL DIVISION

ROBERT MARRAS AND PORTER, INC.,

Defendants,

VERSUS
WESTERN INSTRUMENTS, INC. and
ALBERT E. ROYCE, INC.,

Respondents.

On Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

IN SUPPORT OF PETITION FOR
WRIT OF HABEAS CORPUS AND ASSOCIATION
OF THE RIGHT OF RESPONDENTS

ROBERT MARRAS
President, Robert Marras
and Porter, Inc.
1401 15th Avenue, Suite 2000
Boulder, CO 80501-2267
(303) 440-1100

ALBERT E. ROYCE
President, Albert E. Royce
and Porter, Inc.
1401 15th Avenue, Suite 2000
Boulder, CO 80501-2267
(303) 440-1100

DAVID H. T. KANE
President, Federal Circuit Bar
Association and Counsel of Record
1200 I Street, N.W., Suite 700
Washington, D.C. 20005-3315
(202) 462-4000

SHIRLEY D. HOFFMAN
WESTERN INSTRUMENTS & KIRBY
220 Howard Ave. S.
Suite 2000
Minneapolis, MN 55402
(612) 340-3222

BEST AVAILABLE COPY

TABLE OF CONTENTS

<i>Statement of Interest of Amicus Curiae</i>	1
<i>Summary of Argument</i>	2
<i>Argument</i>	4
I. Claim Interpretation Disputes Are Inevitable In Patent Litigation, And Some Of These Disputes Can Only Be Resolved By Relying Upon Extrinsic Evidence.	4
A. Inconsistencies within the patent specification or interpretation of terms of art in the claims may require extrinsic evidence, including expert testimony.	4
B. <i>Markman</i> acknowledges that extrinsic evidence is necessary.	8
II. Issues Arising Under <i>Markman</i> and Their Practical Consequences	9
A. Patent holders and accused infringers should be able to ascertain the scope of a patent's claims.....	10
B. Court and jury roles should be clarified in a challenge to patent validity under 35 U.S.C. § 112, paragraph 2.	14
C. Court and jury roles should be clarified in a challenge to patent validity requiring a determination of the level of skill of one "skilled in the art". 15	
D. <i>Markman</i> 's effect on patent trial procedure should be considered.	16
<i>Conclusion</i>	18

TABLE OF AUTHORITIES

Cases

<i>Advanced Cardiovascular Systems Inc. v. Scimed Life Systems Inc.</i> , 887 F.2d 1070 (Fed. Cir. 1989)	5
<i>Dennison Manufacturing Co. v. Panduit Corp.</i> , 475 U.S. 809 (1986).....	16
<i>DMI v. Deere and Co.</i> , 755 F.2d 1574 (Fed. Cir. 1985).....	7
<i>Exxon Chemical Patents Inc. v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995)	12
<i>Gardco Mfg., Inc. v. Herst Lighting Co.</i> , 820 F.2d 1209 (Fed. Cir. 1987).....	17
<i>General Electric Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938).....	10
<i>Goodwall Constr. Co. v. Beers Constr. Co.</i> , 824 F. Supp. 1044, 1051, 1057 (N.D. Ga. 1992)	7
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	15
<i>Hilton Davis Chem. Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995)	13
<i>Hoffman-LaRoche, Inc. v. Burroughs Wellcome Co.</i> , 10 U.S.P.Q.2d 1602 (D. Md. 1989)	14
<i>In re Lockwood</i> , 50 F.3d 966, 33 U.S.P.Q.2d 1406 (Fed. Cir. 1995).....	14
<i>Lis v. Robert Packer Hosp.</i> , 579 F.2d 819 (3d Cir.).....	17

<i>Lucas Aerospace, Ltd. v. Unison Industries, L.P.</i> , 890 F. Supp. 329 (D. Del. 1995)	18
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) (<i>en banc</i>)	passim
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891).....	9
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1877)	9
<i>Moeller v. Ionetic Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986).....	5
<i>Tillotson Ltd. v. Walbro Corp.</i> , 831 F.2d 1033 (Fed. Cir. 1987).....	5
<i>United Carbon Co. v. Binney Co.</i> , 317 U.S. 228 (1942)	10

Statutes

35 U.S.C. § 102.....	9
35 U.S.C. § 103.....	15
35 U.S.C. § 112.....	6, 7, 14

Other Authorities

ROBINSON ON PATENTS, § 733	11
----------------------------------	----

No. 95-26

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
and ALTHON ENTERPRISES, INC.,

Respondents.

On Writ of Certiorari To The
United States Court of Appeals for the Federal Circuit

**AMICUS CURIAE BRIEF OF
THE FEDERAL CIRCUIT BAR ASSOCIATION**

Statement of Interest of *Amicus Curiae*

The Federal Circuit Bar Association is a national organization comprising approximately 2,100 members from all areas who practice before the United States

Court of Appeals for the Federal Circuit in all aspects of its jurisdiction. The Association offers a forum for common concerns and dialog before the Bar and the Federal Circuit, government counsel and private practitioners, litigators, and corporate counsel. One of the main purposes of the Association is to offer assistance and advice to the Federal Circuit, including briefs *amicus curiae*, on matters affecting practice before the Federal Circuit and lower tribunals such as the Patent and Trademark Office and district courts whose decisions are reviewed by the Federal Circuit.

The Association submits this brief as *amicus curiae* in the hope that the Court will find it useful in deciding the issues to be reviewed in this matter. The Association hopes that this brief *amicus curiae* will demonstrate to the Court the practical benefits of the opinion below. In particular, the Association wishes to identify examples of the various situations which may arise in the litigation of patent claims for the consideration of the Court.

The views expressed in this brief are not necessarily those of its authors, their respective law firms, or their clients.

Letters of consent from the parties to the filing of this brief have been filed with the Clerk of the Court.

Summary of Argument

The Federal Circuit Bar Association submits this brief in support of the Respondents' position. The Federal Circuit's decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en*

banc) (hereinafter *Markman*), resolved a difficult problem: balancing the conflicting arguments supporting judge versus jury interpretation of patent claims. The *Markman* decision offers solutions to many of the questions which arise in the context of judicial interpretation of patent claims, and to the extent questions remain unanswered, they will be resolved by the developing body of case law after *Markman*.

If the Court should believe it necessary to provide guidelines to trial courts and patent practitioners to clarify the respective roles of judge and jury, the Association wishes to provide examples of situations that may arise needing clarification. Overall, however, the Association believes that the benefits of *Markman* outweigh any practical difficulties in implementing the decision.

In practice, patent litigation frequently leads to cases in which a genuine dispute arises in the interpretation of claim language, requiring the introduction and evaluation of extrinsic evidence, that is, evidence as to the meaning of claim terms which does not appear in the patent specification or in the text of material submitted to the Patent and Trademark Office as part of the prosecution history. The *Markman* decision recognizes the necessity of such extrinsic evidence, and authorizes its introduction and evaluation by the court during the task of claim interpretation. *Id.* at 979.

The Association is mindful of Supreme Court Rule 37.1, and thus will not address the historical Seventh Amendment arguments made by the respective

parties. Instead, the Association wishes to focus on practical issues which arise in the course of protecting the rights of patent holders. It is hoped that the issues set forth herein will emphasize the practical benefit of the judicial interpretation of patent claims, and will assist the Court in providing any guidance it deems necessary to implement the Federal Circuit's decision.

Argument

I. Claim Interpretation Disputes Are Inevitable In Patent Litigation, And Some Of These Disputes Can Only Be Resolved By Relying Upon Extrinsic Evidence.

A. Inconsistencies within the patent specification or interpretation of terms of art in the claims may require extrinsic evidence, including expert testimony.

Numerous decisions of the Federal Circuit, including its decision in this matter, recognize the value of extrinsic evidence to ascertain the meaning of claims. *Markman*, 52 F.3d at 989. While it is clear that the claims, specification and prosecution history constitute an "undisputed public record" of proceedings in the Patent and Trademark Office, *id.*, at 980, it is likewise true that expert testimony is often helpful in resolving the meaning of disputed terms where those terms are not clear from the specification, prosecution history, or

other claims. See, e.g., *Advanced Cardiovascular Systems Inc. v. Scimed Life Systems Inc.*, 887 F.2d 1070, 1072-73 (Fed. Cir. 1989).

A first example is when the patent specification uses a term inconsistently in reference to more than one described structure. In the case of *Moeller v. Ionetics Inc.*, 794 F.2d 653 (Fed. Cir. 1986), the claim under interpretation utilized the term "electrode," but the patent specification "variously referred to both the electrode assembly and the sensitive tip of the electrode as 'the electrode'." *Id.* at 657. Further, one of the claims referred not only to an "electrode," but also to an "electrode system" and an "electrode body." Ionetics, the accused infringer, asserted that the use of the term "electrode" in the claim referred only to the ion-selective tip of its product, and not the entire length of the wire; the patent holder, Moeller, offered an expert declaration explaining that the term "electrode" is commonly used in three distinct senses. Clearly, in such a case, reference to the specification and prosecution history will provide little guidance to either the trial court or reviewing court as to what meaning of the term appearing in the specification should be adopted in construing the claim. Under those circumstances, it is only by resort to extrinsic evidence, and in particular, expert testimony, that the court can complete the first step of infringement analysis and resolve just what it is that the patentee owns.

Another instance may arise where reference solely to the documentary record would create an inconsistent result. Consider the situation presented in *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir.

1987). In assessing a summary judgment motion on a reissued claim, the claim construction issue turned on whether the omission of the phrase "sole force" broadened or narrowed the reissued claim. The patent holder asserted a factual dispute as to whether atmospheric pressure in a chamber constituted a force acting within the chamber. During prosecution of the reissue patent, the Examiner originally rejected the proposed reissue claim, apparently using a zero baseline from which to measure pressure, meaning that the pressure in the chamber could never be "negative" (in other words, where a zero baseline is used, zero pressure in the chamber would constitute a vacuum, and the chamber could never contain less than a vacuum). Extrinsic evidence was submitted to show that industry practice would utilize atmospheric pressure as a base value, so that a pressure in the chamber below atmospheric pressure would be read as a negative pressure. Without resort to this evidence, the claim would have been inherently inconsistent.

Consider also a challenge to the validity of a patent under the enablement requirement of 35 U.S.C. § 112, paragraph 1. The statute specifically requires description of the invention in such "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same . . ." A typical challenge to enablement might occur where one skilled in the art would interpret a claim term differently than used in the patent. Arguably, the use of a term in a context different from the context known to one skilled in the art would disable, rather than enable, the skilled artisan from making and using the invention, rendering the patent

invalid. Extrinsic evidence concerning the usage of claim terms among those skilled in the art is useful in this circumstance.

Further, questions of the interpretation of claim terms might arise in the context of means-plus-function language under 35 U.S.C. § 112, paragraph 6. That paragraph was written "precisely to avoid a holding that a means-plus-function limitation be construed to cover only means disclosed in the specification." *DMI v. Deere and Co.*, 755 F.2d 1574 (Fed. Cir. 1985). A determination of the scope of equivalent structures will often necessarily include analysis of the claim terminology by reference to other means known to those who are skilled in the art.

Finally, consider the case of an accused infringer defending against a charge of willful infringement, who must explain to the jury the infringer's interpretation of a claim term in support of the contention that the infringer reasonably believed they did not infringe. Whether or not the offered claim interpretation is ultimately adopted by the court, expert testimony as to use of terminology in a particular industry, subject of course to cross-examination, could aid in the alleged infringer's defense. See generally *Goodwall Constr. Co. v. Beers Constr. Co.*, 824 F. Supp. 1044, 1051, 1057 (N.D. Ga. 1992), *aff'd in relevant part*, 991 F.2d 751, 756 (Fed. Cir. 1993) ("genuine evidentiary dispute" supported by record evidence related to proper interpretation of terms "riveter", "blunt-tipped moil point rod" and "secured forced pressure" in claims).

B. *Markman* acknowledges that extrinsic evidence is necessary.

The majority opinion below acknowledges that extrinsic evidence "may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear- in the patent and prosecution history," explaining that "[a] judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed." *Markman*, 52 F.3d at 981, 986. The majority asserts that:

[in] using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language as a matter of law based on the patent documents themselves, the court is not crediting certain evidence over other evidence or making factual evidentiary findings. Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.— The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history. It is therefore still construction, and is a matter of law subject to de novo review.

Markman, 52 F.3d at 981 (emphasis added) (footnote omitted).

II. Issues Arising Under *Markman* and Their Practical Consequences

Markman not only clarified the roles of judge and jury in a patent infringement action, it will also have a significant effect on the courtroom procedures and options for a patent holder at the district court level. Trial procedures for patent cases adopted by this Court must be procedurally workable and fair in order to protect the rights of all patent holders and patent infringers. The following issues should therefore be considered when providing guidance to the lower courts on claim interpretation.

A. Patent holders and accused infringers should be able to ascertain the scope of a patent's claims.

A function of the claims in a patent is to inform the public of the rights and scope of the invention claimed by the inventor. As the Federal Circuit noted in *Markman*, "it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." *Markman*, 52 F.3d at 978 (citing *Merrill v. Yeomans*, 94 U.S. 568 (1877)); see also *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) ("The object . . . is not only to secure to [the patentee] all to which he is entitled, but to apprise the public of what is still open to them."). The primary purpose of this requirement is to provide clear warning to others as to what constitutes infringement of the patent. At the same time, a patent is not to unduly inhibit experimentation and further advances in the

field. "A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon Co. v. Binney Co.*, 317 U.S. 228, 236 (1942).

A second function of the claims is to apprise the inventor of the scope of the invention in which the inventor has rights. The inventor should be able to reasonably interpret the scope of the claims without resort to constant litigation. As this Court has noted, it is a benefit to the patentee to be able to arrive at a true and consistent scope of the claims. "The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).

Prior to *Markman*, a patent holder involved in multiple lawsuits risked inconsistent jury verdicts when a jury was allowed to apply different interpretations to the claims of a patent. Although the jury verdict could be appealed, under the clearly erroneous standard applied by an appellate court in its review of jury claim interpretation findings, inconsistent claim interpretations could result. A patent holder therefore faced uncertain litigation outcomes while litigating the same patent.

In *Markman*, the Federal Circuit recognized a patentholder's fear of inconsistent jury verdicts. As noted by the court:

To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would it once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.

Markman, 52 F.3d at 979 (citing 2 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 733 (1890)). To ensure that a patent holder is able to obtain a clear and universal definition of their rights under a patent, claim interpretation was held to be a matter of law. *Markman*, 52 F.3d at 979. The *de novo* review provided for by *Markman* will provide more uniformity to patent holders.

Amicus believe that the benefits provided to patent holders by the *de novo* review of claim interpretation outweigh any practical difficulties that critics have suggested will arise in implementing

Markman. The Federal Circuit decision should therefore be affirmed. At the same time, however, *de novo* review raises several issues about trial practice for patent holders and the appropriate role of judge and jury in collateral interpretation matters. As set forth below, the existence of these issues should not suggest that *Markman* is unworkable. Instead, these issues are presented to assist the Court should the Court deem it necessary to provide further guidance in implementing the *Markman* decision.

Under *Markman*, more consistent interpretations may result in cases where a patent holder sues multiple parties under the same patent. However, *de novo* review may place additional pressure on the patent holder during the district court trial. With a *de novo* review of claim interpretations, a patent holder could be required to present sufficient evidence to support several alternate claim interpretations at the district court level. The consequences of not presenting alternative evidence at trial, and the potential effect on the patentee, is aptly demonstrated by the case *Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995). In *Exxon*, Exxon presented at the district court level one interpretation of a claim directed to a patented lubricating oil composition. Lubrizol presented and argued a second conflicting interpretation. The trial judge selected Exxon's interpretation, and charged the jury according to Exxon's construction. The jury found that the patent was not invalid under 35 U.S.C. § 102 or § 103, and that Lubrizol had willfully infringed the claims of the patent. Attorneys' fees and costs were awarded to Exxon, an injunction was entered against

Lubrizol, and a damage award was entered in a separate proceeding.

In its *de novo* review of the trial judge's selection of Exxon's preferred claim interpretation, the Federal Circuit determined that Exxon's claim interpretation was incorrect, and that Lubrizol's was only partly correct. *Id.* at 1555. The Federal Circuit also found that under a jury charge stating the correct interpretation of the claims, "no jury could reasonably have found—on the evidence submitted by Exxon—that Lubrizol's accused products literally infringed Exxon's claims." *Id.* Because of Exxon's failure of proof, Lubrizol was granted judgment as a matter of law without remand. The Federal Circuit therefore vacated the order awarding attorneys' fees, costs, and the injunction against Lubrizol.

As noted by Judge Nies in the dissent, "by advocating a different interpretation of the claim *sua sponte*, the majority required Exxon to litigate during trial not only its opponent's position but also the unknowable position of the appellate court." *Id.* at 1569. By requiring a patent holder to litigate several permutations of a claim at a district court level, the Federal Circuit may have increased the introduction of evidence at trial. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520–21 (Fed. Cir. 1995), *petition for cert. filed*, (U.S. Nov. 6, 1995) (No. 95-728). While consistency will therefore improve under *Markman*, the burden on a patent holder to present additional theories and expand the evidence presented at trial may have increased.

B. Court and jury roles should be clarified in a challenge to patent validity under 35 U.S.C. § 112, paragraph 2.

Markman raises practical concerns in determining patent validity based on claim indefiniteness under 35 U.S.C. § 112, paragraph 2. The standard for a determination of patent validity based on claim indefiniteness is whether a claim reasonably apprises those skilled in the art of the scope of the invention. The decision below presupposes that there is no ambiguity in the claim language to a person of ordinary skill in the art that would require resort to evidence outside of the specification and prosecution history. Although the decision notes that ambiguity and vagueness in claim language go to claim validity based on indefiniteness and not to claim construction, issues of claim indefiniteness are intertwined with claim construction.

In patent infringement litigation there is often a factual dispute. When disputes as to the meaning and scope of the technical terms or words of art arise in the context of claim construction, its resolution is a ruling of law. However, when such disputes arise in the context of claim validity based on indefiniteness, its resolution is typically based on a findings of fact. See, e.g., *Hoffman-LaRoche, Inc. v. Burroughs Wellcome Co.*, 10 U.S.P.Q.2d 1602, 1607 (D. Md. 1989) (dispute as to which meaning of the term "homogenous" was intended by the patentee raises factual issues in a determination of indefiniteness). The Federal Circuit recently held in *In re Lockwood*, 50 F.3d 966 (Fed. Cir. 1995) that the issue of validity must be given to the jury as a matter of

constitutional right. This disparate treatment of disputes as to the meaning of claim terms depending on the context raised has not yet been resolved.

C. Court and jury roles should be clarified in a challenge to patent validity requiring a determination of the level of skill of one "skilled in the art".

The focus of the inquiry in construing disputed terms in patent claim language is on what one of ordinary skill in the relevant art at the time of the invention would have understood the disputed terms to mean in view of the claims, specification, and prosecution history. *Markman*, 52 F.3d at 986; *Pall*, 66 F.3d at 1224 (Mayer, J., concurring).

That inquiry is similar to the validity inquiry into nonobviousness under 35 U.S.C. § 103, which provides, in pertinent part, that a patent may not be obtained

if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

This Court has characterized the obviousness inquiry as one of law that "lends itself to several basic factual inquiries" including the scope and content of the prior art; the differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1,

17 (1966). In *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986), the Court explained that the subsidiary inquiries that must be made under the test for nonobviousness are factual in nature and are to be reviewed on appeal under the clearly erroneous standard. Thus, this Court may wish to address whether the determination of what one of ordinary skill in the relevant art at the time of the invention would have understood disputed claim terms to mean subsumes the *Graham* determination of the level of ordinary skill in the relevant art.

D. *Markman's* effect on patent trial procedure should be considered.

The interpretation of claim language often determines the outcome of litigation. Patent holders typically argue one interpretation of the claim, and alleged infringers another. Selecting between the two interpretations, or creating a third interpretation, can foreclose a fact finder's decision when applying the facts of the case to the selected claim construction.

Because of the importance of the claim interpretation process, several courts have noted the changes in trial procedure that may arise if a judge must interpret the claim before instructing a jury. First, *Markman* may require additional furcation of a typical patent infringement lawsuit. As Judge Newman noted in her dissent, *Markman* may require a "mini-trial" or other evidentiary hearing in order for a judge to learn sufficient information about the claim language to decide the disputed issues. *Markman*, 52 F.3d at 1008 n.5. The addition of a mini-trial to hear evidence solely

directed to claim interpretation should provide the judge with sufficient information to make the often difficult determination between competing claim interpretations.

It has been recognized that it is advantageous to decide all claims and issues in a civil action within one trial. *Lis v. Robert Packer Hosp.*, 579 F.2d 819 (3d Cir.), *cert. denied*, 439 U.S. 955 (1978). Because of increasing court caseloads, and the limited time for scheduling and hearing trials, the efficient resolution of civil matters demands that as many issues as possible be decided within the span of one trial. The addition of mini-trials would add an additional break in a typical patent infringement action.

It should be noted, however, that such furcations are not new to patent infringement actions. The rules provide that under certain circumstances claims or issues may be separated for separate trials if it is in the interest of efficient judicial administration. FED. R. CIV. P. 42(b). In particular, it has become commonplace for patent cases to be bifurcated (if not trifurcated) into separate phases. *See Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987) ("Under Rule 42(b), a district court has broad discretion in separating issues and claims for trial as part of its wide discretion in trial management.") Typically one phase is directed to liability, and one phase is directed to damages. An additional furcation of a patent lawsuit would therefore not introduce new procedures into a patent infringement action.

A second procedural change suggested by *Markman* is the practical problem of providing a district

court adequate time to fairly rule on claim interpretation issues while the jury waits for instruction. As noted by Judge Schwartz in *Lucas Aerospace, Ltd. v. Unison Industries, L.P.*, 890 F. Supp. 329 (D. Del. 1995):

To construe the claims before giving the case to the jury requires immediate access to a trial manuscript, i.e., daily copy which creates a not insignificant expense to the parties, . . . rapid briefing by the parties, and hopefully an opinion by the court. In this case, it would probably have taken no less than five days for the parties to file helpful briefs and the court to memorialize its holdings on claim construction in a meaningful manner. If the jury were sent home during this period, there is a very real chance that many of the facts important to resolving the infringement issues will have been forgotten.

Id. at 332 n.3.

Mitigating any delay caused by claim interpretation is the ability of courts to rule on claim interpretation issues prior to trial. Appropriate use of pre-trial motions may actually shorten patent trials by resolving claim interpretation issues prior to the presentation to the jury of remaining factual issues.

Conclusion

The Federal Circuit Bar Association respectfully urges affirmation of the decision below. The *Markman* decision provides a workable resolution of the challenge

of balancing judge and jury roles in patent litigation, and will benefit patent holders and accused infringers alike. Subsequent decisions of the Federal Circuit will provide

guidance to judges and practitioners in the resolution of the issues raised herein.

Respectfully submitted,

David H.T. Kane
1300 I. Street, N.W., Suite 700
Washington, DC 20005-3315
(202)408-4000
*President, Federal Circuit Bar
Association and Counsel of Record*

Robert J. Carlson
Stephen C. Bishop
Christensen O'Connor
Johnson & Kindness^{PLLC}
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347
(206) 682-8100

Anne E. Brookes
Gunn & Associates
Five Greenway Plaza, Suite 2900
Houston, TX 77046
(713) 850-9922

Rudolph P. Hofmann
Westman, Champlin & Kelly
900 Second Ave. S., Suite 1600
Minneapolis, MN 55402
(612) 334-3222

DEC 8 1995

CLERK

No. 95-26

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
*Respondents.***On Writ Of Certiorari To The**
United States Court of Appeals
For The Federal Circuit**BRIEF OF AMICUS CURIAE**
AIRTOUCH COMMUNICATIONS, INC.
IN SUPPORT OF RESPONDENTS**ALLAN N. LITTMAN**
*Counsel of Record***ROBERT P. TAYLOR****JOHN O'HARA HORSLEY****PILLSBURY MADISON & SUTRO LLP****225 Bush Street****San Francisco, CA 94104****(415) 983-1000***Counsel for Amicus Curiae**AirTouch Communications, Inc.*

TABLE OF CONTENTS

	<u>Page</u>
INTEREST OF AMICUS CURIAE	1
SUMMARY OF ARGUMENT	2
ARGUMENT	5
I. THE MAJORITY DECISION OF THE EN BANC PANEL SHOULD BE AFFIRMED BASED ON ENDURING PRECEDENT HOLDING THAT PATENT CLAIM INTER- PRETATION IS A LEGAL ISSUE TO BE DECIDED BY JUDGES AND REVIEWED DE NOVO AS A QUESTION OF LAW	5
A. The precedents of this Court have long held that patent interpretation is a matter of law, to be decided by the trial judge and reviewed de novo on appeal	5
B. The English common law circa 1791 did not treat patent interpretation as a question of fact for the jury	13
C. The precedents of the Federal Circuit support the en banc decision below, and any conflicting precedents from the Federal Circuit should be overruled	16
D. The Federal Rules of Evidence relating to ex- pert testimony are consistent with the decision of the en banc court below	19
II. CONCLUSION	22

TABLE OF AUTHORITIES

Cases

	<u>Page</u>
<i>Administrators of Calthorp v. Waymans</i> , 3 Keb. 710 (K.B. 1676)	14
<i>Arkwright v. Nightingale</i> , 1 Carp. P.C. 38 (C.P. 1785)	14
<i>Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.</i> , 739 F.2d 604 (Fed. Cir. 1984)	18
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	6, 10-12
<i>Bramah v. Hardcastle</i> , 1 Carp. P.C. 168 (K.B. 1789)	14
<i>Brooks v. Steele and Currie</i> , 14 R.P.C. 46 (1897)	15-16
<i>Cardinal Chemical Co. v. Morton Int'l, Inc.</i> , 113 S. Ct. 1967 (1993)	19
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	passim
<i>Dollond's Case</i> , 1 Carp. P.C. 28 (C.P. 1758)	14
<i>Fromson v. Advance Offset Plate, Inc.</i> , 720 F.2d 1565 (Fed. Cir. 1983)	17
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson</i> <i>Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995) (en banc) (per curiam), petition for cert. filed, 64 U.S.L.W. — (Nov. 6, 1995)	18
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	6, 10, 14
<i>Hogg v. Emerson</i> , 52 U.S. (11 How.) 587 (1851)	10
<i>Kalman v. Kimberly Clark Corp.</i> , 713 F.2d 760 (Fed. Cir. 1983)	17, 19

TABLE OF AUTHORITIES

CASES

	<u>Page</u>
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. (5 Otto) 274 (1877)	20
<i>Liardet v. Johnson</i> , [unreported] (1778)	15-16
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891)	20-21
<i>McGill Inc. v. John Zink Co.</i> , 736 F.2d 666 (Fed. Cir. 1984)	18
<i>Merrill v. Yeomans</i> , 94 U.S. (4 Otto) 568 (1876)	20
<i>Milburn Co. v. Davis-Bournonville Co.</i> , 270 U.S. 390 (1926)	21
<i>Morris v. Branson</i> , 1 Carp. P.C. 30 (K.B. 1776)	14
<i>Motion Picture Patents Co. v. Universal</i> <i>Film Mfg. Co.</i> , 243 U.S. 502 (1917)	2
<i>Palumbo v. Don-Joy Co.</i> , 762 F.2d 969 (Fed. Cir. 1985)	18
<i>Read Corp. v. Portec, Inc.</i> , 970 F.2d 816 (Fed. Cir. 1992)	18
<i>Rex v. Arkwright</i> , 1 Carp. P.C. 53 (K.B. 1785)	14
<i>Rex v. Else</i> , 1 Carp. P.C. 103 (K.B., N.P. 1785)	14
<i>Senmed, Inc. v. Richard-Allan Med. Indus., Inc.</i> , 888 F.2d 815 (Fed. Cir. 1989)	17-18
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	6, 11, 16

TABLE OF AUTHORITIES

CASES

	<u>Page</u>
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	6
<i>Specialty Composites v. Cabot Corp.</i> , 845 F.2d 981 (Fed. Cir. 1988)	17
<i>SRI Int'l v. Matsushita Elec. Corp. of Am.</i> , 775 F.2d 1107 (Fed. Cir. 1985)	17
<i>SSIH Equip. S.A. v. United States</i> <i>Int'l Trade Comm'n</i> , 718 F.2d 365 (Fed. Cir. 1983)	17
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	9, 12
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	14
<i>Water-Meter Co. v. Desper</i> , 101 U.S. (11 Otto) 332 (1880)	14
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	21
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	6, 10, 17-19
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. 88 (1859)	3, 6, 10, 20

TABLE OF AUTHORITIES

Statutes and Codes

	<u>Page</u>
35 U.S.C. section 112	2, 20-21

Rules and Regulations

Federal Rules of Evidence	
Rule 702	19, 20

Other Authorities

John N. Adams and Gwen Averly, <i>The Patent Specification: The Role of Liardet v. Johnson</i> , 7 J. Legal. Hist. 156 (1986)	15
Francis Buller, <i>An Introduction to the Law Relative to Trials at Nisi Prius</i> (1791)	15
George T. Curtis, <i>A Treatise on the Law of Patents for Useful Inventions</i> (4th ed. 1873)	6
1 James Oldham, <i>The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century</i> (1992)	15
2 William C. Robinson, <i>The Law of Patents for Useful Inventions</i> (1890)	6-9
3 William C. Robinson, <i>The Law of Patents for Useful Inventions</i> (1890)	7

No. 95-26

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ Of Certiorari To The
United States Court of Appeals
For The Federal Circuit

BRIEF OF AMICUS CURIAE
AIRTOUCH COMMUNICATIONS, INC.
IN SUPPORT OF RESPONDENTS

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ AirTouch Communications, Inc. ("AirTouch") respectfully offers this brief as amicus curiae in support of respondents Westview Instruments, Inc., and Althon Enterprises, Inc. AirTouch is not a business rival of any of the parties to this action. AirTouch

¹ Letter of consent from counsel for both Petitioners and Respondents have been filed with the Clerk of the Court pursuant to Supreme Court Rule 37.

has no interest, direct or indirect, in the outcome of this appeal.

AirTouch is a leading provider of wireless telecommunications services such as cellular telephone and paging services. AirTouch competes in a rapidly growing industry where patent rights are an important factor in many major business decisions. Uncertainty about the scope and meaning of patent claims has adverse effects on that industry: it impedes business efforts to license patents on commercially reasonable terms, it complicates technical efforts to avoid infringement, and it often frustrates legal efforts to resolve infringement claims without substantial delays and costs of litigation. AirTouch believes that the en banc decision of the Court of Appeals in this case articulates a well-reasoned and long-precedented approach to allocating judge and jury functions in patent infringement cases, reducing the uncertainty surrounding patent interpretation while at the same time preserving to patent owners their Seventh Amendment right to a trial by jury in actions to enforce their patents against infringers.

SUMMARY OF ARGUMENT

American patent law requires that an applicant for a United States patent file a specification that shall contain a written description of the invention in "full, clear, concise, and exact terms" (35 U.S.C. section 112, ¶ 1), and "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." *Id.* ¶ 2. Thus, it is the *claims* of a patent that define the scope of the exclusionary right created by the patent grant, much as real property boundaries are defined by metes and bounds. See, e.g., *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

In *Coupe v. Royer*, 155 U.S. 565 (1895), this Court held that in determining whether a patent claim is infringed, it is for the judge, and not the jury, to interpret the scope of that claim:

"Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant."

155 U.S. at 579 (citation omitted). The question now before this Court is whether the rule of *Coupe* is to be nullified in every case in which the meaning of some term in the claims, specification or prosecution history of the patent is materially disputed.

We respectfully submit that the decision of the Court of Appeals below, and the rule from *Coupe* on which that decision was in part based, achieves a proper balance between the rights of a patent owner to have a jury trial on infringement issues and the rights of the public to rely upon patent claims as clear and exact legal descriptions of what has been removed from the public domain. This balance, which has endured for more than a century, would be disrupted if juries suddenly were assigned the legal task of interpreting patent claims whenever a patent owner and an accused infringer, or their respective expert witnesses, disagree about the meaning of a patent claim. This Court observed long ago that in cases involving the interpretation of patent claims, "[e]xperience has shown that opposite opinions of persons professing to be experts may be obtained to any amount." *Winans v. New York & Erie R.R. Co.*, 62 U.S. 88, 101 (1859).

The rule advocated by Petitioners and their amici would effectively subvert the *Coupe* rule by assigning the legal issue of claim interpretation to juries, whose verdicts on the issue of infringement are subject to review only under a "substantial evidence" standard. If juries were given that virtually unreviewable discretion to interpret patents, it would become far more difficult to form reasonable judgments concerning the breadth of any patent claim. Such a rule would impair the ability of business competitors to make reasonable commercial decisions about patent licensing and related matters, hamper their ability to resolve patent disputes without litigation and complicate the appellate review of judgments in patent cases.

In examining Petitioners' contention that *Coupe v. Royer* does not really mean what the opinion so clearly says, the Court should note Petitioners' repeated failure to distinguish the legal issue of patent claim *interpretation* from factual issues such as infringement and adequacy of disclosure in the patent specification. For example, Petitioners' citations to older English cases in which juries decided the issue of infringement miss the point. The question before this Court is not who decides the issue of infringement, but who interprets the claims of the patent. None of the pre-1791 English cases cited by Petitioner or the dissenting opinion below involved any instruction to the jury to interpret the meaning of patent claims.

This Court's precedent holds that the interpretation of the claims of a patent is a matter for the trial court, not the jury. There is no legitimate Seventh Amendment argument for overruling that precedent and the stare decisis of more than a century.

ARGUMENT

I. THE MAJORITY DECISION OF THE EN BANC PANEL SHOULD BE AFFIRMED BASED ON ENDURING PRECEDENT HOLDING THAT PATENT CLAIM INTERPRETATION IS A LEGAL ISSUE TO BE DECIDED BY JUDGES AND REVIEWED DE NOVO AS A QUESTION OF LAW.

The dissenting and concurring opinions below assert, incorrectly, that the majority decision contravenes 200 years of legal precedent.² Petitioners are less hyperbolic, but no less incorrect, in arguing that the majority decision "ignored clear historical evidence that juries, not judges, interpreted patents in England in 1791 and thereafter in England and United States." See Brief of Petitioners ("Pet. Br."), p. 22. In fact, the historical evidence suggests no such thing. To the extent that history and precedent inform the resolution of this appeal, they support affirmance of the en banc majority decision of the Court of Appeals.

A. The precedents of this Court have long held that patent interpretation is a matter of law, to be decided by the trial judge and reviewed de novo on appeal.

The majority opinion below correctly concluded that the precedents of this Court have established that "the construction of a patent claim is a matter of law exclusively for

²The opinions of the Court of Appeals are found in the Appendix to the Petition for Certiorari at pages 1a-159a, and are cited as such in this brief. Judge Mayer's concurring opinion asserts that the majority decision "jettisons more than two hundred years of jurisprudence" and "marks a sea change in the course of patent law that is nothing short of bizarre." 57a. Similarly, Judge Newman's dissenting opinion asserts that the majority decision "denies 200 years of jury trial of patent cases in the United States, preceded by over 150 years of jury trial of patent cases in England, by simply calling a question of fact a question of law." 87a.

the court." 25a (citing authorities).³ This Court has long held that proof of patent infringement involves at least two separate and distinct issues: (1) the legal interpretation of the patent claim at issue; and (2) the factual question of whether the defendant's accused product or process infringes that patent claim. The former is a legal issue to be resolved by the trial court; the latter is a factual issue to be decided by the factfinder.

This Court delineated these two distinct issues more than 140 years ago. In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the Court began its opinion by setting out the law applicable to cases in which the patent owner contends that its patent was infringed:

"On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants.

"The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury."

56 U.S. at 337 (emphasis added).

This Court elaborated the fundamental distinction between these issues of interpretation and infringement in

³The majority opinion below relied on *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 235 (1853); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 333 (1853); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1870); *Coupe v. Royer*, 155 U.S. 565, 579-580 (1895); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 731, at 481 (1890); and George T. Curtis, *A Treatise on the Law of Patents for Useful Inventions* § 222, at 251 (4th ed. 1873).

Coupe v. Royer, 155 U.S. 565 (1895). The *Coupe* Court expressly distinguished between the legal issue of patent interpretation and the factual question of patent infringement:

"The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol 3, page 378, as follows: 'Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.'"

Id. at 579 (quoting 3 William C. Robinson, *The Law of Patents for Useful Inventions* § 1075, at 378 (1890)).

The Robinson treatise is especially instructive as to the state of American and English patent law at the time of *Coupe*. Professor Robinson aptly summarized the law holding that the interpretation of patent claims is a legal issue reserved to the courts,⁴ and he described the uncertainty

⁴See, e.g., 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 732, at 481-83 (1890):

"The duty of interpreting letters-patent has been committed to the courts. A patent is a legal instrument, to be construed, like other legal instruments, according to its tenor. Whether its Claims are valid or invalid, whether or not they embrace a given invention, and what may be the actual nature of the invention which they do embrace, are questions of law for the court, to be decided upon an inspection of the instrument itself. No evidence of any kind, no opinions of other persons, can have any direct influence upon this decision. Where technical terms are used, or where the qualities of substances or operations mentioned or any similar data necessary to the comprehension of the language of the patent are unknown to the judge, the testimony of witnesses may be received on these subjects, and any other means of information may be employed. But in the actual interpretation of the patent the court proceeds upon its own responsi-

that would result if juries were given the responsibility for claim interpretation.⁵

The Robinson treatise also noted that courts interpreting patent claims should consider not only the words of the patent, but also the "state of the art at the date of the invention [as] may be shown by previous patents, by the processes or instruments then known to the art, or by the testimony of persons acquainted with its general history and development." 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 740, at 492 (1890) (footnote omitted). Courts interpreting the claims of a patent should appreciate that:

"The nature of the actual invention is sought in the history of the art, in the formal statements of the inventor before his patent issued, and in other facts which indicate its character. To this invention the entire description of the patent is applied, and whatever

bility, as an arbiter of the law, giving to the patent its true and final character and force." (footnotes omitted)

⁵See, e.g., 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 733, at 483-84 (1890):

"Apart from the general principles upon which this duty of interpretation is entrusted to the court, there are advantages attending it which the inventor could not otherwise enjoy. To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of a false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations." (footnotes omitted)

has been properly described and might, therefore, lawfully be claimed, is taken as the true interpretation of the Claim so far as the legitimate use of language will allow. *By this method of construction the rights of the inventor are secured to the fullest extent which is compatible with the preservation of the public right.*"

Id. § 745, at 501 (emphasis added) (footnote omitted).

The *Coupe* Court followed the precedent and reasoning summarized in the Robinson treatise, holding that:

"Our conclusion upon this part of the case, therefore, is, that the question of infringement, arising upon a comparison of the Royer patent and the machine used by the defendants, should be submitted to the jury, *with proper instructions as to the nature and scope of the plaintiffs' patent as hereinbefore defined*, and as to the character of the defendants' machine."

155 U.S. at 579-80 (emphasis added).

The holding of *Coupe* is contrary to the position urged by Petitioners. The *Coupe* Court knew that expert opinion evidence had been offered at trial regarding the meaning of the patent as well as how it might be infringed, but the Court specifically held that interpretation of the patent was for the trial judge, not the jury. In so holding, the Court was well aware of the different functions of judges and juries on the issues of interpretation and infringement.⁶

⁶The Court referred to its having "had occasion, more than once, to reverse the trial courts for taking away from the jury the question of infringement, which they have sometimes done by rejecting evidence of earlier patents offered to show anticipation, and sometimes by a peremptory instruction that a patent relied on by the defence was or was not infringement of the plaintiff's patent." *Id.* at 577-78. It was in this connection, infringement rather than interpretation of the patent in suit, that the Court referred to *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453,

Coupe and *Winans v. Denmead* provide ample support for the ruling below and are consistent with this Court's precedents in other patent cases that involve different issues. For example, in the earlier case of *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848), this Court distinguished the legal issue of patent interpretation from the factual issue of whether the patent made a disclosure that could be understood by persons skilled in the art. The *Hogg* Court held that adequacy of disclosure is basically a factual question, which "involves a question of law only in part, or so far as regards the construction of the written words used." 47 U.S. at 438 (emphasis added). See also *Hogg v. Emerson*, 52 U.S. (11 How.) 587 (1851) (affirming 47 U.S. 437).

Similarly, in *Winans v. New York & Erie Railroad Co.*, 62 U.S. (21 How.) 88 (1859), this Court reiterated the basic distinction between the legal issue of patent interpretation decided by the court and the related factual issue to be decided by the jury. The defendant in *Winans* argued that the patent was invalid for lack of novelty, and the Court accordingly held that "[t]here was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury." 62 U.S. at 100.

Petitioners argue that the rule declared in *Coupe* and *Winans v. Denmead* applies only in cases where there is no material dispute regarding the meaning of any term of the patent. Pet. Br., pp. 31-35. Petitioners' asserted distinction is nonsensical. It effectively concedes that there exists a class of legal issues reserved for decision by courts interpreting patent claims in at least some cases. One must ask what those legal issues are, if they are not the issue of how the claim is properly construed in light of the language of the

455 (1872), and *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814 (1882). *Coupe*, 155 U.S. at 578-79.

claim, the patent specification, the prosecution history and the prior art.

A careful reading of *Coupe* and the cases cited by Petitioners demonstrates that Petitioners are wrong. The *Coupe* case itself involved a significant and highly material dispute over the meaning of the claims of the patent. The parties disagreed whether the shaft in the machine was required to be vertical, and both sides presented conflicting extrinsic evidence and testimony on the subject. *Id.* at 568-76. Despite these evidentiary conflicts, this Court itself, in a jury case, interpreted the patent. *Id.* at 577.

Silsby v. Foote, 55 U.S. (14 How.) 218 (1853), was decided 42 years before *Coupe* and addressed an issue that was eliminated by the 1870 statutory amendment requiring inventions to be "distinctly claimed." The patent specification in *Silsby* did not "point out and designate the particular elements which compose a combination, but only declared, as it properly could, that the patented combination was made up of so much of the described machinery as effects a particular result." 55 U.S. at 226. In other words, patent law at the time *Silsby* was decided permitted the specification to describe the invention in terms only of its expected result, without specifying the proportions of the combination. It was only in that exceptional and now disallowed circumstance that this Court stated, taking care in the process not to overstate, that "it is a question of fact which of the described parts are essential to produce that result; and to this extent, *not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.*" *Id.* at 226 (emphasis added).

In *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1869), the Court considered the defense of patent invalidity based on the existence of a prior art patent. Plaintiff sued defendant for breach of a covenant to assign defendant's patent, but further argued that defendant's patent was invalid in any

case because the invention described in the patent had been previously described in an earlier English patent. 76 U.S. at 813. The *Bischoff* Court held that the trial court could not “pronounce upon the identity or diversity” of the inventions described in the two patents as a matter of law, and held that the trial court had properly submitted that issue to the jury as a question of fact. *Id.* at 814. The *Bischoff* Court was careful, however, to distinguish that factual issue from the legal issue of patent interpretation. Its opinion confirmed that the interpretation of patent language (as distinct from the comparison of the described invention with the prior art) is an issue for the court, and not the jury. *Id.* at 815-16. The *Bischoff* Court concluded its opinion by expressly clarifying that distinction:

“This view of the case is not intended to, and does not, trench upon the doctrine that the *construction* of written instruments is for the court alone. It is not the *construction of the instrument*, but the *character of the thing invented*, which is sought in questions of identity and diversity of inventions.”

76 U.S. at 816 (original emphasis).

The Court followed *Bischoff* in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872). The sole issue in *Tucker* was whether the trial court erred in excluding a prior art patent offered by defendant to demonstrate the invalidity of the patent in suit. 80 U.S. at 455. Citing *Bischoff*, the *Tucker* Court held that the prior art patent should have been admitted into evidence and reversed the judgment of the trial court without any discussion of patent interpretation. *See id.* at 456.

We do not disagree with Petitioners’ thesis that material factual disputes as to whether an accused product infringes a patent claim present an issue of fact for the jury. But that thesis does not entail that material disputes as to the

meaning of a patent claim convert an issue of law into an issue of fact for a jury. The proper interpretation of a patent claim is a legal issue that begins and ends with the court, regardless of whether there is a dispute about the meaning of the claim language.

B. The English common law circa 1791 did not treat patent interpretation as a question of fact for the jury.

Petitioners and the dissenting opinion below argue that patent interpretation is a jury function, based upon the English patent law circa 1791, as incorporated into the Constitutional right to trial by jury guaranteed by the Seventh Amendment. *See* Pet. Br., pp. 23-25; 118a-129a (Newman, J., dissenting); *see also* 66a-67a (Mayer, J., concurring).

None of those discussions cites a single case in which an English court ever instructed a jury to interpret the language of the patent in suit. Their failure to distinguish between the legal issue of patent interpretation and the factual issue of patent infringement is epitomized by the conclusion of Judge Newman’s dissenting opinion, in which she summarizes the older English cases as establishing that “in seventeenth- and eighteenth-century England, patent infringement was tried to a jury at common law.” 129a (Newman, J., dissenting). We do not understand Respondents to dispute that *infringement* is a jury question. The question at issue is not who determines whether the patent has been infringed, but who interprets the claims of the patent so as to make that determination possible.

Petitioners’ argument was implicitly rejected by this Court in *Coupe v. Royer*, 155 U.S. 565 (1895), and by Professor Robinson in his classic treatise on *The Law of Patents* (1890), on which the *Coupe* Court relied. *See, supra*, pp. 7-9. The Robinson treatise refers to virtually all of

the English cases cited by Petitioners, but evidently did not regard them to dictate a different rule.

It is not clear that Petitioner's argument on this point is even germane, given that English patents circa 1791 did not have claims of the type used in the United States. As this Court warned in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848), American courts should not allow themselves to be misled by precedent in older English patent cases because of the differences between American and English patent law. 47 U.S. at 479, 483. Accord: *Water-Meter Co. v. Desper*, 101 U.S. (11 Otto) 332, 337 (1880).

More important, none of the reported English cases cited by Petitioners or in the concurring and dissenting opinions below held that patent interpretation is anything but a legal issue. Indeed, those cases involved almost every issue except patent interpretation in the context of deciding infringement. See *Rex v. Else*, 1 Carp. P.C. 103 (K.B., N.P. 1785) (patent held void for failure to describe a patentable invention); *Dollond's Case*, 1 Carp. P.C. 28 (C.P. 1758) (patent held valid despite prior use of invention by another person); *Morris v. Branson*, 1 Carp. P.C. 30 (K.B. 1776) (patent for an addition to existing machine held valid); *Bramah v. Hardcastle*, 1 Carp. P.C. 168 (K.B. 1789) (patent held valid against defense of lack of novelty); *Arkwright v. Nightingale*, 1 Carp. P.C. 38 (C.P. 1785) (patent held valid against defense of inadequate disclosure); *Rex v. Arkwright*, 1 Carp. P.C. 53 (K.B. 1785) (patent found invalid for lack of novelty and lack of invention by the patentee); *Turner v. Winter*, 1 T.R. 602 (K.B. 1787) (patent held invalid for inadequate disclosure); *Administrators of Calthorp v. Waymans*, 3 Keb. 710 (K.B. 1676) (patent held invalid because invention had never before been used in England).

In none of those cases did the trial court instruct the jury to interpret the patent in suit. That Petitioners do not cite a single reported case holding that patent interpretation was a

jury function confirms that there was *not* a settled common law practice of submitting the issue of patent interpretation to juries in England prior to 1791.

Lacking any reported pre-1791 English authority to support their position, Petitioners rely on secondary accounts of an unreported English case, *Liardet v. Johnson* (1778). Pet. Br., pp. 23-24.⁷ *Liardet* should be disregarded as an unreported case lacking any real value as a legal precedent. More important, it should also be disregarded because it provides no precedent for instructing a jury to interpret the patent in suit: in neither the first nor the second trial did Chief Justice Mansfield tell the jury to interpret the patent.⁸ Whatever he may have thought on the subject of whether the judge or jury should interpret patents, there is no record of him holding in *Liardet* that the question was one for the jury.

Notably, when the English rule on patent interpretation was definitively declared a century later, it was fully consistent with *Coupe*. In *Brooks v. Steele and Currie*, 14 R.P.C. 46 (1897), the court held that expert testimony was admissible in patent cases to explain technical terms, demonstrate

⁷ Although Petitioners describe *Liardet* as a "leading King's Bench decision" (Pet. Br., p. 23), their purported summary of this unreported case is based entirely upon the descriptions provided in 1 James Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century* 748-757 (1992), and Francis Buller, *An Introduction to the Law Relative to Trials at Nisi Prius* 76 (1791).

⁸ See 1 James Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century*, 754-57 (1992). Judge Buller's notes state that Mansfield left to the jury "all objections made to exactness, certainty and propriety of the Specification . . . and whether [the invention had been] publicly used by others before" (*id.* at 756), but thereafter, the single question left to the jury was "whether this was a fair and new invention." *Id.* at 757. See also John N. Adams & Gwen Averly, *The Patent Specification: The Role of Liardet v. Johnson*, 7 J.Legal Hist. 156-177 (1986).

the technology, summarize the prior art and identify differences between the plaintiff's patent and defendant's accused product. 14 R.P.C. at 73. The *Brooks* court held, however, that the value of such evidence does not change the fundamental nature of patent interpretation as an issue of law for the court:

"But after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are examined."

Id. at 73.

We respectfully submit that Petitioners' inaccurate and secondary account of the unreported decision in the case of *Liardet v. Johnson* does not warrant, let alone require, that this Court reverse the century-old precedent of *Coupe v. Royer*. Even if one were to accept Judge Buller's cryptic notes concerning the instruction given at the end of the second trial, they would reflect nothing more than a procedure similar to that announced in *Silsby* under the pre-1870 United States Patent Statute. *See, supra*, p. 11.

C. The precedents of the Federal Circuit support the en banc decision below, and any conflicting precedents from the Federal Circuit should be overruled.

Petitioners and their supporting amici also criticize the majority decision for ignoring earlier precedents of the Federal Circuit. *See* Pet. Brief, pp. 18-19; ATLA Amicus Br., pp. 7-10; Litton Amicus Br., pp. 8-9; *see also* 135a-145a (Newman, J., dissenting); *see also* 59a-61a (Mayer, J., concurring). To the extent that such criticism might be at all relevant to this appeal, we would point out that it simply misstates the decisional law of the Federal Circuit.

In its first year of existence, the Federal Circuit expressly adopted and followed the binding precedents of this Court on the subject of patent interpretation. In *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir. 1983), the court quoted from *Coupe v. Royer* and Robinson's "classic" treatise on patent law:

"[W]here the defendant 'denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.'"

Kalman, 713 F.2d at 770-71 (quoting *Coupe*).

Similarly, in *SSIH Equipment S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 376 (Fed. Cir. 1983), the court cited *Winans v. Denmead* for the proposition that:

"With respect to infringement, the question of 'what is the thing patented' is one of law, while the question 'has that thing been constructed [made], used or sold' by the alleged infringer is a factual issue."

718 F.2d at 376 (quoting *Winans v. Denmead*, 56 U.S. at 337) (brackets in original).

Subsequent Federal Circuit decisions continued to follow the rule in *Coupe* in a variety of procedural contexts. *See, e.g., Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569-71 (Fed. Cir. 1983) (citing *Kalman* and *SSIH*, and reversing judgment of trial court as a matter of law); *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (in banc) (reversing summary judgment of noninfringement and construing disputed claim language as a matter of law); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988) (reversing judgment of noninfringement and construing disputed claim language as a matter of law); *Senmed, Inc. v. Richard-Allan Medical*

Indus., Inc., 888 F.2d 815, 818 (Fed. Cir. 1989) (reversing jury verdict of infringement and construing disputed language in patent claims as matter of law); *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-823 (Fed. Cir. 1992) (quoting *Winans v. Denmead* and affirming denial of JNOV motion based in part on trial court's correct interpretation of disputed claim language).

Before the concurring and dissenting opinions in *Markman*, no Federal Circuit opinion had ever suggested that there was a Seventh Amendment right to a jury trial on the legal issue of claim interpretation. No such contention is made by the cases cited in the *Markman* dissent or in the briefs of Petitioners or their supporting amici.⁹ Rather, those cases feature much more limited holdings: that summary judgment may be inappropriate in cases where extrinsic evidence is required to permit the court to construe the claims, e.g., *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); that parties may agree to submit the issue of claim interpretation to the jury, see *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 614 (Fed. Cir. 1984); or, wrongly, that the "construction of the claim *could* be left to the jury," see *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (emphasis added) (dictum).

Petitioners' contention that there are two divergent lines of Federal Circuit precedent on this issue does not bear close scrutiny. To the extent that such a split of authority might exist, however, this Court should prefer that line

⁹We note that the brief of amicus curiae Litton Industries, Inc. refers to the split decision in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (en banc) (per curiam), petition for cert. filed, 64 U.S.L.W. ____ (Nov. 6, 1995). Litton Amicus Br., pp. 7, 21. The *Hilton Davis* case involves a distinct set of issues relating to the so-called "doctrine of equivalents" and is now the subject of a pending petition for certiorari.

which clearly follows *Kalman* and this Court's own decisions in *Coupe* and *Winans v. Denmead*. The majority decision of the en banc panel in this case resolved any such conflict in favor of those enduring precedents. Here, as in other areas of patent law that affect the public interest, this Court should exercise its authority to resolve such legal disputes in accordance with this Court's own settled precedents. See, e.g., *Cardinal Chemical Co. v. Morton Int'l, Inc.*, 113 S. Ct. 1967 (1993) (disapproving former Federal Circuit practice of dismissing declaratory judgment claims on patent validity issues as moot upon any finding that the patent in suit was not infringed).

D. The Federal Rules of Evidence relating to expert testimony are consistent with the decision of the en banc court below.

The amicus brief of the Association of Trial Lawyers of America ("ATLA") argues summarily that disputes over patent claim interpretation are questions of fact and, therefore, must be determined by juries. The ATLA brief does not even mention *Coupe v. Royer*, 155 U.S. 565 (1895), which is squarely contrary to its argument that "If the terms and facts were in dispute, the issue of claim interpretation has always been held as a question of fact." ATLA Brief, p. 4. The ATLA amicus brief argues that patent interpretation will be a jury function whenever expert witnesses present testimony about the meaning of disputed language. See ATLA Brief, pp. 12-14.

That argument, which is based on Rule 702 of the Federal Rules of Evidence ("Rule 702"),¹⁰ assumes that the trial court can hear expert testimony *only* as a trier of fact.

¹⁰That rule provides as follows: "If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise." Fed. R. Evid. 702.

The Court in *Coupe* considered highly contested expert testimony on the meaning of the patent claims while expressly holding that claim interpretation is a matter of law. See *Coupe*, 155 U.S. at 568-76. Similarly, in *Winans v. New York & Erie R.R. Co.*, the Court expressly recognized that experts may be examined "to explain terms of art, and the state of the art, at any given time. They may explain to the court and jury the machines, models, or drawings, exhibited . . . [and] point out the difference or identity of the mechanical devices involved in their construction." 62 U.S. at 100-101.

Claim construction does not suddenly become a jury issue merely because one party hires an expert witness to opine as to the scope of the claim under Rule 702. As we noted above, section 112 commands that a patent specification must be in full, clear, concise and exact terms and must conclude with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." See, *supra*, p. 2. Implicit in these requirements of specificity is a principle at the heart of this case—a patent claim must have a fixed and determinate scope that provides a meaningful guide to the rest of the world.¹¹ A patent claim is not a "nose of wax" that can be

¹¹ See, e.g., *Merrill v. Yeomans*, 94 U.S. (4 Otto) 568, 573-74 (1876) ("The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits those rights. . . . It seems to us that nothing can be more just and fair, both to the parties and the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 278-79 (1877) ("As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."); *McClain v. Ortmyer*, 141 U.S. 419, 423-24 (1891) ("Nothing is better settled in the law of patents than that

reshaped as the patent owner may desire. *White v. Dunbar*, 119 U.S. 47, 51-52 (1886). Property boundaries are and must be fixed if the public is to rely on their integrity. To allow expert witnesses, acting as advocates, to distort the definition of patent claims is inconsistent with the nature of such claims as property rights.

We respectfully submit that allowing juries to interpret the meaning of patent claims, insulated from any meaningful review by the trial judge or court of appeals, subverts the statutory requirement of specificity and fosters the deliberate use of ambiguous claim language. In summary, the statutory requirements of section 112 reinforce the precedent and policy directing that patents are to be interpreted by the courts, and should not be interpreted, directly or indirectly, by juries.

the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public"); *Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 400-01 (1926) (same).

II. CONCLUSION

For the reasons set forth herein, we respectfully submit that the judgment of the Court of Appeals should be affirmed.

December 8, 1995.

Respectfully submitted,

ALLAN N. LITTMAN

Counsel of Record

ROBERT P. TAYLOR

JOHN O'HARA HORSLEY

PILLSBURY MADISON & SUTRO LLP

225 Bush Street

San Francisco, CA 94104

(415) 983-1000

Counsel for Amicus Curiae

AirTouch Communications, Inc.

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
Petitioners,

vs.

**WESTVIEW INSTRUMENTS, INC., and
ALTHON ENTERPRISES, INC.,**
Respondents.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

**BRIEF OF AMICUS CURIAE AMERICAN
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF RESPONDENTS**

Robert O. Bolan
Charles L. Gholz
R. Carl Moy
Roger W. Parkhurst
Joseph R. Re
Paul A. Stewart
Harold C. Wegner

Don W. Martens
Counsel of Record
President
AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
2001 Jefferson Davis Highway
Arlington, VA 22202-3586
(703) 415-0780

Attorneys for Amicus Curiae

QUESTION PRESENTED

The question presented has been inaccurately stated by the petitioners. The question that this case actually presents is as follows:

Is the determination of the meaning of a word in a patent claim an issue of law or an issue of fact?

TABLE OF CONTENTS**Page #**

INTEREST OF THE AMICUS	2
SUMMARY OF ARGUMENT	3
ARGUMENT	4
I. THE QUESTION PRESENTED IMPROPERLY ASSUMES THAT CONSTRUCTION OF PATENT CLAIMS INVOLVES QUESTIONS OF FACT	4
II. CLAIM CONSTRUCTION IS A QUESTION OF LAW FOR THE COURT	6
A. This Court's Precedents Clearly Establish That Claim Construction Is A Question Of Law	6
B. This Court's Precedents Are Correct	9
1. The Legal Scope And Effect Of The Exercise Of Congressional Power Is Plainly A Question Of Law	9
2. This Court's Precedents Do Not Unconstitutionally Depart From The English Common Law	11
C. Claim Construction Involves No Underlying Questions Of Fact	11

III. TESTIMONY CONTRARY TO A PATENT SPECIFICATION AND ITS OFFICIAL ADMINISTRATIVE RECORD DOES NOT RAISE A TRIABLE ISSUE OF FACT	13
CONCLUSION	15

TABLE OF AUTHORITIES**Page #****CASES**

<i>Bates v. Coe</i> , 98 U.S. 31 (1878)	6,7,11
<i>Binns v. Lawrence</i> , 53 U.S. (12 How.) 9 (1851)	12,14,15
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	8,11
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	6,7,11
<i>Emerson v. Hogg</i> , 8 F. Cas. 628 (C.C.S.D.N.Y. 1845)	8
<i>Evans v. Eaton</i> , 20 U.S. (7 Wheat.) 356 (1822)	14
<i>Fromson v. Advance Offset Plate, Inc.</i> , 720 F.2d 1565 (Fed. Cir. 1983)	8
<i>General Electric Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938)	14
<i>Intellicall, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384 (Fed. Cir. 1992)	14
<i>Markman v. Westview Instruments</i> , 52 F.3d 967 (Fed. Cir.), cert. granted, 116 S. Ct. 40 (1995)	7,10,11,12,13

<i>National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.</i> , 19 Fed. 514 (C.C.D. Ind. 1884)	8
<i>Order of Railway Conductors of America v. Swan</i> , 329 U.S. 520 (1947)	12,14
<i>Permutit Co. v. Graver Corp.</i> , 284 U.S. 52, 60 (1931)	14
<i>Pullman-Standard, Div. of Pullman, Inc. v. Swint</i> , 456 U.S. 273 (1982)	9
<i>Read Corp. v. Portec, Inc.</i> , 970 F.2d 816 (Fed. Cir. 1992)	8
<i>Schriber-Schroth Co. v. Cleveland Trust Co.</i> , 311 U.S. 211 (1940)	14
<i>Senmed, Inc. v. Richard-Allan Medical Indus., Inc.</i> , 888 F.2d 815 (Fed. Cir. 1989)	14
<i>Shatterproof Glass Corp. v. Libbey-Owens Ford Co.</i> , 758 F.2d 613 (Fed. Cir.), cert. dismissed, 474 U.S. 976 (1985)	8
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	8,11
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	14
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	6,7,8,11

CONSTITUTIONAL PROVISIONS

U.S. CONST. art. I, § 8, cl. 8	9
U.S. CONST., amend. VII	<i>passim</i>

STATUTES

Fed. R. Civ. P. 1	5
Fed. R. Civ. P. 50	4
Fed. R. Civ. P. 51	4
Fed. R. Civ. P. 56	4

TREATISES

WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS (Boston, Little, Brown & Company 1890)	7,10
---	------

OTHER MATERIALS

P.J. Federico, <i>The First Patent Act</i> , 14 J. Pat. Off. Soc'y 237 (July 1932)	10
---	----

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1995

—
No. 95-26
—

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, INC., and
ALTHON ENTERPRISES, INC.
Respondents.

—
ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

—
BRIEF OF AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION AS *AMICUS CURIAE*
IN SUPPORT OF RESPONDENTS

—
This *amicus curiae* brief is submitted in support of
the Respondents. Both Petitioners and Respondents have
consented to the filing of this brief. Their written consent
has been filed with the Court.

INTEREST OF THE *AMICUS*

The American Intellectual Property Law Association ("AIPLA") is a national association of more than 9,000 members whose interest and practice lie in the areas of patent, copyright, trademark, trade secret and other intellectual property law. The AIPLA's members include attorneys in private practice and attorneys employed by corporations, universities, and government. Unlike many other areas of practice in which separate and distinct plaintiffs' and defendants' bars exist, most, if not all, intellectual property law attorneys represent both plaintiffs and defendants.

The AIPLA is very interested in the outcome of the present appeal. More specifically, the AIPLA strongly believes that the Federal Circuit's decision on appeal to this Court should be affirmed. The interests of patent litigants represented by our members would be directly and adversely affected if a trial, whether by jury or otherwise, were necessary to determine the scope of rights granted in a United States patent -- a question of law. While the AIPLA is very interested in the preservation of Seventh Amendment rights in intellectual property litigation, it opposes their radical expansion to hearings over issues of law. Most importantly, the AIPLA wishes to preserve the public notice function of patents and their accompanying administrative record, upon which industry must rely without resorting to litigation.

SUMMARY OF ARGUMENT

Because petitioners have improperly stated the question presented, this *amicus* brief has set forth the question actually presented in this case: Is the determination of the meaning of a word in a patent claim an issue of law or an issue of fact? The petitioners' question improperly assumes that there are "genuine factual disputes" concerning the construction of a term in a patent claim. Because this Court has repeatedly held that claim construction is a question of law to be determined by the court, the Seventh Amendment concerns raised by the petitioners are simply not implicated.

This Court should not now reconsider the long-standing rule that claim construction is a question of law, even in cases where a court elects to hear live testimony regarding the meaning of a term in the patent claim. The use of such testimony does not transform questions of law into questions of fact. This Court has repeatedly authorized district courts to hear expert testimony to resolve questions of statutory interpretation involving technical terms which are unfamiliar to the court.

Lastly, this Court should preserve the important public notice function of patents and their accompanying file histories, the patent's official administrative record. Under no circumstances should patent litigants be able to contradict that public record by the introduction of expert testimony. Accordingly, courts should be free to reject as a matter of law any testimony which attempts to alter the public record on which industry must rely. Industry should not be required to participate in protracted litigation just to learn the meaning of a patent.

ARGUMENT

I. THE QUESTION PRESENTED IMPROPERLY ASSUMES THAT CONSTRUCTION OF PATENT CLAIMS INVOLVES QUESTIONS OF FACT

The question presented by this case is improperly stated in the petitioners' brief. As stated by the petitioners, the question presented is a rhetorical one: Must questions of fact be tried to a jury in an action for damages? Of course they must. No attorney familiar with the Seventh Amendment to the United States Constitution would argue otherwise.

The petitioners' rhetorical question, however, assumes that the interpretation of patent claims is a factual inquiry, not a legal one. Indeed, the petitioners make this assumption explicitly. On Page 18 of its brief, the petitioners expressly assume that "[t]he task of determining what the claims mean to one 'of skill in the art' is a factual inquiry." No citation follows this assumption.

The question truly presented by this case, as the Federal Circuit recognized, is whether the construction of words in a patent claim is a question of law or a question of fact. The Federal Circuit held it to be a question of law. If that is correct, claim construction may properly be resolved by a motion for summary judgment, a motion for a directed verdict, or through the preparation of jury instructions. See Fed. R. Civ. P. 50, 51, 56. If claim construction is a question of fact, in contrast, genuine disputes about claim construction must be decided by trial.

This case, therefore, is not important because of any imaginary constitutional concerns. Rather, this case is important -- exceedingly so -- because it will determine whether a trial is necessary on issues of patent law which historically have been decided by the courts as a matter of law without a trial.

The AIPLA is very concerned about the outcome of this case because a reversal by this Court would have a devastating impact on the litigation of patent cases. While trials are the best means for resolving questions of fact, they are poorly suited for resolving questions of law. A trial to determine the legal meaning and effect of public rights granted by the federal government -- by statute, by patent, or otherwise -- would be truly revolutionary. It would also be a serious mistake. A party would be entitled to a trial merely because of a disagreement over the meaning of a legal text.

Moreover, as the petitioners correctly observe, the parties always disagree over the scope and meaning of the rights granted by a patent. Thus, if this Court were to conclude that a trial is the appropriate vehicle to determine the scope of these rights, summary judgment would have virtually no place in patent litigation. Mere disagreement over the meaning of a legal text would entitle the parties to a trial. The just and speedy resolution of legal disputes promised by Rule 1 of the Federal Rules of Civil Procedure would become illusory in all future patent infringement cases.

II. CLAIM CONSTRUCTION IS A QUESTION OF LAW FOR THE COURT

A. This Court's Precedents Clearly Establish That Claim Construction Is A Question Of Law

On at least three occasions, this Court has squarely held that the construction of patent claims is a question of law to be decided exclusively by the court. *See Coupe v. Royer*, 155 U.S. 565, 579 (1895); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853). This Court's holdings are clear and leave no room for reasonable debate.

For example, in the earliest of the cases, this Court unequivocally explained:

On such a trial [of patent infringement], two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used or sold by the defendants.

The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.

Winans, 56 U.S. (15 How.) at 338 (emphasis added).

Similarly, in *Coupe*, this Court quoted the leading patent law treatise of the day to reiterate the proper division of authority between judge and jury. As this Court explained:

Where the defense "denies that the invention used by the defendant is identical with that included in the plaintiff's patent, *the court defines the patented invention as indicated by the language of the claims*; the jury judge whether the invention so defined covers the art or article employed by the defendant."

Coupe, 155 U.S. at 579 (quoting 3 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS § 1075 at 378 (Boston, Little, Brown & Company 1890)).

Again, in *Bates*, this Court held clearly and unequivocally that claim construction is a question of law for the court:

In construing patents, it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings.

Bates, 98 U.S. at 38-39.

In the present case, the Federal Circuit merely re-affirmed the vitality of this Court's decisions in *Winans*, *Coupe*, and *Bates*, and overruled one line of its own earlier decisions that had deviated from this Court's precedents. *Markman v. Westview Instruments*, 52 F.3d 967, 977-79 (Fed. Cir.), *cert. granted*, 116 S. Ct. 40 (1995). The vast majority of prior Federal Circuit decisions had likewise followed this Court's precedents to the letter. The Federal Circuit has repeatedly held that claim construction is a question of law for the court, while infringement of the claim as construed by the court is a question of fact for the

jury when properly demanded. See, e.g., *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992) (quoting *Winans*, 56 U.S. (15 How.) at 338); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569 (Fed. Cir. 1983).

Moreover, contrary to the petitioners' argument, the Federal Circuit's adherence to this Court's precedents will not create practical difficulties in the district courts. The district courts have been construing patent claims as a matter of law throughout the history of our Nation. See, e.g., *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. 514, 515-16 (C.C.D. Ind. 1884); *Emerson v. Hogg*, 8 F. Cas. 628, 631 (C.C.S.D.N.Y. 1845).

The petitioners rely primarily upon *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), and *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), as contrary authority from this Court. See Pet'r Br. at 31-34. These decisions, however, are entirely irrelevant.

In both *Bischoff* and *Tucker*, this Court held that the *novelty* of an invention claimed in a patent is a question of fact for the jury to decide in an action at law. Thus, in an action at law, a jury must compare the patent in suit to earlier patents, publications, and devices to decide whether the patented invention is novel. The Federal Circuit still follows this rule today. E.g., *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985). *Bischoff* and *Tucker* say absolutely nothing about the question before this Court -- whether the claims of a patent should be construed by a judge as an issue of law or by a jury as an issue of fact.

Indeed, this error infects the petitioners' entire brief, and the briefs of many of the *amici curiae*. Repeatedly throughout their briefs, the petitioners and various *amici* cite and discuss cases holding that the novelty of a patent or the adequacy of a patent's disclosure are questions of fact for the jury. Pet'r Br. at 23-25, 31-35; *Amicus* Br. of Litton Systems, Inc. at 16, 18-19; *Amicus* Br. of American Trial Lawyers Association at 5-7. These cases say nothing about claim construction. The petitioners and the *amici* have simply confused very distinct inquiries.

B. This Court's Precedents Are Correct

1. The Legal Scope And Effect Of The Exercise Of Congressional Power Is Plainly A Question Of Law

This Court's precedents holding patent claim interpretation to be a question of law, not a question of fact, are clearly correct. Although this Court has observed that the distinction between "law" and "fact" is sometimes "vexing," *Pullman-Standard, Div. of Pullman, Inc. v. Swint*, 456 U.S. 273, 288 (1982), patent claim construction clearly falls on the "law" side of the dichotomy.

The United States Constitution grants Congress the power "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. CONST. art. I, § 8, cl. 8. Congress has chosen to exercise this power through the issuance of patents by the United States Patent and Trademark Office ("PTO"), rather than through special legislation defining the limits of each inventor's exclusive rights.

Congress' choice of methods, however, should not obscure the legislative nature of the power exercised by Congress and the PTO. Congress has, on occasion, granted inventors the exclusive right to their discoveries by special statute. See 1 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS §§ 46-47 (Boston, Little, Brown & Company 1890) and 2 WILLIAM C. ROBINSON, TREATISE ON THE LAW OF PATENTS FOR INVENTIONS § 429 (Boston, Little, Brown & Company 1890); see also P.J. Federico, *The First Patent Act*, 14 J. Pat. Off. Soc'y 237 (July 1932) (describing petitions for patents addressed to the first Congress). These statutes, defining the scope of the inventors' rights, plainly must be construed as a matter of law. There is no sound reason why those same rights, granted by an administrative agency under power delegated by Congress, should be construed as a matter of fact.

Moreover, a patent, like a statute or regulation, defines legal rights and forbids the public from intruding upon those rights. The scope and meaning of such legal rights is plainly the type of question that courts have historically resolved in the context of statutory interpretation as a question of law. Again, there is no reason why interpretation of the scope of similar rights should be different in the context of patent claim construction. The Federal Circuit was thus entirely correct in analogizing interpretation of patents to interpretation of statutes and concluding that both are pure questions of law. See *Markman*, 52 F.3d at 987.

2. This Court's Precedents Do Not Unconstitutionally Depart From The English Common Law

Petitioners rely upon a series of English cases in an effort to establish that claim construction was a jury question at the time the Seventh Amendment was adopted. See Pet'r Br. at 23-26. Implicitly, petitioners seek to have this Court overturn cases such as *Coupe*, 155 U.S. at 579; *Bates*, 98 U.S. at 38-39; and *Winans*, 56 U.S. (15 How.) at 338, on constitutional grounds.

The English cases, however, require no such drastic step. Like this Court's decisions in *Bischoff* and *Tucker*, the English cases relied upon by petitioners merely hold that the novelty of a patented invention is a question for the jury in actions at law. This is made clear by petitioners' own description of those cases. See Pet'r Br. at 23-26. Like *Bischoff* and *Tucker*, petitioners' English cases do not address the question before this Court.

C. Claim Construction Involves No Underlying Questions Of Fact

Petitioners and the dissent below criticized the Federal Circuit's *in banc* opinion for authorizing the district courts to hear live expert testimony to resolve a question of law. Pet'r Br. at 45-46; *Markman*, 52 F.3d at 1006 (Newman, J., dissenting). This, they argued, establishes that claim construction is necessarily based upon underlying questions of fact.

This unsupported assertion is simply untrue. This Court has long authorized district courts to hear live expert

testimony to resolve questions of statutory interpretation involving technical terms that are unfamiliar to the court. See *Order of Railway Conductors of America v. Swan*, 329 U.S. 520, 525-28 (1947). Indeed, this Court has held that "proof of established usage may be proper or even indispensable, in fixing the just interpretation of the law." *Binns v. Lawrence*, 53 U.S. (12 How.) 9, 18 (1851). Accordingly, in both *Railway Conductors* and *Binns*, this Court approved precisely the sort of pre-trial hearing of expert testimony which the Federal Circuit endorsed in *Markman*. Compare *Railway Conductors*, 329 U.S. at 525-28 and *Binns*, 53 U.S. (12 How.) at 18, with *Markman*, 52 F.3d at 980-81. Thus, the use of expert testimony to aid the court in understanding technical words does not change any issue from one of law to one of fact.

Similarly, Litton Systems, Inc., as *amicus curiae*, makes much of the fact that patent claims are addressed to those skilled in the technical arts, not to lawyers. This, Litton argues, distinguishes patents claims from statutes and establishes that claim construction is based on underlying factual findings. This argument, however, rests upon the unstated assumptions that statutes are always addressed to lawyers and that only documents addressed to lawyers may be construed as a matter of law. As this Court's decisions in *Railway Conductors* and *Binns* make clear, statutes -- like patent claims -- are often addressed to those skilled in the technical arts or other specialized fields, and these statutes are construed by the court as a matter of law.

III. TESTIMONY CONTRARY TO A PATENT SPECIFICATION AND ITS OFFICIAL ADMINISTRATIVE RECORD DOES NOT RAISE A TRIABLE ISSUE OF FACT

Even if factual issues could arise in determining the legal scope and effect of a patent, they do not arise in the present case. As the Federal Circuit thoroughly explained in its opinion, the patent at issue and its file history unequivocally establish the meaning of the disputed claim term, "inventory." See *Markman*, 52 F.3d at 982-83. The opinion testimony offered by the petitioners below was inconsistent with these documents and thus was properly rejected as a matter of law. *Id.*

The petitioners do not even argue that the opinion testimony it offered below was consistent with the public record. Nevertheless, the petitioners have asked this Court to order a trial on the issue of claim construction. Apparently, the petitioners would like the trier of fact to determine, as a question of fact, whether the opinion testimony he offered should be given greater weight than the undisputed, unambiguous content of his patent and file history.

The petitioners' request is dangerous and inconsistent with the very nature of patents. As this Court has often explained, patents serve an important public notice function. The patent must:

"inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or

manufactured without a license and which may not."

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 214-15 (1940) (quoting *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931)). See also *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434-35 (1822).-

This function would be destroyed if patent holders were able to change the scope of their rights merely by introducing testimony that contradicts the public record. The public is entitled to rely upon the public record and should not be subjected to the uncertainties of a trial based on evidence directly contradictory to that record.

For this reason, the Federal Circuit has established a clear hierarchy of claim construction tools. The patent specification and its file history are an immutable public record and provide the principal claim construction tools. Expert opinion that is inconsistent with these sources is not probative of the proper claim construction. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed. Cir. 1992) (collecting cases); *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815, 819 (Fed. Cir. 1989). See also *White v. Dunbar*, 119 U.S. 47, 51 (1886) (a patent holder may not "suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction").

This Court has already adopted a similar approach in connection with statutory construction. Expert testimony may be used to aid the Court's construction, *Railway Conductors*, 329 U.S. at 525-28; *Binns*, 53 U.S. (12 How.)

at 18, but expert testimony may not be used to contradict the statutory language. *Binns*, 53 U.S. (12 How.) at 19. This Court should affirmatively endorse the Federal Circuit's application of this rule to claim construction and reject the petitioners' attempt to destroy the public notice function of patents.

CONCLUSION

This Court should uphold the *in banc* decision of the Federal Circuit. That court was correct in concluding that the issue of claim construction is one of law and that, in any event, there was no genuine issue of material fact warranting a trial on the meaning of the term "inventory" in the asserted patent claims.

Respectfully submitted,

December 8, 1995

DON W. MARTENS
Counsel of Record
President

AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
2001 Jefferson Davis Highway
Arlington, VA 22202-3586
(703) 415-0780

Robert O. Bolan
Charles L. Gholz
R. Carl Moy
Roger W. Parkhurst
Joseph R. Re
Paul A. Stewart
Harold C. Wegner

Attorneys for *Amicus Curiae*

18

No. 95-26

Supreme Court, U. S.

FILED

DEC 8 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN, et al.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC., et al.,
Respondents,

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF OF HONEYWELL, INC.
AS AMICUS CURIAE SUPPORTING RESPONDENTS

RICHARD G. TARANTO
(Counsel of Record)
FAER & TARANTO
2445 M Street, NW
Washington, DC 20037
(202) 775-0184

DAVID L. SHAPIRO
1575 Massachusetts Avenue
Cambridge, MA 02188

377

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTEREST OF AMICUS	1
SUMMARY OF ARGUMENT	1
ARGUMENT	3
THE FEDERAL CIRCUIT CORRECTLY HELD THAT THE MEANING OF A PATENT CLAIM PRESENTS A LEGAL QUESTION FOR THE JUDGE, NOT A FACTUAL QUESTION FOR THE JURY	3
A. The Substantive Rules of Patent Law Preclude Indefiniteness That Could Create a Genuine Issue of Disputed Fact as to the Meaning of a Patent Claim	4
B. A Patent Claim Is an Official, Institutional, Gov- ernmental Imposition of Legal Obligations on the World at Large and As Such, Unlike a Con- tract But Like a Statute, Must Have a Public Meaning to Be Determined by a Court	8
C. This Court's Precedents Support the Federal Circuit's Holding	14
D. Relevant Functional and Practical Analysis Sup- ports the Federal Circuit's Holding	20
E. The Federal Circuit's Holding Is Consistent With the Seventh Amendment	23
CONCLUSION	30

TABLE OF AUTHORITIES

Cases	Page
<i>Aetna Life Ins. Co. v. Dunken</i> , 266 U.S. 389 (1924)	25
<i>Air France v. Saks</i> , 470 U.S. 392 (1985)	10
<i>American Airlines, Inc. v. Wolens</i> , 115 S. Ct. 817 (1995)	12
<i>Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.</i> , 927 F.2d 1200 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991)	6
<i>Arkwright v. Nightingale</i> , Davies Patent Cases 37 (Common Pleas 1785)	27
<i>Association of Data Processing v. Board of Governors</i> , 745 F.2d 677 (D.C. Cir. 1984)	13
<i>Baltimore & Carolina Line v. Redman</i> , 295 U.S. 654 (1935)	4, 24
<i>Bates v. Coe</i> , 98 U.S. (8 Otto) 31 (1878)	15
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1870)	16
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989)	26
<i>Bose Corp. v. Consumers Union of United States</i> , 466 U.S. 485 (1984)	25
<i>Bovill v. Moore</i> , Davies Patent Cases 361 (Common Pleas 1816)	29
<i>Boyle v. United Technologies Corp.</i> , 487 U.S. 500 (1988)	4
<i>Bristow v. Drake Street Inc.</i> , 41 F.3d 345 (7th Cir. 1994)	11
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 212 (1854)	18
<i>Brown v. Guild</i> , 90 U.S. (23 Wall.) 181 (1874)	6
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986)	23
<i>Central Bank v. First Interstate Bank</i> , 114 S. Ct. 1439 (1994)	23
<i>City of New York v. Ransom</i> , 64 U.S. (23 How.) 487 (1860)	20
<i>Collins v. Sawrey</i> , 4 Bro. P.C. 692, 2 Eng. Rep. 470 (H.L. 1772)	29
<i>Corning Glass Works v. Brennan</i> , 417 U.S. 188 (1974)	9
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	16

TABLE OF AUTHORITIES—Continued

	Page
<i>Eastern Airlines, Inc. v. Floyd</i> , 499 U.S. 530 (1991)	10
<i>Edward R. Marden Corp. v. United States</i> , 803 F.2d 701 (Fed. Cir. 1986)	13
<i>Fiske v. Kansas</i> , 274 U.S. 380 (1927)	25
<i>Fogerty v. Fantasy, Inc.</i> , 114 S. Ct. 1023 (1994)	23
<i>Fruin-Colnon Corp. v. United States</i> , 912 F.2d 1426 (Fed. Cir. 1990)	13
<i>Galloway v. United States</i> , 319 U.S. 372 (1943)	26
<i>General Electric Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938)	5, 7, 19
<i>Georgia v. Brailsford</i> , 3 U.S. (3 Dall.) 1 (1794)	26
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	6, 8
<i>Great Northern Ry. v. Merchants' Elevator Co.</i> , 259 U.S. 285 (1922)	13
<i>Haynes v. Washington</i> , 373 U.S. 503 (1963)	25
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	14
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (1995), cert. pending, No. 95-728	7
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	14
<i>Hornblower v. Boulton</i> , Davies Patent Cases, 221 (K.B. 1799)	29
<i>Howes v. Medical Components, Inc.</i> , 814 F.2d 638 (Fed. Cir. 1987)	7
<i>Huddart v. Grinshaw</i> , Davies Patent Cases 265 (K.B. 1803)	29
<i>Hybritech Inc. v. Abbott Laboratories</i> , 849 F.2d 1446 (Fed. Cir. 1988)	5
<i>In re Borkowski</i> , 422 F.2d 904 (C.C.P.A. 1970)	5
<i>In re Envirodyne Industries, Inc.</i> , 29 F.2d 301 (7th Cir. 1994)	9
<i>In re Peterson</i> , 253 U.S. 300 (1920)	24
<i>Intellical, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384 (Fed. Cir. 1992)	7
<i>Kewanee Oil Co. v. Bicron Corp.</i> , 416 U.S. 470 (1974)	8
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. (5 Otto) 274 (1877)	14, 18

TABLE OF AUTHORITIES—Continued

	Page
<i>Liardet v. Johnson</i> (unreported, K.B. 1778)	27
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891)	19
<i>Macbeath v. Haldimand</i> , 99 Eng. Rep. 1036 (K.B. 1786)	26
<i>Market Street Cable Ry. Co. v. Rowley</i> , 155 U.S. 621 (1895)	14
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir.), <i>cert. granted</i> , 116 S. Ct. 40 (1995)	<i>passim</i>
<i>Mayor of Kingston Upon Hull v. Horner</i> , 1 Cowp. 102, 98 Eng. Rep. 989 (K.B. 1774)	29
<i>Merrill v. Yeomans</i> , 94 U.S. (4 Otto) 568 (1877) ..	18
<i>Miles Laboratories, Inc. v. Shandon, Inc.</i> , 997 F.2d 870 (Fed. Cir. 1993)	6
<i>Miller v. Fenton</i> , 474 U.S. 104 (1985)	20
<i>Motion Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	12
<i>New York Times Co. v. Sullivan</i> , 376 U.S. 254 (1964)	25
<i>Pullman-Standard v. Swint</i> , 456 U.S. 273 (1982) ..	25
<i>Ransom v. New York</i> , 20 F. Cas. 286 (S.D.N.Y. 1856)	20
<i>Reed v. Proprietors of Locks and Canals</i> , 49 U.S. (8 How.) 274 (1850)	12
<i>Silby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	15, 17
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	14
<i>Smith v. United States</i> , 113 S. Ct. 2050 (1993)	6
<i>Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n</i> , 988 F.2d 1165 (Fed. Cir. 1993)	9
<i>Thompson v. Keohane</i> , No. 94-6615 (Nov. 29, 1995)	9, 21
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1872)	16
<i>Turner v. Winter</i> , 1 T.R. 602, 99 Eng. Rep. 1274 (K.B. 1787)	28
<i>United Carbon Co. v. Binney & Smith Co.</i> , 317 U.S. 228 (1942)	5, 7, 19
<i>United States v. Cuomo</i> , 525 F.2d 1285 (5th Cir. 1976)	9

TABLE OF AUTHORITIES—Continued

	Page
<i>United States v. Easter</i> , 981 F.2d 1549 (10th Cir. 1992), <i>cert. denied</i> , 113 S. Ct. 2448 (1993)	9
<i>United States v. Mitchell</i> , 985 F.2d 1275 (4th Cir. 1993)	10
<i>Walker v. New Mexico & S.P.R.R.</i> , 165 U.S. 593 (1897)	24
<i>Washburn v. Gould</i> , 29 F. Cas. 312 (C.C.D. Mass. 1844)	20
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	8
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854)	15, 17
<i>Winans v. New York Erie R.R.</i> , 62 U.S. (21 How.) 88 (1859)	7, 14
<i>Wright Constr. Co. v. United States</i> , 919 F.2d 1569 (Fed. Cir. 1990)	13
<i>Statutes and Rules</i>	
35 U.S.C. § 112	<i>passim</i>
35 U.S.C. § 271	5
41 U.S.C. § 609(b)	13
Act of July 4, 1836, ch. 357, 5 Stat. 117	18
Act of July 8, 1870, ch. 230, 16 Stat. 198	18
The Judiciary Act of 1789, 1 Stat. 73	24
37 C.F.R. § 1.2	11
37 C.F.R. pt. 15a	11
37 C.F.R. § 1.11(a)	7
37 C.F.R. § 1.75	5
<i>Other Materials</i>	
F. Buller, <i>An Introduction to the Law Relative to Trials at Nisi Prius</i> (6th ed. 1791)	28
D. Chisum, <i>Patents</i> (1995)	<i>passim</i>
J. Cribbet, <i>Principles of the Law of Property</i> (2d ed. 1975)	12
A. Deller, <i>Patent Claims</i> (2d ed. 1971 & 1995 Supp.)	6, 18, 22
Easterbrook, <i>The Supreme Court, 1983 Term—Foreword: The Court and the Economic System</i> , 98 Harv. L. Rev. 4 (1984)	10

TABLE OF AUTHORITIES—Continued

	Page
W. Hands, <i>The Law and Practice of Patents for Inventions</i> (1808)	28
Hantman, <i>Doctrine of Equivalents</i> , 70 J. Pat. & Trademark Off. Soc'y 511 (1988)	19
H. Hart & A. Sacks, <i>The Legal Process</i> (W. Eskridge & P. Frickey eds. 1994)	9
Hulme, <i>On the History of Patent Law in the Seventeenth and Eighteenth Centuries</i> , 18 Law Q. Rev. 280 (1902)	27
F. James & G. Hazard, <i>Civil Procedure</i> (3d ed. 1985)	23
Lutz, <i>Evolution of the Claims of U.S. Patents</i> , 20 J. Pat. Office Soc'y 134 (1938)	17, 27
Manual of Patent Examining Procedure (1995)	5
Monaghan, <i>Constitutional Fact Review</i> , 85 Colum. L. Rev. 229 (1985)	9
Note, <i>Looking It Up: Dictionaries and Statutory Interpretation</i> , 107 Harv. L. Rev. 1437 (1994)	10
Note, <i>The Changing Role of the Jury in the Nineteenth Century</i> , 74 Yale L.J. 170 (1964)	26
Restatement (Second) of Contracts (1981)	11
Woodward, <i>Definiteness and Particularity in Patent Claims</i> , 46 Mich. L. Rev. 755 (1948)	17, 19, 22

**BRIEF OF HONEYWELL, INC.
AS AMICUS CURIAE SUPPORTING RESPONDENTS**

INTEREST OF AMICUS

Honeywell, Inc., participates in high-technology fields in which patents are important. It is currently a party to a patent case (*Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending)) that raises issues related to the issue presented here. For that reason, and because of its continuing interest in the fair, predictable, and proper functioning of the patent system, Honeywell has a strong interest in the outcome of this case.¹

SUMMARY OF ARGUMENT

This Court should affirm the Federal Circuit's holding that the meaning of terms in patent claims does not present a factual issue for juries. To begin with, petitioners' view that a genuine triable dispute can arise about the reasonable understanding of claim terms is simply inconsistent with the substantive patent-law requirement that patent claims, to be valid, must be definite, precise, clear. A judge, after examining the extensive evidence properly considered in discerning a claim's meaning, cannot simultaneously find that there is ambiguity for a jury to resolve (about a truly shared understanding in the relevant skilled community) and that the claim meets the statutory requirement of definiteness. Petitioners' contrary view would defeat the fundamental statutory insistence that a patent give clear warning to the world as to the scope of the protected monopoly.

The Federal Circuit's holding is independently correct because a patent, like a statute but unlike a contract, is an official government act imposing nonconsensual duties on the public at large, charging the public with knowledge of those duties. Interpreting the meaning of the standard of conduct thus created is part of the process of law declaration, providing rules of general application good

¹ Letters indicating the consent of the parties to the filing of this brief *amicus curiae* have been filed with the Clerk of the Court.

against the world, for use by all others working in the area of the patent. And the need to find the relevant community understanding of "technical" terms (read in full context), which may be unfamiliar to some (but not all) judges, makes the task no less one of law declaration than the interpretation of technical terms in statutes or the interpretation of foreign law. By contrast, the factual issue of subjective intent as to meaning, which may be given to juries for resolution in private contract cases where ambiguity exists, is out of place in patent interpretation, as petitioners effectively recognize in downplaying reliance on any contract analogy and insisting that it is an objective, public meaning that is to be discerned in this setting. Determining the meaning of a patent claim, as a duty-imposing government instrument, is not for a jury.

This Court's precedents support the Federal Circuit's ruling. The Court has many times ruled that patent interpretation is for the courts. The few allegedly contrary decisions petitioners cite actually involved not the determination of the meaning of words in a patent claim, but factual findings about the application of patent language after full refinement through interpretation. The role for the latter task was necessarily greater in the pre-1870 era, when "claims" were either non-existent or so brief and imprecise that very little *interpretation* of patent language was relevant to patent litigation. The task of discerning the meaning of patent claims, however, was even then a question of law, and it did not cease to be one when, because of the ever-increasing emphasis on detailed and precise patent claims, it came to play a much more dominant role in infringement suits.

The Federal Circuit's ruling is further supported by the sorts of functional and practical considerations that this Court has found relevant to drawing the law/fact distinction. In particular, assignment of patent interpretation to judges is more in accord with the patent system's demand for precision and uniformity in the government-imposed

obligations created by patents and with the inevitable unimportance of in-court demeanor and credibility determinations in discerning the shared skilled-community understandings of patent language that must, by law, have a definite meaning. Moreover, the patent system cannot sensibly divide the mass of interpretive issues according to whether they are "technical" or "non-technical," or according to the degree of technical knowledge of the particular judges involved. Of course, if the result of the Federal Circuit's ruling is to resolve many cases without need of jury trials, that is hardly a vice, as petitioners appear to suggest; it is, rather, a virtue.

Against this background, petitioners' Seventh Amendment argument effectively dissolves. The argument fails most simply because, for all of the foregoing reasons, patent interpretation properly falls on the law side of the law/fact distinction under the Seventh Amendment. And even if that were not so, this Court has made clear that the jury's ordinary power over facts under the Seventh Amendment does not apply when seemingly factual issues are intermingled with federal rights and judges' determinations are required in order to ensure proper application of federal rights—here, the monopoly rights granted each patentee and the corresponding limitations on the economic rights of others. Finally, petitioners' resort to pre-1791 English law furnishes them no support: the authorities they cite assign various factual questions to juries (*e.g.*, whether a machine was new, whether the description enabled skilled artisans to construct the machine), but they nowhere establish that juries were assigned the task of interpreting the meaning of patent terms, let alone then-nonexistent patent claims.

ARGUMENT

THE FEDERAL CIRCUIT CORRECTLY HELD THAT THE MEANING OF A PATENT CLAIM PRESENTS A LEGAL QUESTION FOR THE JUDGE, NOT A FACTUAL QUESTION FOR THE JURY.

The Seventh Amendment requires a jury trial only of genuine issues of disputed fact, where reasonable minds

can differ. See *Boyle v. United Technologies Corp.*, 487 U.S. 500, 513 (1988); *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657-59 (1935). The interpretation of a patent claim does not present a jury issue, first, because a patent claim, in order to be valid at all, cannot have the sort of ambiguity of meaning that would raise a triable issue and, second, because the interpretation of a patent claim is in any event a legal (not factual) question about the public, objective meaning of a government-imposed general obligation. This Court's precedents, as well as a functional and practical analysis of the law/fact distinction, support this result. And nothing in Seventh Amendment law is to the contrary. The Federal Circuit's ruling should therefore be affirmed.

A. The Substantive Rules of Patent Law Preclude Indefiniteness That Could Create a Genuine Issue of Disputed Fact as to the Meaning of a Patent Claim.

Petitioners' entire argument for assignment of a "factual" issue of meaning to a jury rests on the premise that a judge, after exhausting the usual textual sources for determining meaning, is left with an ambiguity that cannot be resolved. Such an ambiguity, petitioners urge, creates an issue of fact: "what does a patent term mean to one skilled in the art"? Br. 15; Br. 18 (fact issue is "what the claims mean to one 'of skill in the art'"); see also Litton Br. 21 ("what the relevant scientific community would understand a particular term to mean at the time of the patent's issuance"). But as the Federal Circuit explained (*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (1995)), the substantive rules of patent law require that patent claims be unambiguous. Thus, no jury issue as to the meaning of a valid patent claim can properly arise.

1. The Federal Circuit's ruling rests squarely on longstanding substantive rules of patent law. Section 112 of the current statute, enacted in 1952, begins by declaring that a patent "specification" must "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and

exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112 (paragraph 1). It then adds: "The specification shall conclude with one or more claims particularly pointing out and *distinctly claiming* the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (paragraph 2) (emphasis added).²

The statute thus imposes two quite separate requirements: enablement and definiteness. See D. Chisum, *Patents* § 8.03[2] (1995) ("Definiteness Distinguished from Enablement"). While the enablement requirement "means that the *specification* must describe the manner of making and using the invention in such clear terms as to enable any person skilled in the art to make and use it," the definiteness requirement "means that the language of the *claims* must *clearly* set forth the area over which the applicant seeks exclusive rights." *Ibid.* (emphasis added). This latter requirement, in the second paragraph of 35 U.S.C. § 112, "is essentially a requirement for *precision* and *definiteness* of claim language." *Ibid.*; see, e.g., *Hybritech Inc. v. Abbott Laboratories*, 849 F.2d 1446, 1453 (Fed. Cir. 1988); *In re Borkowski*, 422 F.2d 904, 909 (C.C.P.A. 1970).³ It has thus repeatedly been recognized that a patent *claim* cannot validly cover anything it does not clearly and unambiguously cover. See, e.g., *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) (to be valid, claims must "clearly distinguish what is claimed

² The statute's provision on infringement, 35 U.S.C. § 271, then creates liability if any person (without authority) "makes, uses or sells any patented invention" (in this country during the term of the patent), the "invention" having been defined by the patentee in the "claims."

³ This requirement of definiteness of meaning is embodied in the rules and guidelines of the Patent and Trademark Office as well. See, e.g., 37 C.F.R. § 1.75; Manual of Patent Examining Procedure §§ 608.01(o) (meaning must be "apparent" and "insure certainty"), 608.01(v) (meaning of nonproprietary name must be defined in "precise and definite" manner or already "well-known and satisfactorily defined in the literature").

from what went before in the art and clearly circumscribe what is foreclosed from future enterprise"; forbidding "zone of uncertainty"); *Markman*, 52 F.3d at 986 (ambiguity may invalidate patent); *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 874-75 (Fed. Cir. 1993) ("clear and definite meaning" required); *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1218 (Fed. Cir.), *cert. denied*, 502 U.S. 856 (1991) ("When the meaning of claims is in doubt, . . . they are properly declared invalid."); notes 17, 18, *infra*.⁴

Under these substantive principles of patent law, petitioners' premise is self-defeating. If there is a common community understanding of the meaning of a term in a patent claim, as there must be for a patent claim to be *valid*, there cannot be an ambiguity, unresolvable on the full record available to the judge, leaving a genuine factual issue as to meaning. If there were such an ambiguity, then the patent-infringement plaintiff would already have lost, because the claim cannot meet the precision requirement that "one skilled in the art would understand the bounds of the claim when read in light of the specification." *Miles Laboratories*, 997 F.2d at 875.

After all, "ambiguity" cannot be found until after the court, following the normal rules of construction, has "seiz[ed] every thing from which aid can be derived" (*Smith v. United States*, 113 S. Ct. 2050, 2059-60 (1993), quoting *United States v. Fisher*, 6 U.S. (2 Cranch) 358, 386 (1805)), which, in the patent setting, always includes the other claims, the patent specification, the prosecution history, and the elaborate, established rules of patent construction and may (though need not) also include helpful texts and live testimony. See, e.g., *Graham*

⁴ Indefiniteness need not lead to invalidation of the whole patent claim. If a claim is ambiguous because one (narrow) application is definitely covered but a second (broader) application is uncertain, a "saving" construction—consistent with the principle that the courts "ought to give a favorable construction, so as to sustain the patent if it can fairly be done" (*Brown v. Guild*, 90 U.S. (23 Wall.) 181, 226 (1874))—would adopt the narrower reading. See A. Deller, *Patent Claims* § 76 (1971 ed. & 1995 Supp.).

v. John Deere Co., 383 U.S. 1, 33 (1966); *Winans v. New York & E.R.R.*, 62 U.S. (21 How.) 88, 100-01 (1859); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 645 (Fed. Cir. 1987).⁵ If, after this extensive examination, a genuine uncertainty about meaning remains, the statutory requirement that a claim "distinctly" identify the invention cannot be met. Thus, the patent statute, indeed petitioners' very notion of a common community understanding of particular terms, negates the essential premise of petitioners' argument—that a valid patent claim can present a factual issue as to its meaning on which reasonable jurors could come to opposite conclusions.⁶

2. The distinctively strong statutory requirement of precision is needed to carry out a long-recognized policy: a patent claim must "give fair warning to persons in the art of what will constitute infringement." D. Chisum, *Patents* § 803[3] (1995). Thus, this Court has explained: "The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.'" *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. at 232; *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. at 369. And the Court has emphasized that "[t]he claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention

⁵ The prosecution history is on file with and publicly available from the Patent and Trademark Office. 37 C.F.R. § 1.11(a).

⁶ Contrary to the suggestion of *amicus* Litton (Br. 18), the interpretation of claim language is not left to the jury under the "doctrine of equivalents" (which itself is the subject of a recent *en banc* decision of the Federal Circuit, from which certiorari has been sought, *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (1995), petition for certiorari filed, No. 95-728 (Nov. 6, 1995)). Whatever issues are presented by allowing infringement to be based on a finding as to what is "equivalent" to the plaintiff's patent claim, the threshold requirement is that the claim itself be precisely defined so as to establish a clear benchmark for the equivalence comparison.

is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *White v. Dunbar*, 119 U.S. 47, 51-52 (1886).

These fundamental statutory policies make clear that a valid patent claim cannot allow the sort of ambiguity on which petitioners rest their contention that claim interpretation presents a factual issue for a jury. Any claim so ambiguous as to present two reasonable interpretations cannot provide the statutorily required clear notice to the world as to what precisely is off limits to all but the patentee. Granting to a jury (or any finder of fact) the power to "resolve" some residual ambiguity in a valid claim—some indefiniteness as to how the relevant terms are understood by the relevant skilled community—strips the claim of its fundamental function of furnishing clarity to the public. Petitioners' position, in short, would undermine the "uniformity and definiteness which Congress called for in the 1952 Act." *Graham*, 383 U.S. at 18.

B. A Patent Claim Is an Official, Institutional, Governmental Imposition of Legal Obligations on the World at Large and As Such, Unlike a Contract But Like a Statute, Must Have a Public Meaning to Be Determined by a Court.

1. Even if extrinsic evidence is required in an infringement case, the interpretation of a patent claim is a matter of law because a patent claim, like a statute, is a governmental act imposing nonconsensual public obligations. *See Markman*, 52 F.3d at 987. Once a patent issues, the public at large, including complete strangers to the governmental proceeding that produced the patent, is under a new federally imposed duty to avoid making, using, or selling the patented invention (35 U.S.C. § 271) and is generally charged by law, as with a statute, with knowledge of what it may not do. *See Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478 (1974) (intent is not an element of infringement liability). The issuance of a patent through formal governmental processes thus sets a generally applicable standard of conduct. And the inter-

pretation of its meaning involves "law declaration": as with a statute, fashioning a "more precise definition" is "a further exercise of the function of law declaration," because it is "concerned with general propositions," and "the answer is good not only for this case but for all other like cases," thus adding to the clear guidance that patent law demands. H. Hart & A. Sacks, *The Legal Process* 352 (W. Eskridge & P. Frickey eds. 1994); *see also* Monaghan, *Constitutional Fact Review*, 85 Colum. L. Rev. 229, 235 (1985) ("The important point about law is that it yields a proposition that is *general* in character."); *Thompson v. Keohane*, No. 94-6615 (Nov. 29, 1995), slip op. 13-16.

This analogy to statutes and other public law is in no way defeated by the fact that a patent involves technical concepts or terms requiring interpretation on the basis of non-legal materials. *Cf.* Pet. Br. 45. Not only are federal judges likely to be more adept at such interpretation than juries, but the need to discover the accepted meaning of technical or other non-legal terms simply does not distinguish patents from statutes. This Court has explained that "where Congress has used technical words or terms of art, 'it [is] proper to explain them by reference to the art or science to which they [are] appropriate.'" *Corning Glass Works v. Brennan*, 417 U.S. 188, 201 (1974); *see also United States v. Cuomo*, 525 F.2d 1285, 1291 & n.17 (5th Cir. 1976) (collecting authorities). And courts may rely, as this Court did in *Corning*, on live testimony or documentary evidence, such as specialized dictionaries, to discern the technical meaning in the relevant field. *Corning*, 417 U.S. at 202; *see United States v. Easter*, 981 F.2d 1549, 1558 (10th Cir. 1992), *cert. denied*, 113 S. Ct. 2448 (1993); *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1172 (Fed. Cir. 1993).⁷

⁷ General and specialized dictionaries are routinely used by this Court and other courts, even without formal admission as evidence (*see In re Envirodyne Industries, Inc.*, 29 F.3d 301 (7th Cir. 1994)) and certainly without transforming the interpretive task into a

Nothing about the need to determine the meaning of initially unfamiliar terms, through an examination and evaluation of the objective evidence of how they are understood in the relevant community, disqualifies the task as law interpretation. Uncovering the accepted understanding in the relevant community retains its basic legal character even when the relevant community is a technical or unfamiliar one. Indeed, that task is just what federal judges are charged with doing by Federal Rule of Civil Procedure 44.1, which declares that the determination of *foreign* law—often, of course, in a foreign language and from an unfamiliar legal culture—is a matter of law for the judge, even when conflicting evidence is presented. *See, e.g., United States v. Mitchell*, 985 F.2d 1275, 1280 (4th Cir. 1993).

2. The two dissenting judges below relied on a different analogy—that of contract interpretation. *Markman*, 52 F.3d at 1000-01 (Newman, J., dissenting); *id.* at 997 (Mayer, J., concurring in the judgment). Petitioners virtually concede that this analogy may be inapt, invoking it only briefly in historical terms. Pet. Br. 44.¹ And the analogy is, indeed, inconsistent with their view of

"factual" question for a factfinder. *See, e.g., Eastern Airlines, Inc. v. Floyd*, 499 U.S. 530, 536-38 (1991); *Air France v. Saks*, 470 U.S. 392, 400 (1985); Note, *Looking It Up: Dictionaries and Statutory Interpretation*, 107 Harv. L. Rev. 1437, 1447 (1994). Declarations by human beings about meaning, *i.e.*, relevant community understandings, are no different as an evidentiary matter from the declarations in a text.

¹ The metaphor of a patent as a "bargain" between the patentee and the government can, of course, be applied whenever any person, in exchange for some act (participation in a federal program), acquires statutory rights and obligations; interpreting those rights and obligations does not thereby become a matter of fact. The metaphor of contract also has sometimes been used to describe statutory "deals" as well. *See Easterbrook, The Supreme Court, 1983 Term—Foreword: The Court and the Economic System*, 98 Harv. L. Rev. 4, 14-15 (1984) (in one approach to statutory construction, "the judge treats the statute as a contract").

what the "fact" is that a court interpreting a patent claim is supposed to be discerning.

As the Federal Circuit explained (*Markman*, 52 F.3d at 985), in the law of private contracts, when the judge cannot determine the meaning of a written contract (which is concededly a question of law up to the point of ambiguity), the question of community understanding is displaced by the uniquely contract-law inquiry into subjective intent: what did the parties intend to agree to? *See, e.g., Restatement (Second) of Contracts* §§ 201 & Comment a, 202, 212 & Comment d, 220 & Comment b (distinguishing objective, general usage or community understanding, on one hand, from particular understanding or intent defining agreement, on the other, and deeming latter to control if different from former). But petitioners now concede that such subjective intent (though it may play estoppel or other roles) is not the "fact" that defines the meaning of a patent.⁹ The "fact" instead is quite different: it is the understanding of persons skilled in the relevant art—a matter determinable by a judge using the same materials as those used for other forms of law interpretation. *See Bristow v. Drake Street Inc.*, 41 F.3d 345, 352 (7th Cir. 1994) ("evidence about what words, phrases, etc. mean to a community, not merely to a pair

⁹ Not only would any subjective, mutual intent of the patentee and the government be difficult to ascertain and awkward to apply (the government is rarely a party to infringement litigation, and testimony from examiners is only rarely permitted), but making patent interpretation turn on such intent would be incompatible with the patent policy of clear initial notice to the public at large, as well as with the rule requiring all business with the Patent and Trademark Office to "be transacted in writing." 37 C.F.R. § 1.2; *ibid.* (PTO action "will be based exclusively on the written record"; "[n]o attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt"); 37 C.F.R. pt. 15a.

In a private contract dispute, where general public notice is not key, the ability of the parties to make a factual showing of shared bilateral subjective intent allows a written contract to remain valid despite a broad measure of facial indefiniteness. *See, e.g., Restatement (Second) of Contracts* § 33 & comments.

of individuals[,] . . . is evidence about a public, not a private, language—evidence that is the equivalent, really, of a specialized dictionary”).

Not surprisingly, this Court has distinguished contract rights from “the rights which are given to the inventor by the patent law and which he may assert against all the world through an infringement proceeding.” *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 514 (1917). (The Court has made a similar distinction elsewhere. *E.g.*, *American Airlines, Inc. v. Wolens*, 115 S. Ct. 817, 824 (1995) (distinguishing government-imposed obligations from those voluntarily assumed).) After all, the public duties at issue in patent-infringement actions, created by the government through issuance of the patent, are in no sense voluntarily undertaken or defined. Rather, they are imposed and defined by federal law through formal action of the Patent and Trademark Office, to which the infringement-suit defendant is a stranger.¹⁰ Such a government-imposed public duty, unlike a private party’s agreed-to undertaking, is itself law.

Any analogy to *private*-contract law also fails to aid petitioners for another reason: it simply cannot establish what petitioners are trying to suggest, namely, that finders of fact are routinely given the task of resolving ambiguities in government written instruments, and the same practice therefore can comfortably be followed with patent interpretation. In *government* contract law, however, that is decidedly not the established practice for dealing with

¹⁰ Petitioners’ *amicus* Litton invokes an analogy to a deed (Litton Br. 21), but the decision it relies on for how deeds are interpreted, *Reed v. Proprietors of Locks and Canals*, 49 U.S. (8 How.) 274 (1850), makes only the familiar point that, because a deed is a written bilateral conveyance from one party to another, the boundaries of the property conveyed in the deed are to be determined according to “the intention of the parties.” *Id.* at 288; *see id.* at 289; J. Cribbet, *Principles of the Law of Property* 168, 171 (2d ed. 1975). With subjective intent not the standard for interpreting patent rights (which are not bilateral, but run against the world), the deed analogy adds nothing to, and is no stronger than, the contract analogy.

ambiguity. Rather, the Federal Circuit (like its predecessors) has declared that “contract interpretation is a question of law,” not a matter of fact. *Wright Constr. Co. v. United States*, 919 F.2d 1569, 1571 (Fed. Cir. 1990).¹¹ And if an ambiguity is found (after examination of disputed testimony about the contract’s meaning), resolution of that ambiguity is *not* remitted to a factfinder; instead, the inquiry turns to whether the plaintiff relied on its (reasonable) interpretation of the (government-drafted) contract in submitting its bid. *See, e.g.*, *Fruin-Colnon Corp. v. United States*, 912 F.2d 1426, 1430 (Fed. Cir. 1990); *Edward R. Marden Corp. v. United States*, 803 F.2d 701, 705 (Fed. Cir. 1986). Even in the contract setting, then, it is hardly a familiar step to deem the interpretation of a *government* written instrument a matter of fact for adjudication, much less a jury question. Without even contract law as a reliable precedent in the government context, it would be extraordinary, if not entirely novel, to take that step for patent claims.¹²

¹¹ The question arises, for example, on review of contract interpretations by the Board of Contract Appeals, whose factual findings (but not legal rulings) are subject to substantial-evidence review, 41 U.S.C. § 609(b).

¹² Petitioners’ reference to federal tariffs provides no more aid to the suggestion that the meaning of patent claims is a factual question for juries. Pet. Br. 43-44. This Court explained in *Great Northern Ry. v. Merchants’ Elevator Co.*, 259 U.S. 285, 291-92 (1922), that “[e]very question of the construction of a tariff is deemed a question of law.” The Court then also said, after explaining that contract cases sometimes require factual determinations as to disputed meanings, that the preliminary determination of the specialized meaning of tariff terms was a matter for the Interstate Commerce Commission. 259 U.S. at 292. In a context where the resolution of ambiguity is a task for a national administrative agency, however, nothing turns on whether the resolution is called a factual or legal question: *agency* resolution produces a single, nationwide, uniform answer, to which the courts give deference regardless of its characterization as law or fact. *See, e.g.*, *Association of Data Processing v. Board of Governors*, 745 F.2d 677, 685 (D.C. Cir. 1984) (per Scalia, J.) (equivalence of “substantial evidence” and “arbitrary and capriciousness” tests).

C. This Court's Precedents Support the Federal Circuit's Holding.

Although petitioners and their *amici* argue that this Court's precedents establish that interpretation of a patent claim is a matter of fact for the jury (Pet. Br. 31-37; Litton Br. 15-17; Exxon Br. 7-10), that assertion is incorrect. In fact, petitioners and their *amici* have cited not a single decision of this Court that assigned to a jury, as a finder of fact, the task of resolving an ambiguity in a patent claim so as to decide what the claim *means*. To the contrary, this Court has often declared that determining the meaning of claim language is a matter of law and has often performed that task, without deferring to any finding of fact on the question. And each of the cited authorities supposedly standing for the contrary proposition in fact confirms that determining the meaning of a patent claim, as opposed to other adjudicative tasks, is a matter of law.

1. Petitioners themselves effectively acknowledge that numerous decisions of this Court have both stated that claim interpretation is a matter of law for the judge and actually interpreted the patents' meaning independently. Pet. Br. 34-35, citing and quoting *Heald v. Rice*, 104 U.S. 737, 749 (1881), *Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895), *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904), *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), *Winans v. New York & Erie R.R.*, 62 U.S. (21 How.) at 101, and *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 276 (1877). Petitioners try to write off all of this authority on the ground that none of the cases actually involved a genuine dispute about meanings that were unclear. Pet. Br. 34-35. But the cases have only to be read to see that "technical" issues were often involved, and yet the Court has consistently interpreted patent claims, thus confirming that the meaning of patent claims is a matter of law (for either or both of the reasons set forth in Points A and B, *supra*).

The same principle is confirmed by the decision principally relied on by petitioners' *amicus* Litton (Litton Br. 15-16)—which petitioners assert "simply do[es] not address the question presented here" (Pet. Br. 35 n.18)—namely, *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853). The Court there expressly held that "[t]he construction of the claim was undoubtedly for the court"; that the judge properly concluded that the *meaning* of the patent claim was simply to cover all the parts of the machine that were "essential" to produce the specified result; and that the jury was of course properly given the factual question of which parts were essential. *Id.* at 226. Thus, in full accord with the Federal Circuit's ruling here, *Silsby* carefully distinguished the question of the meaning of the words of the patent—a legal issue—from the factual questions, as to how particular machines would work, that remained once the task of interpretation was exhausted.¹⁸ Similarly, in *Bates v. Coe*, 98 U.S. (8 Otto) 31, 38-39 (1878), this Court explained that "[i]n construing patents, it is the province of the court to determine what the subject-matter is" *See also Markman*, 52 F.3d at 978 n.9 (noting decisions from this Court construing patents in equity cases, without deferential review of trial court construction).

¹⁸ Litton relies, as well, on *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), in which, as petitioners note, "[t]he meaning of [the pertinent] term was undisputed" (Pet. Br. 35 n.18). In fact, the Court in *Winans* said that, in a patent-infringement trial, "two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants. . . . The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury." *Id.* at 338. After the Court construed the patent to cover a particular mode of operation in substance (*id.* at 341, 343), the jury was assigned the task of deciding whether the defendant's product was so close to the patentee's "as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention." *Id.* at 344.

2. Against this weight of authority, petitioners rely for asserted affirmative authority on only two decisions of this Court, *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), and *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872). Pet. Br. 31-33; see also Litton Br. 16. But these two decisions do not remotely hold that determining the meaning of patent language is a task for the jury. If anything, they indicate the opposite.

Thus, in *Bischoff*, the Court held that a jury was to be given the task of comparing the two inventions, noting—at a time before the patent “claim” came to define the invention—that “the outward embodiment of the terms contained in the patent is the thing invented.” 76 U.S. at 815. The Court then took care to note: “This view of the case is not intended to, and does not, trench upon the doctrine that the construction of written instruments is the province of the court alone. It is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions.” *Id.* at 816 (emphasis in original). The Court thus explicitly distinguished the job of interpreting the patent language from the separate job of deciding, as a factual matter, whether the defendant’s product met the description of the patent thus interpreted.¹⁴ That distinction confirms, rather than undermines, the Federal Circuit’s holding that determining the meaning of the patent is a matter of law.

Tucker v. Spalding is no more helpful to petitioners. The issue there was whether the plaintiff’s patent (for a sawing process) was novel or, instead, was invalid because of an earlier invention. 80 U.S. at 454-56. The Court, saying nothing whatever about any issue as to the meaning of any patent language but instead declaring that the case was governed by *Bischoff*, held that the

¹⁴ See also *Coupe v. Royer*, 155 U.S. 565, 579 (1895) (“the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant”).

defendant was entitled to give the jury the prior patent to determine whether “what [the earlier invention] actually did, is in its nature the same as sawing, and its structure and action suggested to the mind of an ordinary skillful mechanic [the] double use” characteristic of the plaintiff’s machine. *Id.* at 455-56. This question of novelty, on its face a factual matter, presents no issue as to the meaning of language in the patent. Cf. Exxon Br. 10-11 (conflating question of meaning with question of level of ordinary skill in the art).

These and similar cases from the era tend to concentrate on the underlying factual aspects of infringement because they were decided under a set of patent-law principles quite different from those prevailing today. At least before the latter years of the Nineteenth Century, the “claim” of a patent, where it existed at all, was not nearly as detailed, precise, and important as it is today: it was not taken as *prescribing*, but merely as *describing*, the protected invention.¹⁵ As a result, although the courts interpreted the meaning of such language as there was, that language, because of its generality and imprecision, did not carry the inquiry into infringement very far. Any

¹⁵ “[T]he courts for a long time did not regard the particular formulations chosen by the inventor to express his claim and distinguish his invention from the prior art as the definitive measure of the scope of the patent.” Woodward, *Definiteness and Particularity in Patent Claims*, 46 Mich. L. Rev. 755, 760 (1948). Thus, the Court’s 5-4 decision in *Winans v. Denmead*, 56 U.S. (15 How.) at 343, treated the claim as merely the best embodiment, rather than definition, of the true invention. See Woodward, *supra*, at 762-63. Until the latter years of the Nineteenth Century, the Patent Office and the courts allowed claims of a few lines that did little more than refer back to the specification for the description of the invention; and in litigation, “the claim was not used to measure infringement,” but, instead, the question of infringement was “whether the two things, one of which is said to be an infringement upon the other, are the same, or different.” Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. Pat. Office Soc’y 134, 147 (1938); see, e.g., *id.* at 134-47, 459-62 (quoting numerous such simple claims); *id.* at 462-66 (Patent Office practice during 1836-1870); *Silsby v. Foote*, 55 U.S. (14 How.) at 226 (representative claim).

effort to refine the *meaning* of patent language was quickly exhausted, and much work was left to the factfinder to apply that fully construed, but still imprecise, language—which often just described a core mode of operation or function “in substance.”

After the 1870 Act, however, the Court began to establish with new force a quite different principle of patent law, one that had previously been invoked on occasion (e.g., *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853)) and that found support in the 1836 Act but was embodied much more explicitly in the 1870 Act: that the patent claim *defines* the protected invention and must, in order to be valid, be precise and definite.¹⁶ E.g., *Merrill v. Yeomans*, 94 U.S. (4 Otto) 568, 570, 573-574 (1876)¹⁷; *Keystone Bridge Co.*, 95 U.S. at 278-79¹⁸;

¹⁶ See D. Chisum, *Patents* § 8.02[2] (1995); A. Deller, *Patent Claims* § 4, at 9 (2d ed. 1971) (“The idea that the claim is just as important if not more important than the description and drawings did not develop until the Act of 1870 or thereabouts [see Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198]. . . . The developing importance of the claims, first mentioned in the Act of 1836 [Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117], then later regarded by the Act of 1870 as of equal importance with the description of the invention and the drawings, has since resulted in the claim being regarded as by far the most important part of a patent.”).

¹⁷ The Court in *Merrill* explained that it was time for a change in patent law: there was no longer any “excuse for ambiguous language or vague descriptions. . . . The genius of the inventor, constantly making improvements in existing patents,—a process which gives to the patent system its greatest value,—should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented.” 94 U.S. at 573-74 (emphasis added).

¹⁸ The Court in *Keystone* explained that the requirement of a “claim,” separate from the description contained in the specification, “was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited and

see *McClain v. Ortmyer*, 141 U.S. 419 (1891). “As a natural result of the general establishment of the claims of a patent as the primary measure of the scope of the patent grant,” the practice of the Patent Office and of patent attorneys gradually but markedly shifted from the former “central claiming” regime to the modern “peripheral claiming” regime, in which the outer boundary (rather than just the core) of the patent monopoly is laid out in precise detail. Woodward, 46 Mich. L. Rev. at 764 (footnote omitted); see Hantman, *Doctrine of Equivalents*, 70 J. Pat. & Trademark Off. Soc’y 511, 522 (1988); *Markman*, 52 F.3d at 996 (Mayer, J., concurring in the judgment). In the decades leading up to the enactment of the current Patent Act in 1952, this Court, with ever increasing consistency, insisted on precision and definiteness of patent claims, which, it explained, “‘measure the invention.’” *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. at 369; *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. at 236; see D. Chisum, *Patents* § 8.02[3] (1995).

Under this modern regime, the interpretation of patent-claim language takes on far greater importance than under the former regime. Where the language is much more precise and detailed, and where it is taken to *define* the invention, that meaning will leave fewer factual questions as to whether a defendant’s product is one of the things described in the (now precise) patent claim. But nothing in the earlier precedents’ focus on the factfinding judgments left in applying patent terms after they have been fully interpreted—an inevitable focus, given the imprecision of the patent terms—in any way casts doubt on the *legal* character of the initial task of interpreting patent terms, a character those decisions in fact affirm. Nor, of course, do those decisions cast doubt on Congress’s power to insist that patent terms be more precise so as to di-

made to conform to what he is entitled to. . . . When the terms of a claim in a patent are *clear and distinct*, as they always should be, the patentee, in a suit brought upon the patent, is bound by it.” 95 U.S. at 278 (emphasis added).

minish the scope for factfinding judgment in applying them.¹⁹

D. Relevant Functional and Practical Analysis Supports the Federal Circuit's Holding.

The correctness of the Federal Circuit's ruling is further confirmed by application of the law/fact analysis set forth in *Miller v. Fenton*, 474 U.S. 104 (1985). There, this Court explained: "In the [28 U.S.C.] § 2254(d) context, as elsewhere, the appropriate methodology for distinguishing questions of fact from questions of law has been, to say the least, elusive. . . . [T]he Court has yet to arrive at 'a rule or principle that will unerringly distinguish a factual finding from a legal conclusion.' . . . At least in those instances in which Congress has not spoken and in which the issue falls somewhere between a

¹⁹ Petitioners' reliance on *Washburn v. Gould*, 29 F. Cas. 312 (C.C.D. Mass. 1844), *see* Pet. Br. 27, is misplaced. There, Justice Story, sitting as Circuit Justice, recognized that the issue of enablement by the specification (a fact question) was a different issue from that of definiteness of the claim and proceeded to construe the claim as a matter of law (29 F. Cas. at 318); he stated that "the court was bound to state what in point of law the invention claimed by the patentee was . . . so far as the construction of the words of the patent, and specification is concerned" (*id.* at 325 (emphasis added)); he indicated that he did not rely on the notion that the jury may judge the meaning of technical phrases (*ibid.*); and he made clear that the factual questions for the jury, in determining infringement, were what parts of the patentee's claimed machine were actually new and whether the defendant used such substantial parts (*ibid.*). Nothing in *Washburn*, in short, holds that determining the meaning of a patent claim is a matter of fact for the jury.

Petitioners' reliance on a passing statement in a lengthy jury instruction given in *Ransom v. New York*, 20 F. Cas. 286, 289 (S.D.N.Y. 1856), *see* Pet. Br. 28, needs little response. Even aside from the minimal weight of such authority, it is not clear that the court actually gave the question of the technical meaning of the patent claim to the jury. In any event, on review, this Court remanded for a new trial (though for lack of a proper record, the Court was "unable to test the correctness of the construction of the patent by the court below"). *City of New York v. Ransom*, 64 U.S. (23 How.) 487, 488, 491 (1860).

pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question." *Id.* at 113-14. The Court then found the "voluntariness" of a confession not to be a question of fact, based on (a) precedent, (b) the need to ensure that the answer in any case is compatible with the overall legal system's presumption of innocence and non-inquisitorial character, and (c) the relative unimportance to this issue of in-court credibility of witnesses. 474 U.S. at 115-18. (The Court recently followed a similar analysis in holding that whether a suspect is "in custody"—a question whose resolution is not based on subjective intent but rather on an objective standard—is a question of law. *Thompson v. Keohane*, No. 94-6615 (Nov. 29, 1995).)

A similar analysis in this case supports the Federal Circuit's ruling that patent-claim interpretation—itself plainly not a matter of simple historical fact, *i.e.*, a concrete occurrence at a particular time, "what happened" (*Thompson*, slip op. 11)—is a question for the court. To begin with, as just discussed, precedent provides strong support for the Federal Circuit's ruling. Moreover, the Federal Circuit's ruling is (for the reasons discussed in Points A and B, *supra*) more compatible with the overall patent system—both with the statute's demand for precision, definiteness, and uniformity and with the character of patent grants imposing general duties on the public at large through formal agency action. Further, a jury does not have any peculiar advantage in determining community understanding as to the meaning of a term in a patent claim. In particular, it is hard to imagine how a finding of a shared understanding of meaning in the relevant skilled community could come down to an assessment of in-court demeanor—as opposed to an evaluation of accumulated documentary evidence and the substance of transcribed testimony.

Practical considerations bearing on the "sound administration of justice" support this result as well. Petitioners'

suggestion that interpretation of "technical" terms is a task for the jury creates an impractical division of labor for what ultimately is one task. Petitioners do not, and could not, dispute that it is for the judge to interpret patent claims insofar as the task requires application of the blizzard of established and developing special rules of patent law defining the effect of particular terms and phrasings. See Woodward, 46 Mich. L. Rev. at 765 ("the claims of patents have become highly technical in many respects as the result of special doctrines relating to the proper form and scope of claims that have been developed by the courts and the Patent Office from time to time"); see generally A. Deller, *Patent Claims* (2d ed. 1971 & 1995 Supp.); D. Chisum, *Patents* § 8.06 (1995). Yet petitioners' position would require the judge to draw a line between the "technical" and "non-technical" terms in patent claims so as to assign interpretation of the former, but not the latter, to the jury. The introduction into the law of such a hard-to-discern line would complicate the workings of the patent system, fostering excessive litigation and undermining the statutory policy of certainty and clarity in the scope of patent monopolies.

Inevitably, any line based on whether or not an interpretation is of a "technical" term will vary from judge to judge. One judge, adept in the relevant technical field, may not even have a need for extrinsic evidence on the relevant community understanding of the term, but may find the meaning clear from the judge's own knowledge or with aid of relevant texts that the judge comprehends. A second judge, less familiar with the technical field, may need other extrinsic evidence to become informed of the matter. The task of interpretation, however, cannot sensibly be for the judge in the one case and for a jury in the other.

Petitioners object that, if claim interpretation is a matter of law for the judge, juries may have too little to do in infringement litigation. Pet. Br. 17 n.8. This is an absurd objection. What work there is for a jury turns entirely on the substance of the governing legal standard

and what factual questions the standard presents. See F. James & G. Hazard, *Civil Procedure* § 7.10, at 337 (3d ed. 1985). A legal standard imposing some form of strict liability, thus eliminating the factual inquiry required by an intent-based standard, is not to be condemned on that account.

Indeed, whether as a policy matter or as a constitutional matter, there is no virtue in making work for juries. To the contrary, it flies in the face of reason and policy to treat as a vice, rather than a virtue, a statutory standard that reduces the necessity and extent of costly litigation over factual issues. See, e.g., *Central Bank v. First Interstate Bank*, 114 S. Ct. 1439, 1454 (1994); *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986) (summary judgment should be used to implement Fed. R. Civ. P. 1's commitment to securing the "just, speedy and inexpensive determination of every action"); *Fogerty v. Fantasy, Inc.*, 114 S. Ct. 1023, 1030 (1994) ("Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.")

E. The Federal Circuit's Holding Is Consistent With the Seventh Amendment.

There is no precedent of this Court stating whether patent-claim interpretation must, as a matter of Seventh Amendment law, be assigned to a jury: petitioners acknowledge that this Court has not "addressed the Seventh Amendment explicitly." Pet. Br. 21. That absence of authority—notwithstanding this Court's ample body of precedent supporting the Federal Circuit's holding that interpreting a patent claim is a legal task for the judge—is readily understandable. Given all of the foregoing reasons why the Federal Circuit's holding is sound as a non-constitutional matter, nothing whatever in the Seventh Amendment requires a different result.

1. Initially, treatment of the task of discerning the meaning of a patent claim as a legal question is consistent with the Seventh Amendment because, for all of the rea-

sons stated above, the issue properly falls on the law side of the fact/law distinction.²⁰ Indeed, no precedent identified by petitioners or their *amici* holds that the determination of the *meaning* of a written instrument—which is different from subjective intent and not a pure historical fact—is *constitutionally required* to be treated as a question of fact. Still less is there any precedent declaring such a requirement for the interpretation of a legal instrument issued by formal government action to impose obligations on the world at large, including strangers to the government proceeding.

The second clause of the Seventh Amendment (*see* Pet. Br. 31 n.16; Litton Br. 12-13) adds nothing to the analysis. For cases tried in federal court, it merely protects the right granted in the first clause, by insisting that appellate courts, and the trial judges themselves, follow the common-law principles for setting aside determinations that have been made by a jury. *See, e.g., Baltimore & Carolina Line*, 295 U.S. at 657. The clause has never been read, and cannot sensibly be read, as imposing any requirement as to what issues must be tried to a jury in the first place: the clause addresses itself only to the post-trial process, declaring that a fact that has been “tried by a jury” (as required by law) may not be “re-examined” except under common-law rules. Moreover, and in any event, nothing in the second clause, which speaks explicitly of any “fact” tried by a jury, creates a different line from the fact/law distinction of the first clause—which, as noted, does not aid petitioners’ Seventh Amendment argument.

2. The Seventh Amendment presents no obstacle to the Federal Circuit’s ruling even aside from the fact/law

²⁰ The Court has said: “The limitation imposed by the amendment is merely that . . . the ultimate determination of issues of fact by the jury be not interfered with.” *In re Peterson*, 253 U.S. 300, 310 (1920); *see, e.g., Baltimore & Carolina Line*, 295 U.S. at 657; *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593, 596 (1897). The Judiciary Act of 1789, 1 Stat. 73, gave fact issues to juries (§ 9 (district courts); § 12 (circuit courts); § 13 (Supreme Court)) and barred appellate “reversal . . . for any error of fact” (§ 22).

distinction. This Court has made clear that the Seventh Amendment does not rigidly insist on this distinction where proper application of the controlling substantive law requires judicial determination of matters in dispute. Thus, the Court held in *New York Times Co. v. Sullivan*, 376 U.S. 254, 285 n.26 (1964), that “[t]he Seventh Amendment[’s] . . . ban on reexamination of facts does not preclude us from determining whether governing rules of federal law have been properly applied to the facts,” and subsequently in *Bose Corp. v. Consumers Union of United States*, 466 U.S. 485, 511 (1984), that independent appellate court judgment was permitted by the Seventh Amendment on whether there was “actual malice”—an issue that does involve a question of simple historical fact because it asks about the defendant’s subject state of mind, namely, knowledge or suspicion of falsity. *See Bose Corp.*, 466 U.S. at 511 n.30 (meaning of actual malice); *id.* at 517-18 (Rehnquist, J., dissenting) (actual malice a fact question, a proposition not denied by majority); *cf. Pullman-Standard v. Swint*, 456 U.S. 273 (1982) (state of mind a matter of fact). More broadly, the Court has long made clear that the Seventh Amendment’s commitment of fact questions to juries, with its bar on appellate reexamination, does not apply “where a conclusion of law as to a Federal right and a finding of fact are so intermingled as to make it necessary, in order to pass upon the Federal question, to analyze the facts.” *Fiske v. Kansas*, 274 U.S. 380, 385-86 (1927); *see Bose Corp.*, 466 U.S. at 506 & n.24, 508 & n.27; *New York Times Co.*, 376 U.S. at 285 n.26; *Haynes v. Washington*, 373 U.S. 503, 515-16 (1963); *Aetna Life Ins. Co. v. Dunken*, 266 U.S. 389, 394 (1924).

These principles apply to the question of patent-claim interpretation presented in this case and thus independently dispose of petitioners’ Seventh Amendment argument. The interpretation of a patent, concededly a matter of federal right, is, at a minimum, “intermingled” with any “fact” question as to the relevant community understanding of the meaning of particular terms. And given the Patent Act’s demand for clarity and uniformity, proper applica-

tion of a federal patent monopoly—what it restricts and, just as important, what it leaves unrestricted—requires judicial freedom to examine any “fact” determination as to the meaning of particular terms to ensure true definiteness, and proper definition, of the patent claim. See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150, 151, 162 (1989) (patent law policy defeated by improper extension of patent monopoly).

3. Finally, even if the pre-1791 background of the Seventh Amendment were solely determinative here, not only as to what causes of action—statutory as well as nonstatutory—were “suits at common law” but as to what issues in such a case were for the jury, petitioners cannot prevail.²¹ Most generally, contemporaneous authority stated that the meaning of written documents was a matter of law for the judge, not a matter of fact for a jury. *Macbeath v. Haldimand*, 99 Eng. Rep. 1036, 1040 (K.B. 1786) (“there was no evidence which was proper for their [the jury’s] consideration; for the evidence consisting altogether of written documents and letters which were not denied, the import of them was a matter of law and not of fact”). That principle on its face requires rejection of petitioners’ view.

Petitioners fare no better when they attempt to show that *patent* interpretation was treated in English law prior to 1791 as a matter of fact for the jury. See Pet. Br. 22-26. Indeed, they are able to invoke precedent in support of their position only by lumping together a host of different issues in patent law and pretending that they are the same. In particular, their invocation of precedent makes the fundamental mistake of failing to distinguish definite-

²¹ There is reason to doubt any such effect, over and above the points described above. The role of the jury was not so clearly defined as to make a rigid historical approach sensible. See, e.g., *Galloway v. United States*, 319 U.S. 372, 390-91 (1943). Even law questions were occasionally viewed, at the time, as within the right of the jury to decide. See, e.g., *Georgia v. Brailsford*, 3 U.S. (3 Dall.) 1, 4 (1794); Note, *The Changing Role of the Jury in the Nineteenth Century*, 74 Yale L.J. 170, 173-74, 179 (1964). That proposition, of course, has long been rejected.

ness of claim language from enablement. See page 5, *supra*. Once those distinct issues are separated, it is clear that none of petitioners’ pre-1791 English precedents supports their view that determining the *meaning* of the terms of a patent—much less of a (then-nonexistent) “claim” required by law to *define* the precise terms of the invention—presents a question of fact for the jury.²²

Petitioners’ lead case, *Liardet v. Johnson* (unreported, K.B. 1778), which was a patent-infringement action brought by the inventors of stucco, has no bearing on the role of a jury in interpreting the meaning of the terms of a patent, much less the meaning of a patent claim. Indeed, there appears to have been no disputed issue either about the scope of the plaintiffs’ invention (let alone about the meaning of any terms in the patent) or about the defendant’s having used the claimed invention. Rather, Judge Mansfield explained that the defendant “‘rested his defence solely upon this question, Whether the plaintiffs’ composition was a new and useful invention, and whether their patent and specification were sufficient to support the exclusive privilege which they claimed?’” Hulme, *On the History of Patent Law in the Seventeenth and Eighteenth Centuries*, 18 Law Q. Rev. 280, 284 (1902). The case thus involved the quite different issues of novelty and enablement, which present factual questions about the concrete nature of particular products and what skilled artisans can do with particular information at particular times.

Petitioners’ second English authority lends no more aid to their argument. Pet. Br. 24. In *Arkwright v. Nightingale*, Davies Patent Cases 37 (Common Pleas 1785), there was again no issue as to the meaning or scope of the terms of a patent. Rather, the court explained that the sole issue for the jury was the adequacy of the disclosure in enabling the machine to be replicated. *Id.* at 56. The

²² “Prior to 1790 nothing in the nature of a claim had appeared either in British patent practice or in that of the American states.” Lutz, 20 J. Pat. Office Soc’y at 134; see *Markman*, 52 F.3d at 984 (patent claim first developed in United States).

court instructed the jury that the only question before it was whether to believe the several witnesses who testified that they had, in fact, constructed the machine based on the patent specification (thus proving its intelligibility): "the only question for your consideration is, whether these five men have made the machine?" *Id.* at 60. That question, undeniably a factual one, is entirely different from the question whether a relevant community has a shared understanding about the meaning of particular language.

Petitioners' third authority is no different. Pet. Br. 24. In *Turner v. Winter*, 1 T.R. 602, 99 Eng. Rep. 1274 (K.B. 1787), there was simply no question of resolving some apparent ambiguity in the terms of a patent so as to determine what the terms meant. Rather, the question, as in *Liardet*, was whether the patent's terms provided clear instruction of how to produce the invention—for, if not, the vagueness of the disclosure would render the patent void. 1 T.R. at 605-06; 99 Eng. Rep. at 1276-77. There is thus no parallel between the factual question in that case—what skilled artisans were capable of doing with certain information—and the question of interpreting a patent's meaning.

Petitioners also cite W. Hands, *The Law and Practice of Patents for Inventions* 17 (1808), to show the pre-1791 law, but nothing in the text says that the jury is to decide the meaning of the terms of a patent. Pet. Br. 25. The quoted page says that (after legal objections are resolved) the case is submitted to the jury, but it says nothing whatever about what particular issues are submitted. Equally unsupportive of petitioners' reading of English law in the late Eighteenth Century is its misleading quotation from F. Buller, *An Introduction to the Law Relative to Trials at Nisi Prius*, ch. VII, at 76 (6th ed. 1791). See Pet. Br. 25. As respondents noted at the petition stage, quoting the cited passage more fully (Br. in Opp. 9 n.7), the source says nothing to the effect that a jury is to interpret the words of a patent to define its meaning. Rather, in an accurate description of *Liardet*, it says that "[t]he general questions on patents are, 1st,

whether the invention were known and in use before the patent. 2d, whether the specification is sufficient to enable others to make it up" and then adds that "[t]he meaning of the specification is, that others may be taught to do the things for which the patent is granted" Petitioners cannot fairly transform that last sentence into a statement by Buller—much less a well-recognized principle of English patent law—that juries interpret the terms of a patent.²⁸ They are left, in the end, with no proof whatever that the Seventh Amendment codified some pre-1791 principle of English law recognizing that claim interpretation was a matter for juries.

²⁸ In a footnote (Pet. Br. 25 n.13), petitioners cite two additional pre-1791 decisions, but neither lends any support to their point that the interpretation of a patent claim (or indeed of any written document) is a jury question. See *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102, 108, 98 Eng. Rep. 989, 992-93 (K.B. 1774) (factual question of date of port); *Collins v. Sawrey*, 4 Bro. P.C. 692, 699, 2 Eng. Rep. 470, 475 (H.L. 1772) (law case may not be kept by equity court simply because it involves only written evidence). Other authority at the time stated that interpreting written documents was for the judge. *Macbeath v. Haldimand*, *supra*.

Petitioners also cite three English decisions from shortly after 1791. Pet. Br. 26-27, discussing *Hornblower v. Boulton*, Davies Patent Cases 221 (K.B. 1799), *Huddart v. Grinshaw*, Davies Patent Cases 265 (K.B. 1803), and *Bovill v. Moore*, Davies Patent Cases 361 (Common Pleas 1816). But such decisions cannot prove a recognized pre-1791 English principle that the Seventh Amendment could have codified, and in any event, petitioners' own description indicates that the decisions involved only the assignment to juries of plainly factual questions about enablement and novelty. (*Hornblower* also discussed whether the patent was for a machine or an unpatentable mere principle of science, and the judges appear to have answered that question for themselves.) These authorities do not hold that juries are to be assigned the task of determining the meaning of patent language.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

RICHARD G. TARANTO
(Counsel of Record)
FARR & TARANTO
2445 M Street, NW
Washington, DC 20037
(202) 775-0184

DAVID L. SHAPIRO
1575 Massachusetts Avenue
Cambridge, MA 02138

December 8, 1995

1

BEST AVAILABLE COPY

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, INC., AND
ALTHON ENTERPRISES, INC.
Respondents.

On Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE*
DOUGLAS W. WYATT
IN SUPPORT OF RESPONDENTS

DOUGLAS W. WYATT
WYATT, GERBER, BURKE & BADIE, L.L.P.
99 Park Avenue
New York, N.Y. 10016
(212) 681-0800
Counsel of Record

PAUL M. JANICKE
JOHN R. KIRK, JR.
THOMAS E. SMITH
FREDERICK J. DORCHAK
Attorneys for Amicus Curiae

December 8, 1995

TABLE OF CONTENTS

TABLE OF AUTHORITIES	iv
INTEREST OF AMICUS CURIAE	1
SUMMARY OF ARGUMENT	2
ARGUMENT	5
I. <i>AMICUS CURIAE</i> WYATT URGES THIS COURT TO AFFIRM THE FEDERAL CIRCUIT'S HOLDING IN <i>MARKMAN</i>	5
II. THE CONSTITUTIONAL FOUNDATION	7
III. PATENTS, LIKE FEDERAL STATUTES, ARE CREATURES OF CONGRESS	8
IV. STATUTORY CONSTRUCTION IS A MATTER OF LAW FOR JUDGES ONLY, NOT JURIES	9
V. CONSTRUCTION OF PATENT CLAIMS, LIKE STATUTES, IS A MATTER OF LAW EXCLUSIVELY FOR JUDGES, NOT JURIES	10

VI. PATENTEES AND ALL MEMBERS OF THE PUBLIC SHOULD HAVE ONE UNIVERSALLY APPLICABLE CONSTRUCTION OF PATENT CLAIMS ..	16
A. The Public Notice Function of Patent Claims	16
B. While Courts May Consult Extrinsic Evidence in Construing Patent Claims, Such Construction Should, If Possible, Be Based On the Publicly Available Patent and Prosecution History.	17
VII. PATENT CLAIM CONSTRUCTION BY COURTS, NOT JURIES, IS NOT ONLY NECESSARY FOR NATIONALLY UNIFORM PATENT SCOPE, BUT CAN HELP STREAMLINE PATENT JURY TRIALS. ..	19
CONCLUSION	22

TABLE OF AUTHORITIES

CASES

Bates v. Coe, 98 U.S. 31 (1878)	10, 11, 18
Betts v. Menzies, 4 B. & S.Q.B., 999	13
Bischof v. Wethered, 9 Wall., 814	13
Blonder-Tongue Lab. v. University of Illinois Found., 402 U.S. 313 (1971)	19
Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403 (1902)	11
Carver v. Braintree, 5 F. Cas. 235 (C.C.D. Mass. 1843) . .	17
Coupe v. Royer, 155 U.S. 565 (1895)	11
Emerson v. Hogg, 8 F. Cas. 628, (C.C.S.D.N.Y. 1845)	10, 14, 17
Evans v. Eaton, 20 U.S. (7 Wheat.) 356 (1822)	3, 17
General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938)	11, 16, 17
Graham v. John Deere Co., 383 U.S. 1 (1966)	11, 12
Hogg v. Emerson, 52 U.S. (11 How.) 587 (1850)	11, 14
Hogg v. Emerson, 47 U.S. (6 How.) 437 (1848)	14

Imazio Nursery, Inc. v. Coastal Nursery, et al., Appeal No. 94-1450, Slip op. at 9-10 (Fed. Cir. November 3, 1995)	10
Kane v. United States, 43 F.3d 1446 (Fed. Cir. 1994)	10
In re Lockwood, 50 F.3d 966 (Fed. Cir. 1995)	19-20
Lowell v. Lewis, 15 F. Cas. 1018 (C.C.D. Mass. 1817) .	10, 17
Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995)	5, 10, 11, 19, 20, 21, 22
Market Street Cable R. Co. v. Rowley, 155 U.S. 621 (1894)	10-11
Nix v. Hedden, 149 U.S. 305 (1893)	10
O'Hara v. Luckenbach S.S. Co., 269 U.S. 364 (1926)	10
Order of Railway Conductors v. Swan, 329 U.S. 520 (1947)	9
Parker v. Hulme, 18 Fed. Cas. 1138 (C.C.E.D. Pa. 1849) . .	4
Permutit Co v. Graver Corp., 284 U.S. 52, 60 (1931) . .	16, 17
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940)	11, 12, 16, 18
Seymour v. Osborne, 78 U.S. (11 Wall) 516 (1868) .	12, 13, 18
Sickles v. Evans, 2 Cliff., 203	12
Silsby v. Foote, 55 U.S. (14 How.) 218 (1852)	10

Smith v. Snow, 294 U.S. 1 (1935)	11
United Carbon Co. v. Binney & Smith, 317 U.S. 228 (1942)	13
United States v. Adams, 303 U.S. 39 (1966)	11, 12
United States v. John C. Grimberg, 702 F.2d 1362 (Fed. Cir. 1983)	10
U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals, Inc., 315 U.S. 668 (1942)	13
Washburn v. Gould, 29 F. Cas. 312 (C.C.D. Mass. 1844)	10
Western Electric Co. v. Piezo Technologies, Inc., 860 F. 2d 428 (Fed. Cir. 1988)	7
Winans v. Denmead, 56 U.S. (15 How.) 330 (1853)	10

U.S. CONSTITUTION

U.S. Const., Art. I, Sec. 7	7
U.S. Const., Art. I, Sec. 8	3, 7
U.S. Const., Art. I, Sec. 8, Cl. 18	7
U.S. Const., Amend. VII	5, 7

STATUTES

28 U.S.C. § 1338	3, 8
35 U.S.C. § 1-6	8
35 U.S.C. § 112	4, 8, 11, 17, 18
35 U.S.C. § 131	8
35 U.S.C. § 151-154	9

TREATISES

Curtis, G.T. A Treatise on the Law of Patents (4th ed. 1873) § 222	11
2A Singer, Sutherland on Statutory Construction § 47.31 . .	9, 10
2A Singer, Sutherland on Statutory Construction § 47.29 . . .	10
2A Singer, Sutherland on Statutory Construction § 48.01-20 .	9
Stringham, Outline of Patent Law § 5000 (1937)	11

ARTICLES

P.J. Federico, Origin and Early History of Patents, 11 J. Pat. Off. Soc'y (1929)	11
---	----

ADMINISTRATIVE REPORTS

Annual Report of the Director of the Administrative Office of the United States Courts, Table C-4 (1992)	19
Annual Report of the Directory of the Administrative Office of the United States Courts, Table C-4 (temp. ed. 1993) . . .	19
1994 Preliminary Annual Report of the Directory of the Administrative Office of the United States Courts, Table C-4 (1994)	19

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, INC., AND
ALTHON ENTERPRISES, INC.
Respondents.

On Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE*
DOUGLAS W. WYATT
IN SUPPORT OF RESPONDENTS

INTEREST OF *AMICUS CURIAE*

Douglas W. Wyatt ("Wyatt") and Frederick J. Dorchak are
members of the firm of Wyatt, Gerber, Burke & Badie,
L.L.P., 99 Park Avenue, New York, N.Y. 10016;

Professor Paul M. Janicke is a professor of law at the
Intellectual Property Law Institute, University of Houston
Law Center, 4800 Calhoun Boulevard, Houston, Texas
77204-6371;

John R. Kirk, Jr. is a shareholder of the firm of Jenkins & Gilchrist, P.C. 1100 Louisiana, Suite 1800, Houston, TX 77002;

Thomas E. Smith is a member of the firm of Lee, Mann, Smith, McWilliams, Sweeney & Ohlson, 209 S. LaSalle Street, Suite 410, Chicago, Illinois 60604-1212.

Except for Professor Janicke, who is an intellectual property law professor, the attorneys representing Amicus Curiae Wyatt are all intellectual property lawyers in private practice.

Each of the attorneys representing amicus Wyatt are interested and have expertise in intellectual property law, including patent law. The private practitioners practice in the field of patent law, represent patent owners, their competitors and other persons and businesses affected by patents.

While amicus Wyatt, Professor Janicke, and Messrs. Kirk, Smith and Dorchak have no interest in any of the parties of this case, or in the outcome of the case as among those parties, amicus Wyatt and the attorneys do have an interest in seeing that the question upon which certiorari was granted in this case is properly decided by this Court.

SUMMARY OF ARGUMENT

Amicus Wyatt urges this Court to affirm the Federal Circuit's *en banc* holding in *Markman*, thereby affirming the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction. The Federal Court also recognized the

exclusive province of the jury to determine factual issues concerning infringement after a claim has been construed by a court.

The Seventh Amendment guarantees a party's right to a jury trial, where properly demanded, in a patent infringement action for damages. But, amicus Wyatt is unaware of any U.S. Supreme Court decision that expressly holds that a dispute as to the meaning of a U.S. patent claim or any term therein must be a jury question. It is the jury's function to determine the underlying facts as to whether there is infringement. It is the court's function to instruct the jury as to the scope of the claim to enable the jury to perform its function of determining the facts concerning the infringement issue.

The U.S. Constitution, Article I, Section 8, Clause 8, gave Congress the right to grant patent rights, and Congress delegated that authority to the U.S. Patent and Trademark Office (PTO). Prior to the Constitution, the states granted patents in the form of special legislation. See, e.g., Evans v. Eaton, 20 U.S. 356, 370 (1822). Congress has also granted patents by way of special legislation. Id. See also Section 2 of the Patent Act of 1832. Congress also enacted statutory requirements for patent clarity, which requirements are in the first instance enforced by PTO examination before granting of a U.S. patent. Patent claims originated as an American advance in patent law, and an issued patent claim is ultimately like a statutory grant. Congress gave the Federal Courts original jurisdiction over any Act of Congress relating to patents 28 U.S.C. § 1338. Nowhere did Congress make an exception to the courts' powers to interpret the scope of patent claims in the same manner as courts would construe a statute.

In our legal system it is well established that statutory construction is a matter of law for judges exclusively, not for juries. Patent claims, like statutes, should also be construed exclusively by judges, not by juries. A long line of decisions of this Court support the principle that questions of construction of patents and patent claims are questions of law to be decided by courts. This Court's decisions also authorize reference to evidence extrinsic to a patent and its administrative prosecution history to assist courts in properly construing patent claims.

Patent claims serve as notice to the public concerning the scope of a patentee's exclusive rights, and patent claims should have one nationally uniform meaning, as judicially construed based on the publicly available patent and prosecution history. Patent claim construction exclusively by courts, not juries, provides uniform patent claim construction and provides courts with flexibility in administering patent cases to streamline patent jury trials. *Parker v. Hulme*, 18 Fed. Cas. 1138, 1140 (C.C.E.D. Pa. 1849)(No. 10,740)

Unlike patent specifications which are drafted to be understood by persons of ordinary skill in the art under 35 U.S.C. § 112, paragraph 1, patent claims are written by persons expert in drafting claims and not one skilled in the art. Persons skilled in claim drafting and interpretation are patent lawyers, judges and patent examiners and not inventors.

The Federal Circuit was correct in *Markman* and this Court should affirm.

ARGUMENT

I. *AMICUS CURIAE* WYATT URGES THIS COURT TO AFFIRM THE FEDERAL CIRCUIT'S HOLDING IN *MARKMAN*.

In its *en banc* decision in this case the Federal Circuit reaffirmed the long established rule "...that in a [patent] case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)(*en banc*). The Federal Circuit also recognized the exclusive province of the jury to determine factual issues concerning infringement after a patent has been construed by the court.

Amicus Wyatt urges this Court to affirm the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction.

The Seventh Amendment, U.S. Const. Amend. VII, guarantees a party's right to a jury trial, where properly demanded, in a patent infringement action for damages. However, amicus Wyatt believes that the fundamental issue raised by the question upon which this Court has granted certiorari in this case is one which is properly decided by courts, i.e. judges, not by juries. It is the jury's function to determine underlying facts as to whether there is infringement. It is the court's function to instruct the jury as to the scope of a patent claim to enable the jury to perform its function of determining the facts concerning the infringement

issue.

The specific question stated in Markman's petition, upon which this Court granted certiorari, is: "In a patent infringement action for damages, is there a right to jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning?"

The question upon which certiorari was granted here subsumes the fundamental issue of whether, in litigation seeking damages for infringement of a U.S. patent, confirmation of the meaning of a U.S. patent claim or any term or terms used therein is properly (1) exclusively within the power of the court, -- i.e., judges, or (2) resolved as a genuinely disputed question of fact -- a classic jury function. This fundamental issue becomes even more germane when such determinations require consideration of evidence extrinsic to the patent document itself or its administrative prosecution history.¹

For the reasons advanced in this brief, amicus Wyatt advocates that patent claim construction, including determination of the meaning of terms in patent claims, with or without reference to extrinsic evidence, is and should be exclusively within the authority and responsibility of our Federal Courts, i.e., judges. Amicus Wyatt believes that this approach is akin to that used in determining the meaning of federal statutes or terms therein, which are construed exclusively by courts, not by juries. Once the meaning of a statute or a patent claim has been construed, it is the function

¹ Herein we use the terms "extrinsic evidence" to mean evidence outside the patent document and its prosecution history before the administrative agency.

of the jury to determine as fact whether the accused acts are within the properly construed statute or patent claim.

It is important to consider the fact that the Patent Examiner cannot be examined as to his understanding of the meaning of a word in a claim. E.g. Western Electric Co. v. Piezo Technology, Inc., 860 F.2d 428 (Fed. Cir. 1988). The situation with the Patent Examiner is similar to that of a legislator who cannot be examined as to the meaning of particular words in legislation.

II. THE CONSTITUTIONAL FOUNDATION.

The draftsmen of our Constitution affirmatively conferred upon the U.S. Congress the power "to promote the progress of science and useful arts, by securing for limited times for authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const., Art. I, Sec. 8, Cl. 8. The States in 1789 ratified that delegation of power.

Shortly thereafter, the Constitutional draftsmen and Congress supplemented the original work (the Constitution) with the Bill of Rights, which was ratified by the States in 1791. The Bill of Rights included the Seventh Amendment. But, there is no known constitutional or legislative history which indicates that the Seventh Amendment was in any way intended to change the power conferred upon Congress by the U.S. Constitution, Article I, Section 8, Clause 8, quoted above.

The Constitution gave Congress the exclusive authority to make federal statutory law. U.S. Const., Art. I, Sec. 7 and Sec. 8, Cl. 18. The Constitution also expressly gave Congress the authority to grant patent rights to provide

inventors limited periods of exclusivity to their inventions or discoveries.

III. PATENTS, LIKE FEDERAL STATUTES, ARE CREATURES OF CONGRESS.

Just as the citizens and the States gave Congress the power to make statutes and to grant patent rights, the Congress used that power and delegated its authority to administrative agencies like the U.S. Patent and Trademark Office ("PTO") and its predecessors. Congress delegated its power to grant patent rights to the PTO. See 35 U.S.C. §§1-6. In addition, Congress gave the Federal Courts original jurisdiction over any Act of Congress relating to patents; 28 U.S.C. §1338. Nowhere did Congress make an exception as to the courts' powers to interpret the scope of patent claims in the same manner as courts would construe a statute.

In addition to delegating its authority to the PTO, Congress also under its law-making authority enacted 35 U.S.C. §112, paragraph 2, requiring that patents "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Still further, under 35 U.S.C. §131, Congress called for examination of each patent application to determine whether a patent applicant is entitled to a patent under the law (including 35 U.S.C. §112). Thus, when examining patent applications for compliance with §112 before grant, the PTO carries out the constitutional authority delegated to it by Congress to ensure, insofar as possible, that issued patents have clear meaning.

While in the first instance, the words used in proposed patent claims are drafted and submitted to the PTO by patent

applicants, in the final analysis, it is the PTO, pursuant to its statutorily delegated exercise of the constitutional authority given to it by Congress, which approves the grant of a specific patent claim. In this sense an issued patent claim is ultimately like a statutory grant, 35 U.S.C. §§151-154.

Within the power given to it, Congress could have exercised its constitutional authority by providing that each individual patent would be granted by separate bill which, when passed and signed by the President, would have been a statutory patent grant. As reviewed above herein, we know that Congress chose to delegate that authority to the PTO. Thus, it is clear that U.S. patents are the direct progeny of the statutory delegation of the constitutional power of Congress and for all these reasons are closely akin to statutes *per se*.

IV. STATUTORY CONSTRUCTION IS A MATTER OF LAW FOR JUDGES ONLY, NOT JURIES

Determination of the legal meaning and effect of words of a statute is a matter of law to be determined by courts, i.e., judges, only. See, for example, 2A Singer, Southerland on Statutory Construction, §47.31, and the citations therein. And this general rule still applies even when, in disputes concerning the meaning of a term in a statute, testimony or other evidence extrinsic to the words of the statute itself may be admitted and considered en route to a court's determination. See, for example, *Order of Railway Conductors v. Swan*, 329 U.S. 520, 525 (1947) and 2A Singer, §§48.01-20. The authorities also indicate that courts in construing statutes are not compelled to adopt the trade or commercial meaning of a term, 2A Singer, §47.31, but courts may construe statutory terms according to their technical or commercial meaning if the statute is directed to

a trade or business in which that meaning is generally accepted. *Id.* at §§47.29, 47.31 and *O'Hara v. Luckenbach S.S. Co.*, 269 U.S. 364, 370-71 (1926). And, disputes over the commonly-used meaning of a term appearing in a statute are to be resolved by courts directly, not by juries. Compare, however, *Nix v. Hedden*, 149 U.S. 305 (1893)(affirming directed verdict).

The Federal Circuit has followed the rule that statutory interpretation is a matter of law strictly for the court. *United States v. John C. Grimberg Co.*, 702 F.2d 1362, 1365, 1368 (Fed. Cir. 1983), cited with approval in *Markman*, 52 F.3d at 987 and *Imazio Nursery, Inc. v. Coastal Nursery, et al.*, Appeal No. 94-1450, Slip op. at 9-10 (Fed. Cir., November 3, 1995). Those cases also make the related point that appellate courts review issues of statutory interpretation under a *de novo* standard of review; *Imazio Nursery*, Slip. op. at 9; and *Kane v. United States*, 43 F.3d 1446, 1448 (Fed. Cir. 1994).

V. CONSTRUCTION OF PATENT CLAIMS, LIKE STATUTES, IS A MATTER OF LAW EXCLUSIVELY FOR JUDGES, NOT JURIES

For at least more than one hundred seventy-five years questions of construction of patents and patent claims have been held to be questions of law to be decided by the courts, not by juries. *Lowell v. Lewis*, 15 F. Cas. 1018, 1020 (C.C.D. Mass. 1817) (Story, Circuit Justice, charging jury); *Washburn v. Gould*, 29 F. Cas. 312, 318 (C.C.D. Mass. 1844) (Story, Circuit Justice, charging jury); *Emerson v. Hogg*, 8 F. Cas. 628, 631 (C.C.S.D.N.Y. 1845); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 223-25 (1852); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); *Market Street Cable R. Co. v. Rowley*, 155 U.S. 621, 625

(1894); and *Coupe v. Royer*, 155 U.S. 565, 579 (1895).

Patent claims are part of a patent specification, 35 U.S.C. § 112, ¶ 2, and a U.S. patent specification is directed to "any person skilled in the art to which it [the invention] pertains or with which it is most nearly connected" 35 U.S.C. § 112, ¶ 1. See also, *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902).

Patent claims originated as an uniquely American advance in patent law and practice. Stringham, *Outline of Patent Law* § 5000, at 266-67 (1937)("The patent claim, first developed in the United States, is now largely relied upon as defining the scope of protections ...") (emphasis added). See generally, P.J. Federico, *Origin and Early History of Patents*, 11 J. Pat. Off. Soc'y (1929). Cited with approval in *Markman*, 52 F.3d at 984.

When properly construing patent claims, a court must know what certain terms mean to those skilled in the art to which the claimed invention pertains. Since judges are usually not persons skilled in the art of a patented invention in a particular case, the court usually needs to know the art-skilled definition of any extraordinary terms in a patent claim.

This Court has often said that courts properly may look to a patent's specification for such guidance. See *Hogg v. Emerson*, 52 U.S. (11 How.) 587, 606 (1850); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); Curtis, G.T., *A Treatise on the Law of Patents*, 4th ed., 1873, § 222, pages 251-252; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403 (1902); *Smith v. Snow*, 294 U.S. 1 (1935); *General Electric Co. v. Wabash Corp.*, 304 U.S. 364, 371-72 (1938); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) and *United States v. Adams*, 303 U.S. 39, 49

(1966). And, a patent claim must be read and interpreted in light of its prosecution history. *Schriber-Schroth*, 311 U.S. at 220-21 (1940) and *Graham v. John Deere*, 383 U.S. at 33.

This Court also long ago also recognized that courts may be aided by the testimony of witnesses and expert witnesses in ascertaining the true meaning of technical terms or terms of art appearing in patent claims.

Whether a re-issued patent is for the same invention as that embodied in the original patent or for a different one, is a question for the court in an equity suit to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning on the language employed. *Sickles v. Evans*, 2 Cliff., 203.

Where the specification and claim, both in the original and re-issued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the re-issued patent is for the same invention as that described in the original patent or for a different one, is purely a question of construction, but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases, doubtless, arise where the language of the specification and claims, both of the surrendered and re-issued patents, is so interspersed with technical terms and terms of art that the testimony of scientific witnesses

is indispensable to a correct understanding of its meaning. Both parties in such a case would have the right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony, but the case before the court is not of a character to render it expedient to pursue the inquiry. *Bischof v. Wethered*, 9 Wall., 814 (76 U.S. XIX, 830); *Betts v. Menzies*, 4 B. & S.Q.B., 999.

Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 545-46 (1868)(reviewing a decree in equity).

And, in *United Carbon Co. v. Binney & Smith*, 317 U.S. 228, 233 (1942) this Court said:

Here, as in any other cases, it is difficult for persons not skilled in the art to measure the inclusions or to appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself. The clearest exposition of the significance which the terms employed in the claims had for those skilled in the art was given by the testimony of Weigand, one of the patentees, who respondent called as its witness.

Also see *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals, Inc.*, 315 U.S. 668, 678 (1942).

These precedents certainly authorize reference to evidence extrinsic to a patent itself and a patent's prosecution history as aids to the court in properly understanding the art-skilled meaning of terms used in patent claims, thus facilitating proper judicial construction of patent claims.

A most explicit statement of the rule advocated here by amicus Wyatt was made in *Emerson v. Hogg*, 8 F. Cas. 628, 631 (C.C.S.D.N.Y. 1845)(Betts, Dist. J.) In granting a motion for new trial:²

The specification was objected to at the trial as ambiguous, and one of the particulars urged in support of the objection was, that it was uncertain, upon the face of the specification, whether the patentee claimed a wheel constructed spirally, or only spiral paddles attached to a wheel. The court did not dispose of the point as a question of construction merely, but left a fact to be found by the jury, and indicated the rule of law that would govern when that fact should be ascertained. This was undoubtedly error. It is the province and the duty of the court to settle the meaning of the patent, and if that cannot be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. Gods. Pat. 109, and Supp. 29; Phil. Pat. 249, 252. The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the court. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective

² That case was re-tried before a different judge (Nelson, Dist. J.) and jury in May 1847 and plaintiff-patentee again won a verdict. After judgment on that verdict, defendants Hogg et al appealed the case to this Court on writ of error. This Court affirmed, *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848) and 52 U.S.(11 How.) 587 (1850).

parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the court had been incorporated in the specification. It accordingly devolved upon the court to dispose of the question as a point of law, and either to decide that the patent was in this respect ambiguous, and therefore void, and direct the jury to find a verdict for the defendants, or to rule against the objection, and decide that the patent conveyed, in this particular, a meaning sufficiently certain, and point out what its claim was. *Washburn v. Gould*. [emphasis added].

The public need for certainty and national uniformity of the scope of patent claims and statutes -- both of which are applicable and may be enforced against any member of the public, be it individual, corporate or other group entity, or even the U.S. government itself -- far outweighs any private parties' desire to have either construed and defined by a randomly selected jury. In the case of a patent, once the patent claim has been construed, both patentee and accused infringer alike enjoy the Seventh Amendment right of a trial by jury on the factual question of whether the accused infringer's acts constitute infringement of the patentee's patent claim.

VI. PATENTEES AND ALL MEMBERS OF THE PUBLIC SHOULD HAVE ONE UNIVERSALLY APPLICABLE CONSTRUCTION OF A PATENT CLAIM.

A. The Public Notice Function of Patent Claims

Patents, like statutes, have important public notice functions. In *Schriber-Schroth Co. v. Cleveland Trust Co.* this court stated

... the requirement of the statute [is] that the patentee describe his invention so that others may construct and use it after the expiration of the patent and that it "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not," *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 [(1931)].

311 U.S. 211, 214-15 (1940). [bracketed matter added]

In *General Electric Co. v. Wabash Appliance Corp.* this Court stated

... Congress requires of the applicant "a distinct and specific statement of what he claims to be new, and to be his invention." Patents, whether basic or for improvement, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the

encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." The claims "measure the invention."

304 U.S. 364, 369 (1938)(footnotes omitted). See also *Permutit v. Graver Corp.*, 284 U.S. 52, 60 (1931) and *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434-35 (1822).

B. While Courts May Consult Extrinsic Evidence in Construing Patent Claims, Such Construction Should, if Possible, Be Based On The Publicly Available Patent and Prosecution History.

If a patentee has complied with the statute, 35 USC § 112, ¶ 2, and the public policies articulated in the above-quoted opinions of this Court, then the public (certainly at least the art-skilled public) should be readily able to understand the meaning of terms in patent claims, and in most instances do so from the face of a patent and its prosecution history. Like claim construction, the question of whether or not a claim complies with the requirements of § 112, ¶ 2, is a matter of law to be decided by courts, not by juries. *Lowell v. Lewis*, 15 F. Cas. at 1020; *Carver v. Braintree*, 5 F. Cas. 235, 240 (C.C.D. Mass. 1843)(Story, Circuit Justice); and *Emerson v. Hogg*, 8 F. Cas. at 631.

As explained earlier in this brief, it sometimes may be necessary for courts to refer to evidence extrinsic to the documentary administrative record to confirm the art-skilled definition of certain terms used by an inventor in patent claims. In so doing courts are merely being aided in learning what the art-skilled public already understands from the documentary administrative record. Such inquiries are consistent with the court's duty to decide questions about a patent claim's compliance with § 112, ¶ 2, as a matter of law.

This Court has long held the practices of constructing patent claims in view of the specification, drawings and prosecution history as mandatory. *Schreiber-Schroth*, 311 U.S. at 217, 220-21. And quite early this Court held that construction of patent claims was the exclusive province of the courts - not juries. *Bates v. Coe*, 98 U.S. at 38-39. And this Court has encouraged courts to use the assistance of the testimony of expert witnesses in ascertaining the true meaning of technical terms or terms of art appearing in patent claims. *Seymour v. Osborne*, 78 U.S. (22 Wall.) at 546. In all of these efforts to accurately construe patent claims, courts are making essentially the same inquiry. So long as a court's search is limited to seeking the art-skilled meaning of a term used by an inventor in a patent claim, without changing the meaning that is apparent from the patent and its prosecution history, such inquiries are of the same nature as resorting to the patent itself and its publicly available prosecution history.

VII. PATENT CLAIM CONSTRUCTION BY COURTS, NOT JURIES, IS NOT ONLY NECESSARY FOR NATIONALLY UNIFORM PATENT SCOPE, BUT CAN HELP STREAMLINE PATENT JURY TRIALS.

For the reasons explained above in this brief, the rule adopted by the Federal Circuit *en banc* in *Markman*, and advocated here by amicus Wyatt, is not only legally sound, but is also logical, practical, and can help streamline patent jury trials which now consume a substantial portion of the time of our federal courts.

In *Blonder-Tongue Lab. v. University of Illinois Found.*, 402 U.S. 313, 336 n.30 (1971), the Supreme Court noted that in the three year period spanning 1968-1970, only 13 of 382 patent cases going to trial were jury trials. More than half such suits, however, are now tried to juries.¹

¹ In the fiscal years 1992-1994, 163 of 274 patent trials were tried to a jury. In fiscal year 1994, 70% of patent trials were tried to juries. 1994 Preliminary Annual Report of the Directory of Administrative Office of the United States Courts, Table C-4 (available from the Administrative Office's Statistics Division); Annual Report of the Directory of the Administrative Office of the United States Courts (temp. Ed. 1993), Table C-4; Annual Report of the Director of the Administrative Office of the United States Courts, Table C-4 (1992).

In re Lockwood, 50 F.3d 966, 980 (Fed. Cir. 1995)(Nies, Cir.

J., dissenting).

Determination of patent claim construction exclusively by courts assures that claim construction will be decided by an authority that will make that claim construction uniformly nationally applicable. Where claim construction is decided by juries, it is often difficult to determine from a general jury verdict, or a jury verdict that includes answers to a few special interrogatories, the specific claim construction accorded a patent claim by a given jury. Thus, it is difficult for the public to know in future cases just what claim construction was adopted by a jury in an earlier case. Conversely, where claim construction is decided by a judge, that claim construction can be explained in a written opinion, which can then be followed, and indeed should be followed under applicable doctrines of collateral estoppel and *stare decisis*.

The parties in any civil action involving a particular patent will bring to the attention of the court any dispute concerning the meaning of a term in a patent claim or construction of the patent claim as a whole, as well as any extrinsic evidence that may relate to any such alleged dispute. But ultimately it is the court, in not only exercising its duty under the *Markman* rule, but also in efficiently administering justice in each case on that court's docket, who will decide when and how the question of patent claim construction should be determined in the case. Depending upon the way in which any disputed claim construction is raised by the parties, the court may decide the question of claim construction as early as reasonably practical during the course of a civil action. For example, the matter of claim construction may be taken up as early as pre-trial scheduling conferences, or otherwise decided on motion for partial summary judgment, in a final pre-trial order, in jury

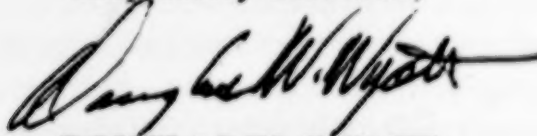
instructions, in a directed verdict, or (hopefully rarely) even after jury verdict by decision on judgment as a matter of law (JMOL). In any given case, it will ultimately be left to the discretion of the trial judge to decide when and how claim construction can best be decided to facilitate efficient handling of the case.

Once claim construction is decided by the court, that construction can readily be used by the parties in tailoring further discovery and trial preparation, and by the jury in more readily deciding the question of patent infringement. All of these advantages of the application of the *Markman* rule provide practical reasons why this legally proper rule should be uniformly followed by our Federal Courts in all patent cases.

CONCLUSION

For all of the foregoing reasons, amicus Wyatt respectfully requests that this Court affirm the Federal Circuit's *en banc* decision in *Markman*, and affirm the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Douglas W. Wyatt", with a long horizontal flourish extending to the right.

DOUGLAS W. WYATT
WYATT, GERBER, BURKE & BADIE, L.L.P.
99 Park Avenue
New York, N.Y. 10016
(212) 681-0800
Counsel of Record

PAUL M. JANICKE
JOHN R. KIRK, JR.
THOMAS E. SMITH
FREDERICK J. DORCHAK
Attorneys for Amicus Curiae

December 8, 1995

DEC 8 1995

No. 95-26

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN, *et al.*,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC., *et al.*,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF AMICUS CURIAE OF
UNITED STATES SURGICAL CORPORATION
IN SUPPORT OF RESPONDENTS**

Of Counsel:

ARTHUR R. MILLER
1545 Massachusetts Avenue
Cambridge, Mass. 02138
(617) 495-4111

THOMAS R. BREMER
Senior Vice President
and General Counsel

JOHN C. ANDRES
Chief Patent Counsel
United States Surgical
Corporation
150 Glover Avenue
Norwalk, Conn. 06856
(203) 845-1000

* Counsel of Record

JOHN G. KESTER *
J. ALAN GALBRAITH
WILLIAM E. MCDANIELS
WILLIAMS & CONNOLLY
725 12th Street, N.W.
Washington, D.C. 20005
(202) 434-5000
Attorneys for Amicus Curiae

44 PP

QUESTION PRESENTED

"[T]he specific question at issue here [is] whether judges or juries should interpret patents." Pet. Br. at 30.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
TABLE OF AUTHORITIES	v
INTEREST OF THE <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT	1
ARGUMENT	2
I. FOR A CENTURY AND A HALF THIS COURT REPEATEDLY HAS HELD THAT PATENT CLAIM CONSTRUCTION IS FOR THE COURT	2
A. This Court's Decisions Are Clear	2
B. Assistance of Experts Does Not Alter the Court's Role	7
II. TRIAL BY JURY CONTEMPLATES A DIVISION OF FUNCTIONS BETWEEN JUDGE AND JURY	9
A. The Seventh Amendment Does Not Assign All Rulings Involving Factual Issues to the Jury	9
B. Judges, Not Juries, Construe Official Grants and Directives	14
1. Public Laws	14
2. Private Laws	15
3. Patents for Land	15
4. Copyrights	16
5. Corporate Charters	17
6. Federal Regulations	17
7. Foreign Law	17
8. Consent Orders	18

TABLE OF CONTENTS—Continued

	Page
9. Collateral Estoppel	18
10. Private Agreements Distinguished	18
C. Standard of Appellate Review Is a Separate Question	20
III. HISTORY DOES NOT SUPPORT PETITIONERS' POSITION	22
A. Juries Did Not Construe the Scope of Royal Patents in 1791	22
B. United States Patent Law Requires Clarity and Predictability of Patent Claims	25
IV. CONSTITUTIONAL POLICY REQUIRES PATENT CERTAINTY	27
A. Patents Are Constitutionally Limited	27
B. Certainty Is Required in Patent Claims.....	28
CONCLUSION	30

TABLE OF AUTHORITIES

Cases:	Page
<i>Albemarle Paper Co. v. Moody</i> , 422 U.S. 405 (1975)	6
<i>Ames v. Howard</i> , 1 Fed. Cas. 755 (C.C.D. Mass. 1833) (No. 326)	5
<i>Arkansas Valley Land & Cattle Co. v. Mann</i> , 130 U.S. 69 (1889)	11
<i>Arkwright v. Nightingale</i> , Dav. Pat. Cas.* 37 (C.P. 1785)	23
<i>Atlas Roofing Co. v. OSHA</i> , 430 U.S. 442 (1977)	9
<i>Bailey v. United States</i> , No. 94-7448 (Dec. 6, 1995)	15
<i>Baltimore & Carolina Line, Inc. v. Redman</i> , 295 U.S. 654 (1935)	14
<i>Barrett v. Hall</i> , 2 Fed. Cas. 914 (C.C.D. Mass. 1818) (No. 1,047)	5
<i>Barron v. Baltimore</i> , 7 Pet. 243 (1833)	4
<i>Bischoff v. Wethered</i> , 9 Wall. 812 (1870)	13
<i>Blake v. Stafford</i> , 3 Fed. Cas. 610 (C.C.D. Conn. 1868) (No. 1,504)	26
<i>Blanchard v. Sprague</i> , 3 Fed. Cas. 648 (C.C.D. Mass. 1839) (No. 1,518)	5
<i>Blonder-Tongue Labs., Inc. v. University of Illinois Foundation</i> , 402 U.S. 313 (1971)	18, 29
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989)	19, 27, 28, 30
<i>Bose Corp. v. Consumers Union of the United States, Inc.</i> , 466 U.S. 485 (1984)	11
<i>Boulton v. Bull</i> , 2 H. Bl. 463, 126 Eng. Rep. 651 (C.P. 1790)	22, 23
<i>Bovill v. Moore</i> , Dav. Pat. Cas. 361, 17 Rev. Rep. 514 (C.P. 1816)	24
<i>Brown v. Huger</i> , 21 How. 395 (1859)	15
<i>Burlington N.R.R. v. Oklahoma Tax Comm'n</i> , 481 U.S. 454 (1987)	20
<i>Capital Traction Co. v. Hof</i> , 174 U.S. 1 (1899)	9
<i>Carnegie Steel Co. v. Cambria Iron Co.</i> , 185 U.S. 403 (1902)	27
<i>Catalin Corp. v. Catalazuli Mfg. Co.</i> , 79 F.2d 593 (2d Cir. 1935)	4

* J. DAVIES, A COLLECTION OF THE MOST IMPORTANT CASES RESPECTING PATENTS OF INVENTION (1816).

TABLE OF AUTHORITIES—Continued

	Page
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986)	11
<i>Chauffeurs Local No. 391 v. Terry</i> , 494 U.S. 558 (1990)	25
<i>Colgrove v. Battin</i> , 413 U.S. 149 (1973)	9, 12
<i>Continental Paper Bag Co. v. Eastern Paper Bag Co.</i> , 210 U.S. 405 (1908)	26
<i>Corning v. Burden</i> , 15 How. 252 (1854)	19
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	4, 5
<i>Curtis v. Loether</i> , 415 U.S. 189 (1974)	7, 10
<i>Daubert v. Merrell Dow Pharmaceuticals, Inc.</i> , 113 S. Ct. 2786 (1993)	7, 10
<i>Davis v. Palmer</i> , 7 Fed. Cas. 154 (C.C.D. Va. 1827) (No. 3,645)	3
<i>Dennison Mfg. Co. v. Panduit Corp.</i> , 475 U.S. 809 (1986)	21
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981)	20
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	11, 12
<i>Dixon v. Moyer</i> , 7 Fed. Cas. 758 (C.C.D. Pa. 1821) (No. 3,931)	29
<i>Driggins v. Oklahoma City</i> , 954 F.2d 1511 (10th Cir.), cert. denied, 113 S. Ct. 129 (1992)	17
<i>Eddy v. Prudence Bonds Corp.</i> , 165 F.2d 157 (2d Cir. 1947), cert. denied sub nom. <i>Prudence Realization Corp. v. Eddy</i> , 333 U.S. 845 (1948)	20
<i>Evans v. Eaton</i> , 3 Wheat. 454 (1818)	3, 15
<i>Evans v. Eaton</i> , 8 Fed. Cas. 856 (C.C.D. Pa. 1818) (No. 4,560), aff'd, 7 Wheat. 356 (1822)	29
<i>Evans v. Hettick</i> , 8 Fed. Cas. 861 (C.C.E.D. Pa. 1818) (No. 4,562), aff'd, 7 Wheat. 453 (1822)	29
<i>Feist Pubs., Inc. v. Rural Tel. Serv. Co.</i> , 499 U.S. 340 (1991)	16, 27
<i>Fertilizing Co. v. Hyde Park</i> , 97 U.S. 659 (1878)	17
<i>Fidelity & Deposit Co. v. United States</i> , 187 U.S. 315 (1902)	12
<i>The Fire-Extinguisher Case</i> , 21 Fed. 40, 42 (C.C.D. Md. 1884)	15
<i>First Options of Chicago, Inc. v. Kaplan</i> , 115 S. Ct. 1920 (1995)	21
<i>Fiske v. Kansas</i> , 274 U.S. 300 (1927)	11
<i>Fox Film Corp. v. Doyal</i> , 286 U.S. 123 (1932)	27

TABLE OF AUTHORITIES—Continued

	Page
<i>Galloway v. United States</i> , 319 U.S. 372 (1943)	11, 12, 13, 25, 30
<i>Gasoline Prods. Co. v. Champlin Ref. Co.</i> , 283 U.S. 494 (1931)	11, 12
<i>Gates Rubber Co. v. Bando Chem. Industries, Ltd.</i> , 9 F.3d 823 (10th Cir. 1993)	16
<i>General Elec. Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938)	21, 26
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	18
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	28
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	28
<i>Gray v. James</i> , 10 Fed. Cas. 1015 (C.C.D. Pa. 1817) (No. 5,718)	3
<i>Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.</i> , 340 U.S. 147 (1950)	28
<i>Great N. Ry. v. United States</i> , 315 U.S. 262 (1942)	15
<i>Gunning v. Cooley</i> , 281 U.S. 90 (1930)	13
<i>Harper & Row, Publishers, Inc. v. Nation Enterprises</i> , 471 U.S. 539 (1985)	16
<i>Harper House, Inc. v. Thomas Nelson, Inc.</i> , 889 F.2d 197 (9th Cir. 1989)	17
<i>Harries v. Air King Prods. Co.</i> , 183 F.2d 158 (2d Cir. 1950)	21
<i>Harte-Hanks Communications, Inc. v. Connaughton</i> , 491 U.S. 657 (1989)	21
<i>Haworth v. Hardcastle</i> , Web. Pat. Cas.* 480 (1834)	24
<i>Heald v. Rice</i> , 104 U.S. 737 (1882)	13
<i>Hepner v. United States</i> , 213 U.S. 103 (1909)	11
<i>Hogg v. Emerson</i> , 6 How. 437 (1848)	20, 26
<i>Hornblower v. Boulton</i> , 8 T.R. 95, 101 Eng. Rep. 1285 (K.B. 1799)	23
<i>Huddart v. Grimshaw</i> , Dav. Pat. Cas. 265 (K.B. 1803)	23

* T. WEBSTER, REPORTS AND NOTES OF CASES ON LETTERS PATENT FOR INVENTIONS (1844).

TABLE OF AUTHORITIES—Continued

	Page
<i>Hurley v. Irish-American Gay, Lesbian & Bisexual Group</i> , 115 S. Ct. 2338 (1995)	10
<i>Improvement Co. v. Munson</i> , 14 Wall. 442 (1872) ..	13
<i>In re Japanese Electronic Prods. Antitrust Litigation</i> , 723 F.2d 238 (3d Cir. 1983), reversed sub nom. <i>Matsushita Elec. Indus. Co. v. Zenith Radio Corp.</i> , 475 U.S. 574 (1986)	10
<i>Keene Corp. v. United States</i> , 113 S. Ct. 2035 (1993)	6
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	4, 19
<i>Kneass v. Schuylkill Bank</i> , 14 Fed. Cas. 746 (C.C. Pa. 1820) (No. 7,875)	3
<i>Levy Gadsby</i> , 3 Cranch 180 (1805)	19
<i>Liardet v. Johnson</i> , (n.p. 1778)	23
<i>In re Lockwood</i> , 50 F.3d 966 (Fed. Cir.), vacated sub nom. <i>American Airlines, Inc. v. Lockwood</i> , 116 S. Ct. 29 (1995)	27, 29
<i>London v. Carson Pirie Scott & Co.</i> , 946 F.2d 1534 (Fed. Cir. 1991)	29
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1882)	8
<i>Lorillard v. Pons</i> , 434 U.S. 575 (1978)	6
<i>In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation</i> , 831 F. Supp. 1354 (N.D. Ill. 1993)	8
<i>Market Street Cable Ry. v. Rowley</i> , 155 U.S. 621 (1895)	13
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891)	4
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1877)	28
<i>Miller v. Fenton</i> , 474 U.S. 104 (1985)	21
<i>Mitchell v. Tilghman</i> , 19 Wall. 287 (1874)	19
<i>Motion Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	18
<i>Mountain Timber Co. v. Washington</i> , 243 U.S. 219 (1917)	28
<i>Neilson v. Harford</i> , 8 M. & W. 806, 151 Eng. Rep. 1266, Web. Pat. Cas. 331 (Exch. 1841)	24, 25, 30
<i>New York Times Co. v. Sullivan</i> , 376 U.S. 254 (1964)	21

TABLE OF AUTHORITIES—Continued

	Page
<i>Nippon Kogaku (USA), Inc. v. United States</i> , 673 F.2d 380 (C.C.P.A. 1982)	17
<i>NLRB v. Town & Country Electric, Inc.</i> , 64 U.S.L.W. 4022 (U.S. Nov. 28, 1995)	15
<i>North American Vaccine, Inc. v. American Cyanamid Co.</i> , 7 F.3d 1571 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1645 (1994)	7
<i>O'Reilly v. Morse</i> , 15 How. 62 (1853)	2
<i>In re Paoli R.R. Yard PCB Litigation</i> , 35 F.3d 717 (3d Cir. 1994), cert. denied sub nom. <i>General Elec. Co. v. Ingram</i> , 115 S. Ct. 1253 (1995)	10
<i>Parker v. Hulme</i> , 18 Fed. Cas. 1138 (C.C.E.D. Pa. 1849) (No. 10,740)	4, 21
<i>Parklane Hosiery Co. v. Shore</i> , 439 U.S. 322 (1979)	12, 18
<i>Patlex Corp. v. Mossinghoff</i> , 758 F.2d 594, rehearing denied, 771 F.2d 480 (Fed. Cir. 1985)	17
<i>Pennock v. Dialogue</i> , 19 Fed. Cas. 171 (C.C.E.D. Pa. 1825) (No. 10,941), aff'd, 2 Pet. 1 (1829)	3
<i>Ex parte Peterson</i> , 253 U.S. 300 (1920)	11, 12
<i>Pettibone v. Derringer</i> , 19 Fed. Cas. 387 (C.C.D. Pa. 1818) (No. 11,043)	3
<i>Proprietors of Charles River Bridge v. Proprietors of Warren Bridge</i> , 11 Pet. 420 (1837)	17
<i>Prouty v. Draper</i> , 20 Fed. Cas. 11 (C.C.D. Mass. 1841), aff'd, 16 Pet. 336 (1842)	5
<i>Read Corp. v. Portec, Inc.</i> , 970 F.2d 816 (Fed. Cir. 1992)	5
<i>Reed v. Proprietors of Locks</i> , 8 How. 274 (1850) ..	16
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970)	9
<i>Rubber Co. v. Goodyear</i> , 9 Wall. 788 (1870)	4
<i>Rubin v. United States</i> , 449 U.S. 424 (1981)	20
<i>Russell v. Cowley</i> , Web. Pat. Cas. 457 (Exch. 1834)	24
<i>Ryan v. Goodwin</i> , 21 Fed. Cas. 110 (C.C.D. Mass. 1839) (No. 12,186)	5
<i>Salve Regina College v. Russell</i> , 499 U.S. 225 (1991)	21
<i>Shelly v. Kraemer</i> , 334 U.S. 1 (1948)	20
<i>Silsky v. Foote</i> , 14 How. 218 (1852)	3

TABLE OF AUTHORITIES—Continued

	Page
<i>Smith v. Snow</i> , 294 U.S. 1 (1935)	4, 20
<i>Spring Co. v. Edgar</i> , 99 U.S. 645 (1879)	10
<i>Stillwell & Bierce Mfg. Co. v. Phelps</i> , 130 U.S. 520 (1889)	10
<i>Stone v. Sprague</i> , 23 Fed. Cas. 161 (C.C.D.R.I. 1840) (No. 13,487)	5
<i>Trustees of Dartmouth College v. Woodward</i> , 4 Wheat. 518 (1819)	17
<i>Tucker v. Spalding</i> , 13 Wall. 453 (1872)	13
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	12
<i>Turner v. Winter</i> , 1 T.R. 602, 1 Rev. Rep. 311 (K.B. 1787)	23
<i>United Carbon Co. v. Binney & Smith Co.</i> , 317 U.S. 228 (1942)	4, 20
<i>United States v. American Bell Tel. Co.</i> , 128 U.S. 315 (1888)	15
<i>United States v. Boeing Co.</i> , 802 F.2d 1390 (Fed. Cir. 1986)	17
<i>United States v. Gaudin</i> , 115 S. Ct. 2310 (1995) ..	25
<i>United States v. J.B. Williams Co.</i> , 498 F.2d 414 (2d Cir. 1974)	18
<i>United States v. Mitchell</i> , 985 F.2d 1275 (4th Cir. 1993)	18
<i>United States v. Reader's Digest Ass'n</i> , 662 F.2d 955 (3d Cir. 1981), <i>cert. denied</i> , 455 U.S. 908 (1982)	18
<i>United States v. Turner</i> , 11 How. 663 (1850)	30
<i>United States v. Weitzenhoff</i> , 1 F.3d 1523 (9th Cir. 1993), <i>amended</i> , 35 F.3d 1275 (9th Cir. 1994), <i>cert. denied sub nom. Mariani v. United States</i> , 115 S. Ct. 939 (1995)	17
<i>United States Surgical Corp. v. Ethicon, Inc.</i> , No. 94-2081	1, 30
<i>Walker v. New Mexico & S.P.R.R.</i> , 165 U.S. 593 (1897)	11, 14
<i>Washburn v. Gould</i> , 29 Fed. Cas. 312 (C.C.D. Mass. 1844) (No. 17,214)	5
<i>Wheaton v. Peters</i> , 8 Pet. 591 (1834)	14
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	27

TABLE OF AUTHORITIES—Continued

	Page
<i>Whittemore v. Cutter</i> , 29 Fed. Cas. 1120 (C.C.D. Mass. 1813) (No. 17,600)	5
<i>Wickwire v. Reinecke</i> , 275 U.S. 101 (1927)	28
<i>Williams Mfg. Co. v. United Shoe Machinery Corp.</i> , 316 U.S. 364 (1942)	4
<i>Winans v. Denmead</i> , 15 How. 330 (1854)	1, 2, 3, 5, 7, 26
<i>Winans v. New York & E.R.R.</i> , 21 How. 88 (1859)	7
<i>Constitutional Provisions:</i>	
U.S. Constitution, Article I	28
Article I, § 8	25, 30
Article III	28
Seventh Amendment	2, <i>passim</i>
<i>Statutes:</i>	
35 U.S.C. § 112	27
Act of April 10, 1790, ch. 7, § 2, 1 Stat. 109, 110....	25, 26
Act of Feb. 21, 1793, ch. 11, § 3, 1 Stat. 318, 321....	26
Act of Jan. 21, 1808, ch. 13, 6 Stat. 70	15
Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119....	19, 26
Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201..	26
<i>Rules:</i>	
Federal Rules of Civil Procedure, Rule 12	13
Rule 23	10
Rule 44.1	18
Rule 52	21
Federal Rules of Criminal Procedure, Rule 26.1..	18
Federal Rules of Evidence, Rule 102	12
Rule 104	10
Rule 201	10
Rule 403	10
Rule 701	7
Rule 702	7, 10
Rule 703	7
Rule 1008	10
<i>Miscellaneous:</i>	
Adams & Averly, <i>The Patent Specification: The Role of Liardet v Johnson</i> , 7 J. LEGAL HIST. 156 (1986)	22, 23

TABLE OF AUTHORITIES—Continued

	Page
F. BULLER, AN INTRODUCTION TO THE LAW RELATIVE TO TRIALS AT NISI PRIUS (7th ed. 1817)	23
W. CARPMAEL, LAW REPORTS OF PATENT CASES (1843)	25
G. CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS IN THE UNITED STATES OF AMERICA (2d ed. 1854)	6
J. DAVIES, A COLLECTION OF THE MOST IMPORTANT CASES RESPECTING PATENTS OF INVENTION (1816)	v, <i>passim</i>
H. DUTTON, THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION 1750-1852 (1984)	22
W. FLETCHER, CYCLOPEDIA OF PRIVATE CORPORATIONS (Keating & Nelson rev. ed. 1989)	17
S. GREENLEAF, A TREATISE ON THE LAW OF EVIDENCE (3d ed. 1846)	20
H.R. Rep. No. 97-312, 97th Cong., 1st Sess. (1981) ..	30
W. HANDS, LAW AND PRACTICE OF PATENTS FOR INVENTIONS (1808)	14
Henderson, <i>The Background of the Seventh Amendment</i> , 80 HARV. L. REV. 289 (1966)	25
Hulme, <i>On the History of Patent Law in the Seventeenth and Eighteenth Centuries</i> , 18 LAW Q. REV. 280 (1902)	23
C. MACLEOD, INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM, 1660-1800 (1988)	22
A MEMOIR OF BENJAMIN ROBBINS CURTIS, LL.D. (B. Curtis ed. 1879)	2
Miller, <i>Federal Rule 44.1 and the "Fact" Approach to Determining Foreign Law</i> , 65 MICH. L. REV. 613 (1967)	18
J. OLDHAM, THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY (1992)	23
Rifkind, <i>The Romance Discoverable in Patent Cases</i> , 16 F.R.D. 253 (1954)	20
W. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS (1890)	4, 6, 8, 13

TABLE OF AUTHORITIES—Continued

	Page
Schneider, <i>Claims to Fame</i> , 71 J. PAT. & T. OFF. SOC'Y 143 (1989)	26
Scott, <i>Trial by Jury and the Reform of Civil Procedure</i> , 31 HARV. L. REV. 669 (1918)	12
B. STEDMAN, PATENTS (1939)	6
Story, <i>On the Patent Laws</i> , 3 Wheat. app. 13 (1818) (F. Brightly ed. 1904)	6
SUTHERLAND STATUTORY CONSTRUCTION (N. Singer rev. ed. 1992)	14
TERRELL ON THE LAW OF PATENTS (W. Aldous, et al., 13th ed. 1982)	25
J. THAYER, A PRELIMINARY TREATISE ON EVIDENCE AT THE COMMON LAW (1898)	9
A. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA (1887)	6, 8
A. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA (4th ed. 1904) ..	5
Walterscheid, <i>The Early Evolution of the United States Patent Law: Antecedents</i> , 77 J. PAT. & T. OFF. SOC'Y 771 (1995)	22
T. WEBSTER, REPORTS AND NOTES OF CASES ON LETTERS PATENT FOR INVENTIONS (1844)	vii, <i>passim</i>
WEBSTER'S NEW WORLD DICTIONARY (V. Neufeldt ed. 1990)	1
9 J. WIGMORE, EVIDENCE (J. Chadbourn rev. ed. 1981)	9, 10, 18

INTEREST OF THE AMICUS

Amicus, a manufacturer of surgical equipment, was plaintiff in a patent infringement suit in which the trial court submitted the issue of claim construction for the jury to decide with the aid of a copy of *Webster's New World Dictionary* in the jury room. *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081 (petition for certiorari pending).¹

SUMMARY OF ARGUMENT

Petitioners seek a massive overruling. They are asking this Court not just to reverse a decision of eight judges of the full bench of the Federal Circuit, but also to disapprove an unbroken line of this Court's own cases that reaches back before the Civil War. Those decisions have been firmly established, have worked well, and have been reaffirmed often for over a century. Repeatedly this Court has held, and lower courts and treatise writers for over a century have recognized, that construction of patent claims is an issue of law to be decided by the court. *E.g.*, *Winans v. Denmead*, 15 How. 330 (1854).

There is no dispute in this case that jury trial is available in patent-infringement actions. All parties agree that it is. The issue instead concerns allocation of functions in a jury trial. Although petitioners state "the specific question at issue here" as "whether judges or juries should interpret patents," Pet. Br. 30, they also say that "[w]here the terms themselves are clear without resorting to extrinsic evidence, there is simply no genuine interpretive dispute for the jury to decide." *Id.* at 35; see also Litton Br. 10. *Amicus* Exxon acknowledges that "courts have traditionally viewed claim construction as raising, in an overall sense, a legal question . . . claim construction is ultimately a question of law." Exxon Br. 3, 10.

However, petitioners say, if the judge for help in understanding terminology of the claim consults sources extrinsic to the patent document itself—in particular, if the

¹ Petitioners and respondents have consented to the filing of this brief; their letters to that effect have been lodged with the Clerk.

judge hears expert testimony—then the construction of the claim is transformed into an issue that the jury, not the judge, is required by the Seventh Amendment to decide.

Petitioners assert that the decision under review here “uprooted the landscape.” Pet. Br. 14. Quite the opposite. And the constitutionally grounded need for certainty and understandable limits on patent claims—which many cases recognize never could be maintained if claims were construed by varying juries—confirms the soundness of a century and a half of this Court’s holdings.

ARGUMENT

I. FOR A CENTURY AND A HALF, THIS COURT REPEATEDLY HAS HELD THAT PATENT CLAIM CONSTRUCTION IS FOR THE COURT.

A. This Court’s Decisions Are Clear.

It would be difficult to imagine a more clear-cut statement of the allocation of responsibilities in a patent-infringement case than what this Court through Justice Curtis held in 1854 in *Winans v. Denmead*, 15 How. 330:

“On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants.

“*The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them.* The second is a question of fact, to be submitted to a jury.”

15 How. at 338 (emphasis supplied).²

² Justice Curtis had been a practitioner of patent law. His brother, the author of the leading treatise on the subject, wrote that Justice Curtis at law school was “among the studious young men of talent who first gathered about Judge Story,” and “[t]he practice on which he entered in Boston . . . made him familiar with the patent law, for which his mental characteristics gave him a singular adaptation.” 1 A. MEMOIR OF BENJAMIN ROBBINS CURTIS, LL.D. v. 42-43, 84 (B. Curtis ed. 1879); cf. *O’Reilly v. Morse*, 15 How. 62, 63 (1853) (Justice Curtis, “having been of counsel, did not sit” in case involving patent on the telegraph).

The rule recognized so plainly in *Winans v. Denmead* had been previously announced on several occasions, going all the way back to judges who lived in the time of the adoption of the Seventh Amendment. In *Davis v. Palmer*, 7 Fed. Cas. 154 (C.C.D. Va. 1827) (No. 3,645), Chief Justice Marshall rejected the contention that the jury should construe a patent:

“Will it be said that it may be left to the jury to determine, what is ‘about’ the proportion particularly designated? This expedient will not remove the difficulty. We doubt how far it may consist with the principle that the court is to construe every written instrument. But, waiving this doubt, if the word has any limits, they must always be the same.”

7 Fed. Cas. at 158. This Court itself construed the scope of patent grants at least as early as *Evans v. Eaton*, 3 Wheat. 454, 512-15 (1818).³

In *Silsby v. Foote*, 14 How. 218 (1852), decided two years before *Winans v. Denmead* and also written by Justice Curtis, this Court had affirmed that “[t]he construction of the [patent] claim was undoubtedly for the court.” 14 How. at 225. The jury, in contrast, would decide whether particular parts challenged as infringing actually came within the definition given to the jury by the court. “[T]o this extent, not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.” 14 How. at 226. Thus before the turn of this century this Court summarized:

“The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol. 3, page 378, as follows: ‘Where the defence denies that the invention used by the defendant is identical with that

³ For other early examples in which judges construed patents, often in jury charges, all by Justice Washington, see, e.g., *Pennock v. Dialogue*, 19 Fed. Cas. 171, 173 (C.C.E.D. Pa. 1825) (No. 10,941), *aff’d*, 2 Pet. 1 (1829); *Kneass v. Schuylkill Bank*, 14 Fed. Cas. 746, 748 (C.C. Pa. 1820) (No. 7,875); *Pettibone v. Derringer*, 19 Fed. Cas. 387, 389 (C.C.D. Pa. 1818) (No. 11,043); *Gray v. James*, 10 Fed. Cas. 1015, 1017 (C.C.D. Pa. 1817) (No. 5,718). See also n. 5, *infra*.

included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.' "

Coupe v. Royer, 155 U.S. 565, 579 (1895), quoting 3 W. ROBINSON, PATENTS 378 (1890). For examples of this Court itself construing patent claims, see, e.g., *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 237 (1942); *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 368 (1942); *Smith v. Snow*, 294 U.S. 1, 7 (1935) ("The question presented here is what scope may rightly be given to Claim 1 of the patent"); *McClain v. Ortmyer*, 141 U.S. 419, 423-25 (1891); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 275 (1877); *Rubber Co. v. Goodyear*, 9 Wall. 788, 796 (1870).

Petitioners propose that this Court's constant reaffirmations that claim construction is a matter of law should all be reinterpreted as in effect summary-judgment resolutions, simply because in some instances this Court remarked that the interpretation of the claim was not difficult. Pet. Br. 34.⁴ That was not the understanding at all. *Parker v. Hulme*, 18 Fed. Cas. 1138, 1140 (C.C.E.D. Pa. 1849) (No. 10,740), a leading case, summarized:

"The specification, being an instrument of writing, and the words of which it is made up having a fixed and plain import, its interpretation is a matter exclusively for the court, who must explain it. This part of the case is not for the jury, who, for the purposes of this cause, will adopt and act upon the interpretation given to it by the court. There is great reason and importance for this distribution of

⁴ Such judicial comments are not uncommon in many contexts. E.g., *Barron v. Baltimore*, 7 Pet. 243, 247-48 (1833) ("The question thus presented is, we think, of great importance, but not of much difficulty"); *Catalin Corp. v. Catalazuli Mfg. Co.*, 79 F.2d 593, 597 (2d Cir. 1935) (L. Hand, J.) ("The defendant's fanciful interpretation has no support in the specifications and contradicts their natural implication").

the respective duties of the court and the jury. The import of the instrument is purely a question of law."⁵

The "doctrine of the cases" referred to in *Coupe v. Royer* has been followed countless times throughout the Twentieth Century. See, e.g., *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992) (noting that *Winans v. Denmead* "mandates" that court construe patent claims). A few recent deviant decisions, which confused the jury's role in deciding infringement with the judge's in construing claims, were disapproved by the *en banc* court here.

Moreover, the Seventh Amendment looks to what courts, attorneys and scholars understood the law to be; not whether with retrospective ingenuity petitioners can find ways to recharacterize long-established holdings as dicta. The leading early treatise, by Justice Curtis'

⁵ Petitioners and the dissent misunderstand *Washburn v. Gould*, 29 Fed. Cas. 312 (C.C.D. Mass. 1844) (No. 17,214). That opinion referred to a then-recent English opinion on juries construing terms of art to determine whether a specification was adequate, see pp. 24-25, *infra*; in the sentences that immediately follow the portion quoted at P.C.A. 105a and Pet. Br. 27, Justice Story explained:

"But I do not proceed upon this ground. The court did explicitly give to the jury its construction of the patent in the present case . . ."

29 Fed. Cas. at 325. The jury based on the instruction would decide, he said, what parts were novel. *Id.* For other examples in which Justice Story construed patents as a matter of law, see *Prouty v. Draper*, 20 Fed. Cas. 11, 12 (C.C.D. Mass. 1841) (No. 11,446), *aff'd*, 16 Pet. 336 (1842); *Stone v. Sprague*, 23 Fed. Cas. 161 (C.C.D.R.I. 1840) (No. 13,487); *Blanchard v. Sprague*, 3 Fed. Cas. 648, 650 (C.C.D. Mass. 1839) (No. 1,518); *Ryan v. Goodwin*, 21 Fed. Cas. 110, 112 (C.C.D. Mass. 1839) (No. 12,186); *Ames v. Howard*, 1 Fed. Cas. 755, 756-57 (C.C.D. Mass. 1833) (No. 326); *Barrett v. Hall*, 2 Fed. Cas. 914, 925 (C.C.D. Mass. 1818) (No. 1,047); *Whittemore v. Cutter*, 29 Fed. Cas. 1120, 1123 (C.C.D. Mass. 1813) (No. 17,600). Cf. A. WALKER, TEXT-BOOK OF THE PATENT LAWS 417 (4th ed. 1904), cited at Litton Br. 17 n.26, which similarly refers "question[s] of the prior art" to the jury, but reiterates that "Questions of construction are questions of law for the judge, not questions of fact for the jury." *Id.* at 183.

brother, observed that the extent of a patent claim "is universally a question for the court." G. CURTIS, PATENTS 19 (2d ed. 1854); *accord*, A. WALKER, TEXT-BOOK OF THE PATENT LAWS 133 (1887) ("Questions of construction are questions of law for the judge, not questions of fact for the jury"). Professor William C. Robinson, after reviewing every available English and American patent decision up to 1882, concluded:

"The duty of interpreting letters-patent has been committed to the courts. A patent is a legal instrument, to be construed, like other legal instruments, according to its tenor. . . . Where technical terms are used . . . the testimony of witnesses may be received upon these subjects, and any other means of information be employed. But in the actual interpretation of the patent the court proceeds upon its own responsibility as an arbiter of the law, giving to the patent its true and final character and force."

2 W. ROBINSON, *supra*, at 481-83; see 1 *id.* at vi; ⁶ see also, e.g., B. STEDMAN, PATENTS 540 (1939) ("The court defines the patented invention as indicated by the language of the claims").⁷

⁶ See also Story, *On the Patent Laws*, 3 Wheat. app. 13, 18 (1818) ("the court will construe the terms of the patent and of the specification, in a liberal manner"). Professor Robinson in a passage incompletely quoted at Litton Br. 17 said that when a claim was challenged as invalid for ambiguity ("the fourteenth defence"), the court as a matter of "judicial discretion" might elect to refer fact issues outside the claim to a jury. 3 ROBINSON at 299-300. But "the court interprets the Claim so far as it is capable of an interpretation . . . the jury follow this interpretation." *Id.* at 377. The "instructions on this point control the jury." *Id.* at 378 n.13. Most importantly, when as here the issue is whether a defendant's device infringes a plaintiff's patent ("the eighteenth defence"), "the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant." *Id.* at 378.

⁷ That Congress several times reenacted the patent laws with this settled law so well established is of course persuasive as to what those laws intend. *Cf.*, e.g., *Keene Corp. v. United States*, 113 S. Ct. 2035, 2043 (1993); *Lorillard v. Pons*, 434 U.S. 575, 580 (1978); *Albemarle Paper Co. v. Moody*, 422 U.S. 405, 418 n.8 (1975).

B. Assistance of Experts Does Not Alter the Court's Role.

Faced with these decisions, petitioners urge that the recognized rule should not apply if the court interpreting a patent claim consults materials outside the language of the document itself. Pet. Br. 35. But that is a *non sequitur*. Judges often consult outside materials of all kinds and even hold evidentiary hearings in making legal rulings. That a court may inquire beyond the document in interpreting a patent, including opinions of experts ⁸ as to the understanding of terms in a particular art, does not convert an issue for the court into an issue for the jury.

With respect to patent claims, it developed that in some instances judges found it useful to consult experts as to the proper understanding of technical terminology. However, they were not obliged to do so. The leading case is *Winans v. New York & E.R.R.*, 21 How. 88 (1859), decided only five years after *Winans v. Denmead*. The trial court had rejected a proffer of expert testimony to show the meaning of the terms of the patent. This Court affirmed because

"There was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury.

"The testimony of experts which was rejected had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent."

⁸ The information that a court may consult to assist in construing terms of a patent claim may include expert opinion testimony. Testimony of patentees is held to be of little probative value. See, e.g., *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1577 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1645 (1994). Expert opinion testimony is a form of evidence particularly subject to judicial control, and trial judges have considerable discretion whether to allow it at all. See Fed. R. Evid. 701-703; *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993).

21 How. at 100. This Court went on to explain:

"Experts may be examined to explain terms of art, and the state of the art, at any given time. . . . [B]ut professors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence."

Id. at 100-01. A leading Nineteenth-Century treatise explained:

"As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases. The judges are not, however, obliged to blindly follow such testimony. They may disregard it if it appears to them to be unreasonable. While the testimony of experts relevant to the meaning of particular words or phrases in letters patent is to this extent admissible, such testimony is wholly inadmissible relevant to the construction of the letters patent as a whole."

A. WALKER, TEXT-BOOK OF THE PATENT LAWS 133-34 (1887) (footnotes omitted). See also 2 W. ROBINSON, *supra*, at 481; *Loom Co. v. Higgins*, 105 U.S. 580, 586 (1882) ("This evidence, of which the record in this case furnishes an abundance, being resorted to; we have no difficulty in comprehending the patent"). Courts continue to hear expert testimony when it is helpful to assist in construing technical language, while recognizing the distinction that "[i]nterpretation of language in patent claims is an issue of law . . . and the question whether a device literally infringes the claim as construed is one of fact." *In re Mahurkar Double Lumen*, 831 F. Supp. 1354, 1359 (N.D. Ill. 1993).

II. TRIAL BY JURY CONTEMPLATES A DIVISION OF FUNCTIONS BETWEEN JUDGE AND JURY.

Much of the dissent is devoted to establishing that the ultimate question of patent infringement was for the jury. *E.g.*, P. A. 118a-129a. But that is not contested here. The issue, rather, is allocation of function between judge and jury. Judges in order to make proper legal rulings often determine subsidiary issues of fact.

A. The Seventh Amendment Does Not Assign All Rulings Involving Factual Issues to the Jury.

"[F]actfinding . . . was never the exclusive province of the jury under either the English or American legal systems at the time of the adoption of the Seventh Amendment" *Atlas Roofing Co. v. OSHA*, 430 U.S. 442, 458 (1977). "[I]t is not 'trial by jury,' but 'the right of trial by jury,' which the Amendment declares 'shall be preserved.'" *Capital Traction Co. v. Hof*, 174 U.S. 1, 23 (1899). "[T]he Framers of the Seventh Amendment were concerned with preserving the *right* of trial by jury in civil cases where it existed at common law, rather than the various incidents of trial by jury." *Colgrove v. Battin*, 413 U.S. 149, 155-56 (1973) (emphasis in original; footnote omitted).

The right of trial by jury is the right to a trial conducted before a judge and a jury, in which each performs their respective customary functions. "Courts pass upon a vast number of questions of fact [T]here is not, and never was, any such thing in jury trials as an allotting of all questions of fact to the jury. The jury simply decides *some* questions of fact." J. THAYER, A PRELIMINARY TREATISE ON EVIDENCE 185 (1898), quoted in 9 J. WIGMORE, EVIDENCE 640 (J. Chadbourn rev. ed. 1981) (emphasis supplied). The "seventh amendment question depends on the nature of the issue to be tried rather than the character of the overall action." *Ross v. Bernhard*, 396 U.S. 531, 538 (1970).

The judge's function often requires the evaluation of factual testimony and the resolution of factual disputes

ancillary to the taking of evidence by the jury. Common examples are evidentiary hearings in criminal cases after which the court resolves motions to suppress evidence. In civil actions, evidentiary hearings are conducted by the court to resolve many factual disputes. Thus, for example,

“when the competency of a piece of evidence depends upon a preliminary fact, that fact is for the judge to decide. That means he is to decide it finally without submitting it to the jury.”

9 J. Wigmore, *supra*, at 641. And in doing so, the judge “may of course *hear evidence on both sides* for determining the facts on which the rule of admissibility turns.” *Id.* 663 (emphasis in original). The qualifications and knowledge of a witness are “a preliminary question for the judge presiding at the trial.” *Stillwell & Bierce Mfg. Co. v. Phelps*, 130 U.S. 520, 527 (1889); accord, e.g., *Spring Co. v. Edgar*, 99 U.S. 645, 658 (1879). In *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993), this Court mandated that under Fed. R. Evid. 104(a) and 702 “the trial judge must ensure that any and all scientific testimony or evidence admitted is not only relevant, but reliable.” 113 S. Ct. at 2795.⁹ See also Fed. R. Evid. 201 (judicial notice of adjudicative facts); Fed. R. Evid. 403 (judge may exclude probative evidence likely to mislead); Fed. R. Evid. 1008 (when admissibility “depends upon the fulfillment of a condition of fact, the question whether the condition has been fulfilled is ordinarily for the court to determine”); Fed. R. Civ. P. 23(b)(3) (findings on class certification). Cf. *Hurley v.*

⁹ See, e.g., *In re Paoli R.R. Yard PCB Litigation*, 35 F.3d 717, 736 (3d Cir. 1994) (five-day evidentiary hearing before judge on whether testimony satisfied Rule 702), *cert. denied sub nom. General Elec. Co. v. Ingram*, 115 S. Ct. 1253 (1995); *In re Japanese Electronic Prods. Antitrust Litigation*, 723 F.2d 238, 277 (3d Cir. 1983) (“as a matter of law, the district court must make a factual inquiry and finding as to what data experts in the field find reliable”), *reversed on other grounds sub nom. Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986).

Irish-American Gay, Lesbian & Bisexual Group, 115 S. Ct. 2338, 2344 (1995) (“constitutional facts”), citing *Fiske v. Kansas*, 274 U.S. 300, 305-06 (1927); see also *Bose Corp. v. Consumers Union of the United States, Inc.*, 466 U.S. 485, 511 (1984).

It will not do, as petitioners appear to believe, simply to call the right to jury trial “sacred,” Pet. Br. 21, and cite opinions like *Dimick v. Schiedt*, 293 U.S. 474 (1935), that have quite appropriately praised the right to jury trial preserved in the Seventh Amendment. For a jury trial without a judge performing his or her role would be neither sacred, nor what the Seventh Amendment preserves. *Hepner v. United States*, 213 U.S. 103, 115 (1909). To rely on such general observations simply begs the question, which is, what if any is the assignment of respective functions as to patent-claim construction that the right preserves? Even *Dimick v. Schiedt*, which held that additur by the court to damages awards was not permitted under the Seventh Amendment, was a decision in which Justice Stone, joined by Chief Justice Hughes and Justices Brandeis and Cardozo, dissented, citing examples of variations from procedures known in 1791 that the Court had approved, such as remittitur. See 293 U.S. at 491-92, 495; *Arkansas Valley Land & Cattle Co. v. Mann*, 130 U.S. 69, 72-74 (1889).¹⁰

Scarcely mentioned by petitioners is *Galloway v. United States*, 319 U.S. 372 (1943). There this Court explained that “[t]he jury was not absolute master of fact in 1791,” pointing out as examples the court’s authority to exclude evidence for privileges or irrelevancy, to direct verdicts, and to set aside verdicts for insufficient evidence.

“The [Seventh] Amendment did not bind the federal courts to the exact procedural incidents or de-

¹⁰ E.g., *Ex parte Peterson*, 253 U.S. 309 (1920) (auditors to report on facts); *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593 (1897) (special verdict); *Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494 (1931) (new trial on damages); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) (summary judgment).

tails of the jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing."

319 U.S. at 390 (footnote omitted) (citing dissent of Stone, J., in *Dimick v. Schiedt*, *supra*). "[T]he Amendment was designed to preserve the basic institution of jury trial in only its most fundamental elements, not the great mass of procedural forms and details, varying even then so widely among common-law jurisdictions." 319 U.S. at 392 (footnote omitted). "[M]any procedural devices developed since 1791 that have diminished the civil jury's historic domain have been found not to be inconsistent with the Seventh Amendment." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 336 (1979); see also *id.* at 345 (Rehnquist, J. dissenting) ("it is the substance of the right of jury trial that is preserved, not the incidental or collateral effects of common-law practice in 1791"). Cf. Fed. R. Evid. 102 ("These rules shall be construed to secure . . . promotion of growth and development of the law of evidence").¹¹

There are, of course, certain issues in patent cases that if materially disputed are for the jury. Infringement—whether one product actually transgresses the area pa-

¹¹ See also *Gasoline Prods. Co. v. Champlin Ref. Co.*, *supra*, 283 U.S. at 497-98 ("It is true that at common law there was no practice of setting aside a verdict in part" but "the Constitution is concerned not with form, but with substance"); *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 320-21 (1902). "The command of the Seventh Amendment that 'the right of trial by jury shall be preserved' does not require that old forms of practice and procedure be retained." *Ex parte Peterson*, *supra*, 253 U.S. at 309 (Brandeis, J.). The development of trial by jury "surely . . . was not, by the adoption of our constitutions, suddenly congealed." Scott, *Trial by Jury and the Reform of Civil Procedure*, 31 HARV. L. REV. 669, 670 (1918). "Only those incidents which are regarded as fundamental, as inherent in and of the essence of the system of trial by jury, are placed beyond the reach of the legislature." *Id.* at 671, quoted in *Tull v. United States*, 481 U.S. 412, 426 (1987), and *Colgrove v. Battin*, 413 U.S. 149, 156 n.11 (1973). *Accord*, *Galloway v. United States*, *supra*, 319 U.S. at 392.

tented to another; "equivalence"—whether a product although not identical is essentially the same as what was patented; "enablement"—whether a person skilled in the art could look at a patent and build the invention. But construing the meaning of the claims stated in the patent itself has for over a century been recognized as a legal determination for the court.

Searching for authority, petitioners unfortunately commingle all sorts of Nineteenth-Century patent decisions, citing some that involved such jury issues. Pet. Br. 31-34. Lack of inventiveness, for example, was the issue in *Tucker v. Spalding*, 13 Wall. 453 (1872); see 3 W. ROBINSON, *supra*, at 373 n.1. *Market Street Cable Ry. v. Rowley*, 155 U.S. 621 (1895), and *Bischoff v. Wethered*, 9 Wall. 812 (1870), involved the jury issue of novelty; see 3 W. ROBINSON, *supra*, at 375 n.5. The jury also sometimes decided whether a reissued patent was identical to the original. Cf. *Heald v. Rice*, 104 U.S. 737 (1882).

That in some cases construction of a patent claim may be outcome-determinative, as petitioners urge, Br. 17-18, does not advance their argument.¹² Legal rulings by definition often are. Cf. Fed. R. Civ. P. 12(b)(6). "The rules governing the admissibility of evidence, for example, have a real impact on the jury's function as a trier of facts and the judge's power to impinge on that function." *Galloway v. United States*, *supra*, 319 U.S. at 390 n.22. So does the court's authority to take fact issues from the jury if evidence is insufficient. *Improvement Co. v. Munson*, 14 Wall. 442, 447 (1872); see also *Gunning v. Cooley*, 281 U.S. 90 (1930). And "[t]he power of the court to grant a new trial if in its judgment the jury have misinterpreted the instructions as to the rules of law or misapplied them is unquestioned, as also when it appears

¹² An *amicus* goes so far as to argue that in jury cases "legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right . . . regardless of how the facts fit into, or mix with, the legal matrix of the overall controversy." Litton Br. 12 (emphasis in original).

that there was no real evidence in support of any essential fact." *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593, 596 (1897).

The invocation of the "reexamination" clause, Litton Br. at 12-13, is chimerical. As the construction of a claim is for the court, there is no factfinding by the jury to be reexamined. In the present case, the trial court provisionally allowed the interpretation to be made by the jury, then corrected itself and determined the issue as a matter of law. In substance, a legal ruling was reserved. That in no way involves the Seventh Amendment's concern about judges or appellate courts overturning jury verdicts, any more than would an appellate court's reviewing for error of law. Also, the clause forbids only reexamination "otherwise . . . than according to the rules of the common law."

"At common law there was a well established practice of reserving questions of law arising during trials by jury and of taking verdicts subject to the ultimate ruling on the questions reserved [I]t undoubtedly was well established when the Seventh Amendment was adopted, and therefore must be regarded as part of the common-law rules, to which resort must be had"

Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 659-60 (1935).

B. Judges, Not Juries, Construe Official Grants and Directives.

1. *Public Laws*.—Patents are grants that bind the public.¹³ *Wheaton v. Peters*, 8 Pet. 591, 663-64 (1834). "Like other statutes, those which confer legal advantages or economic benefits have all the force, effects and attributes of laws. They are subject to the same rules of interpretation that apply to other statutes." 3 SUTHERLAND STATUTORY CONSTRUCTION 228 (N. Singer rev. ed.

¹³ "The King's grants are contained in charters or letters patent, . . . with the great seal pendent at the bottom, and are usually directed or addressed by the King to all his subjects at large." W. HANDS, LAW AND PRACTICE OF PATENTS FOR INVENTIONS 1 (1808).

1992) (footnote omitted). "[G]rants provided for . . . patents protecting inventions" are among these. *Id.* at 238. It is for courts, of course, to construe statutes using whatever materials seem useful. *E.g.*, *NLRB v. Town & Country Electric, Inc.*, 64 U.S.L.W. 4022, 4024 (1995) (referring to dictionaries); *Bailey v. United States*, No. 94-7448 (Dec. 6, 1995), slip op. at 8 (same).

2. *Private Laws*.—Like a private relief act, a patent assigns a governmentally owned right to a private person, using the intermediary of the Patent Office to designate the terms and scope of the grant. See *United States v. American Bell Tel. Co.*, 128 U.S. 315, 360-63 (1888). Indeed, "[s]pecial acts for the relief of particular inventors have often been passed by congress," *The Fire-Extinguisher Case*, 21 Fed. 40, 42 (C.C.D. Md. 1884), and construed by courts like any other laws. *E.g.*, *Evans v. Eaton*, 3 Wheat. 454, 517 (1818) (construing patent granted under private act, 6 Stat. 70; *cf.* *Great N. Ry. v. United States*, 315 U.S. 262, 273 (1942) (construing land grant in light of historical facts)).

3. *Patents for Land*.—Invention patents are only one example of grants from the sovereign of exclusive rights. Millions of acres of public lands have been patented to individuals and corporations by the federal and state governments. "The power . . . to issue a patent for an invention, and the authority to issue such an instrument for a grant of land, emanate from the same source, and . . . are of the same nature, character and validity" *United States v. American Bell Tel. Co.*, *supra*, 128 U.S. at 358-59. Land patents, this Court has held, like patents for inventions are for the judge to construe as a matter of law, while juries decide whether the boundaries of the claim as construed by the court have in fact been transgressed. In *Brown v. Huger*, 21 How. 305 (1859), this Court held:

"With regard to the second part of this objection, that which claims for the jury the construction of the patent, we remark that the patent itself must be taken as evidence of its meaning; that, like other written

instruments, it must be interpreted as a whole, its various provisions be taken as far as practicable in connection with each other, and the legal deductions drawn therefrom must be conformable with the scope and purpose of the entire document. *This construction and these deductions we hold to be within the exclusive province of the court.* The patent itself could not be altered by evidence aliunde, but proof as to the existence and character of the objects or subjects to which it was applicable was regular, and even necessary to give it effect."

21 How. at 318 (emphasis supplied). Although a land claim that rested upon testimony as to markers could be for a jury, *id.* at 320-21, construction of a land patent is "a question of law," *id.* at 319, and a claim under a patent simply "presents for the determination of the court the construction of the calls for boundary mentioned in the patent, and surely none will pretend that the legal construction of a patent is not a matter proper for the decision of a court." *Id.* at 321.¹⁴

4. *Copyrights.*—The determination of what material is included in a copyright is for the court, not a jury. Copyrights, like patents, are public grants and have boundaries. A copyright grant covers only the "constituent elements of the work that are original," and it is a legal question for the court whether, for example, "Rural's white pages lack the requisite originality." *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 364 (1991); accord, *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985). Thus although "[d]etermining which elements of a [computer] program are protectable is a difficult task," nevertheless there is no doubt that "a court should dissect the program" in order to do so. *Gates Rubber Co. v. Bando Chem. Industries, Ltd.*, 9 F.3d 823,

¹⁴ *Reed v. Proprietors of Locks*, 8 How. 274 (1850), a case involving not a land patent but a private deed, is incompletely described at Litton Br. 21. This Court held that "it was the duty of the court to give a construction to the deed in question, so far as the intention of the parties could be elicited therefrom," 8 How. at 288, as under the parol evidence rule, which assigns contract interpretation to the court. See 8 How. at 290.

834 (10th Cir. 1993); accord, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207 (9th Cir. 1989) ("these instructions did not adequately explain to the jury which material was, in fact, protectable").

5. *Corporate Charters.*—Corporate charters are construed by courts, not juries. "It is the duty of the court to ascertain by a fair, intelligent and equitable construction of the language used what is the character and extent of the grant." 7A W. FLETCHER, CYCLOPEDIA OF PRIVATE CORPORATIONS 242 (Keating & Nelson rev. ed. 1989). This Court indeed has noted that "The rule of construction in this class of cases is that it shall be most strongly against the corporation." *Fertilizing Co. v. Hyde Park*, 97 U.S. 659, 666 (1878); see also *Proprietors of Charles River Bridge v. Proprietors of Warren Bridge*, 11 Pet. 420, 538-39, 548 (1837) (construing charter as not excluding competition); cf. *Trustees of Dartmouth College v. Woodward*, 4 Wheat. 518, 629 (1819) (construing charter). The same rule applies to charters of municipal corporations. *Driggins v. Oklahoma City*, 954 F.2d 1511, 1513 (10th Cir.), cert. denied, 113 S. Ct. 129 (1992).

6. *Federal Regulations.*—Federal regulations often contain terms that may require technical knowledge to interpret. But that does not mean that the interpretation of such regulations is handed over to a jury, nor that judges are precluded from consulting extrinsic aids to understand them. See, e.g., *Nippon Kogaku (USA), Inc. v. United States*, 673 F.2d 380, 383 (C.C.P.A. 1982) (construction of tariff schedules); *United States v. Boeing Co.*, 802 F.2d 1390, 1393 (Fed. Cir. 1986) (construction of federal acquisition regulations); *United States v. Weitzenhoff*, 1 F.3d 1523, 1531-32 (9th Cir. 1993) (error to submit to jury expert testimony on construction of "removed substance" and "essential maintenance" in EPA regulation), cert. denied sub nom. *Mariani v. United States*, 115 S. Ct. 939 (1995).

7. *Foreign Law.*—Although "[i]t was generally held at common law that a foreign law is a matter of 'fact,'

i.e., its existence is to be determined by the jury," nevertheless "the only sound view, either on principle or on policy, is that it should be proved to the judge." 9 J. WIGMORE, EVIDENCE 687 (J. Chadbourn rev. ed. 1981) (emphasis in original). Under Fed. R. Civ. P. 44.1, courts determine foreign law and in doing so "have turned to a wide variety of sources including affidavits and expert testimony." *United States v. Mitchell*, 985 F.2d 1275, 1280 (4th Cir. 1993) (Fed. R. Crim. P. 26.1); see generally Miller, *Federal Rule 44.1 and the "Fact" Approach to Determining Foreign Law*, 65 MICH. L. REV. 613, 684 (1967) ("No federal case involving foreign law has been found in which the jury-trial question was considered to be of constitutional dimensions").

8. *Consent Orders*.—"[C]onstruing the meaning of a consent order, even an ambiguous one, is a question of law for the court" *United States v. Reader's Digest Ass'n*, 662 F.2d 955, 961 (3d Cir. 1981), *cert. denied*, 455 U.S. 908 (1982). The court may consult materials outside the order in construing it. *Id.*; see also, e.g., *United States v. J.B. Williams Co.*, 498 F.2d 414, 430-31 (2d Cir. 1974) (distinguishing what an order means (for court) from whether it has been violated (for jury)).

9. *Collateral Estoppel*.—The doctrine of collateral estoppel applies to patent litigation, and judges determine which fact issues are thereby precluded from jury consideration without regard to common-law doctrines of mutuality. *Blonder-Tongue Labs., Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971); see also *Parklane Hosiery Co. v. Shore*, *supra*.

10. *Private Agreements Distinguished*.—It is not accurate to say that "this Court has held that patents are properly analogous to contracts or deeds, not to statutes." *Litton Br. 4*. This Court has held no such thing; and the principles applied to private agreements are different.¹⁵

¹⁵ In *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880), cited at *Litton Br. 20 n.32*, this Court on review construed the patent, referring to the evidence. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917), does not

Even contract cases start with the parol evidence rule—that construction of the document is for the court—which at the turn of the Nineteenth Century was taken seriously. See, e.g., *Levy v. Gadsby*, 3 Cranch 180, 186 (1805) ("no principle is more clearly settled, than that the construction of a written evidence is exclusively with the court"). Only if there is ambiguity can parol evidence be presented, and then only for the limited purpose of trying to determine what the parties intended.

A patent is not a contract negotiated by the patentee. Nor are private contracts required by law to be clear, as patents are. Since the Patent Act of 1836, patent examiners have been established as an administrative assurance that the grant conforms to legal requirements, "for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture." *Keystone Bridge Co. v. Phoenix Iron Co.*, *supra*, 95 U.S. at 278; see also *Corning v. Burden*, 15 How. 252, 270-71 (1854). Being the result of this administrative screening, patents and their claims are presumed valid; claim interpretation is in effect a review of an agency determination. *Cf. Mitchell v. Tilghman*, 19 Wall. 287, 390 (1874).

Petitioners' argument that patents should be treated like private contracts because they can be viewed as "bargains" with society is little more than a play on words. *Pet. Br. 44*. The policy underlying patents can be likened to a theoretical bargain between the government and inventors generally, to provide limited monopolies in order that the public may benefit from disclosure of their work. See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989). That analytical rationalization in no way assumes that individual inventors are allowed to bargain about the terms of their patents. Nor

likened a patent to a deed, and at the page cited at *Litton Br. 21 n.33* reiterates that "It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is." 243 U.S. at 510.

does it imply that juries should define the terms of the government's grant.¹⁶

C. Standard of Appellate Review Is a Separate Question.

The instances inviting resort to technical expert testimony to assist the court in construing a patent claim are far less frequent than petitioners imply. Most patents can be interpreted without resort to extrinsic aids, just as most statutes can be interpreted without resort to legislative materials.¹⁷ This Court and others often have construed patent claims on appellate review without expressing any need for assistance from outside experts. *E.g.*, *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942). As a general rule "appellate courts have untrammelled power to interpret written documents." *Eddy v. Prudence Bonds Corp.*, 165 F.2d 157, 163 (2d Cir. 1947) (L. Hand, J.), *cert. denied sub nom. Prudence Realization Corp. v. Eddy*, 333 U.S. 845 (1948).

¹⁶ There is no basis for imposing on the law a new distinction between "construction" and "interpretation" of a patent claim, as proposed by the dissent at P.C.A. 87a-89a. The cases do not recognize it, and it would make no difference: "The interpretation, as well as the construction of a written instrument, is for the Court, and not for the Jury." 1 S. GREENLEAF, EVIDENCE 400 n.1 (3d ed. 1846); see also P.C.A. 21a n.6. And it is difficult to comprehend *amicus'* plainly incorrect assertion that private contracts are somehow "enforceable against the public," Litton Br. 19, or the proposition, citing *Shelly v. Kraemer*, 334 U.S. 1 (1948), that private contracts somehow are really public instruments. Litton Br. at 20 n.29.

¹⁷ See, *e.g.*, Rifkind, *The Romance Discoverable in Patent Cases*, 16 F.R.D. 253, 254 (1954) ("I fail to see why the technical intricacies of a patent should be harder to understand than the complexities of a corporate merger or a family history"). "The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles. . . ." *Hogg v. Emerson*, 6 How. 437, 485 (1848). *Cf. Smith v. Snow*, *supra* (construing claim for incubator). *Cf. also Burlington N.R.R. v. Oklahoma Tax Comm'n*, 481 U.S. 454, 461 (1987); *Diamond v. Diehr*, 450 U.S. 175, 182 (1981); *Rubin v. United States*, 449 U.S. 424, 430 (1981).

Constitutional policy points toward plenary appellate review of the scope of patent claims; for patent monopolies are not to be enlarged beyond the limited grants authorized by the Constitution. The Seventh Amendment's "ban on re-examination of facts does not preclude us from determining whether governing rules of federal law have been properly applied to the facts." *New York Times Co. v. Sullivan*, 376 U.S. 254, 285 n.26 (1964). Appropriately confining the scope of patent claims is at the heart of constitutional policy on patents. *E.g.*, *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).¹⁸

If in uncommon instances evaluation of expert testimony on claims might be thought to entail determinative credibility judgments based on demeanor, the model might be *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657 (1989). There in conducting appellate review of facts under *New York Times Co. v. Sullivan*, *supra*, this Court held that "credibility determinations are reviewed under the clearly-erroneous standard." 491 U.S. at 688. A similar analysis could apply to judicial factfinding collateral to interpretation of patent claims. *Cf. Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) ("whether or not the ultimate question of obviousness is a question of fact subject to Rule 52(a), the subsidiary determinations of the District Court, at the least, ought to be subject to the Rule"); see also *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d Cir. 1950). The standard of appellate review is a consideration quite distinct from that of whether judges are to continue to construe patent claims. See generally *First Options of Chicago, Inc. v. Kaplan*, 115 S. Ct. 1920, 1926 (1995); *Salve Regina College v. Russell*, 499 U.S. 225, 231-33 (1991).

¹⁸ "At least in those instances in which Congress has not spoken and in which the issue falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question." *Miller v. Fenton*, 474 U.S. 104, 114 (1985). *Cf. Parker v. Hulme*, *supra*.

III. HISTORY DOES NOT SUPPORT PETITIONERS' POSITION.

A. Juries Did Not Construe the Scope of Royal Patents in 1791.

Petitioners describe 1791 English law as "unequivocal," Pet. Br. 25, and assert that "the historical record shows that the issue here was a jury issue in 1791." *Id.* at 23. That is not remotely correct. Patent law in England at that time was scarcely describable. From 1750 to 1799 there were only 18 patent decisions at common law in England, and hardly any of those prior to the American Revolution. H. DUTTON, *THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION 1750-1852* at 78 (1984). The common-law courts did not receive general authority to hear patent cases until 1752, and "[t]he net result was considerable uncertainty as to the nature of the patent law," and "lack of adequate case law." Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents*, 77 J. PAT. & T. OFF. SOC'Y 771, 775-76 (1995).

"In the late eighteenth and early nineteenth centuries, when the law remained in an infant and unsettled state, judges rarely expressed a consistent viewpoint." H. DUTTON, *supra*, at 77. "The equity courts were rarely guided by precedent . . . [and] the common-law courts were no better." C. MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION* 61 (1988). An attorney in 1785 who asked "What is the Law of Patents?" reported "[t]he books are silent." Adams & Averly, *The Patent Specification: The Role of Liardet v. Johnson*, 7 J. LEGAL HIST. 156, 167 (1986). "Patent rights are no where that I can find accurately discussed in our books." *Boulton v. Bull*, 2 H. Bl. 463, 491, 126 Eng. Rep. 651, 655 (C.P. 1795) (Eyre, C.J.). "At the end of the eighteenth century . . . the Common Law judges were left to pick up the threads of the principles of law without the aid of recent and reliable precedents." Adams & Averly, *supra*, at 157. There was no coherent body of English patent law to be known by the enactors of the Seventh Amendment.

Eighteenth-Century English patents did not contain claims by the inventor; they required simply specifications of the invention. Thus the few English cases petitioners cite obviously did not involve jury construction of patent claims as such, for there were none to construe. Juries in infringement cases did decide whether specifications satisfied "enablement": whether the specification was detailed enough to enable someone to copy the invention, which was a common issue in early English patent cases. See F. BULLER, *TRIALS AT NISI PRIUS* 76*b* (7th ed. 1817). Each of the two reported pre-1791 cases that petitioners cite is of that kind. *Turner v. Winter*, 1 T.R. 602, 1 Rev. Rep. 311 (K.B. 1787); *Arkwright v. Nightingale*, Dav. Pat. Cas. 37 (C.P. 1785). So is the summary of a jury instruction in an unreported trial, *Liardet v. Johnson* (n.p. 1778).¹⁰ Post-1791 English cases cited by petitioners similarly were decisions on the issue of "enablement." *Hornblower v. Boulton*, 8 T.R. 95, 101 Eng. Rep. 1285 (K.B. 1799); *Huddart v. Grimshaw*, Dav. Pat. Cas. 265 (K.B.

¹⁰ *Liardet v. Johnson*, which petitioners incorrectly cite as "a leading King's Bench decision," Pet. Br. 23, was not a decision reviewed by the King's Bench. It was an unreported trial before Lord Mansfield, and was notable only for his instruction on novelty, an issue not involved here. See Hulme, *On the History of Patent Law*, 18 LAW Q. REV. 280, 287 (1902). Regarding the jury's role, it simply followed the accepted doctrine that the specification must enable a person skilled in the art to build the invention, which was a jury issue. The phrase quoted at Pet. Br. 24 is not from the trial but from later editions of a treatise by Sir Francis Buller. "Buller's *Nisi Prius* in fact incorrectly records the outcome. His version is evidently based on the defendant's pamphlet." Adams & Averly, *supra*, 7 J. LEGAL HIST. at 165 (footnote omitted); see F. BULLER, *TRIALS AT NISI PRIUS* 76*b* (7th ed. 1817). Buller's manuscript notes of the charge, presumably based on the pamphlet, do not contain any instruction that the jury construe the patent. In their entirety they read:

"[Lord Mansfield] left to the jury 1st, on all objections made to exactness, certainty and propriety of the Specifications, & whether any workman could make it by [the Specification]."

I J. OLDHAM, *THE MANSFIELD MANUSCRIPTS* 756 (1992) (brackets in original). See also *Boulton v. Bull*, *supra*, 2 H. Bl. at 491, 126 Eng. Rep. at 665: "The modern cases have chiefly turned upon the specifications, whether there was a fair disclosure."

1803); *Bovill v. Moore*, Dav. Pat. Cas. 361, 17 Rev. Rep. 514 (C.P. 1816).

By the early Nineteenth Century, English judges were not hesitating to construe patent specifications (there being no claims). See *Russell v. Cowley*, Web. Pat. Cas. 457, 465, 468-70 (Exch. 1834); *Haworth v. Hardcastle*, Web. Pat. Cas. 480, 483, 484 (1834). Petitioners seek support in a case decided in England fifty years after the Seventh Amendment, *Neilson v. Harford*, 8 M. & W. 806, 151 Eng. Rep. 1266, Web. Pat. Cas. 331 (Exch. 1841), but they misunderstand it. Petitioners say, Br. 27, that "The *Neilson* court agreed that it was 'peculiarly the province of a jury' to construe 'as matters of fact' patent terms that might constitute 'words of art, words of commerce, [and] words which are used in some sense different from their ordinary sense.'" But what petitioners quote is not the court at all, but rather oral argument of counsel. See Web. Pat. Cas. at 367. The report shows that one judge interrupted the argument to observe:

"You are proposing to leave to the jury the construction of that which limits the amount of the right of the patentee as regards all subsequent inventions. To what an extravagant length that goes."

Id. Another judge also interrupted to explain that the jury's function was not to decide the limits of the patent, but rather "The question, whether a patent is so worded as that a person of ordinary knowledge will understand it and work by it, is for the jury." *Id.* He observed:

"It appears to me to be too late at the present day to contend that it is not for the Court to construe the specification, like any other written instrument."

8 M. & W. at 823, 151 Eng. Rep. at 1273. The court's opinion concluded that although the jury in performing its function of determining "enablement" could ascertain the meaning of terms of art,

"Then we come to the question itself, which depends on the proper construction to be put on the specification itself. It was contended, that of this

construction the jury were to judge. We are clearly of a different opinion."

Id. at 370, 8 M. & W. at 823, 151 Eng. Rep. at 1273. *Neilson v. Harford* is cited by English legal scholars as holding that "The construction of the specification is for the court alone." TERRELL ON THE LAW OF PATENTS 73 (W. Aldous, et al., 13th ed. 1982).²⁰

B. United States Patent Law Requires Clarity and Predictability of Patent Claims.

Claims were not a part of American patents at the beginning, either, so analogies cannot be perfect.²¹ But Congress from the first patent law insisted that inventors describe their inventions with clarity, in a manner understandable not only to persons skilled in the art, but also by the administrators of the patent system, and by the public, which was paying the burden of the granted monopoly. Unlike grants from the crown, patents in this country had to comply with a constitutional provision. U.S. Const., Art. I, § 8, cl. 8. The first patent act in 1790, older

²⁰ Cf. 1 W. CARPMAEL, LAW REPORTS OF PATENT CASES iv (1843) (publishing collection of patent decisions "to give a correct opinion of the construction which a court of law will put on a particular specification").

²¹ "Nor were 'the rules of the common law' then prevalent, including those relating to the procedure by which the judge regulated the jury's role on questions of fact, crystallized in a fixed and immutable system." *Galloway v. United States*, 319 U.S. 372, 390-91 (1943). Members of this Court have observed that "the incompleteness of our historical records makes it difficult to know the nature of certain actions in 1791." *Chauffeurs Local No. 391 v. Terry*, 494 U.S. 558, 593 (1990) (Kennedy, J., dissenting); *id.* at 576 (Brennan, J., concurring) (referring to "recondite controversies better left to legal historians"). "Neither during the ratification controversy nor in the subsequent proceedings on adoption of the Bill of Rights was any specific consensus expressed on the relation of judge to jury in civil cases," and there was "great diversity of practice in the thirteen states." Henderson, *The Background of the Seventh Amendment*, 80 HARV. L. REV. 289, 336 (1966). But "uniform postratification practice can shed light upon the meaning of an ambiguous constitutional provision." *United States v. Gaudin*, 115 S. Ct. 2310, 2318 (1995).

than the Seventh Amendment, required filing of a specification "so particular," and if feasible a model of the invention "so exact," that it could be distinguished from the prior art and that a skilled person could replicate it "to the end that the public may have the full benefit thereof, after the expiration of the patent term."²²

It became the practice in the United States (unlike the old English law, for patent applications to include not just specifications of the device, but also "claims" defining the aspects in which it was novel and therefore entitled to be patented. The inclusion of claims became mandatory beginning with the Patent Act of 1836, Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119. See Schneider, *Claims to Fame*, 71 J. PAT. & T. OFF. SOC'Y 143, 145 (1989). And the Patent Act of 1870 tightened the law further by requiring that the application "particularly point out and distinctly claim" the invention. Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201. "The claims 'measure the invention.'" *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938), quoting in part *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908).

In *Hogg v. Emerson*, 6 How. 437 (1848), this Court in ruling "without the aid of experts and machinists" noted that exactness was required not only to enable a person skilled in the art to make the device, but also so the Commissioner of Patents could decide whether it qualified, and also to allow "the public" to understand precisely what was patented. 6 How. at 484; see also *Winans v. Denmead*, *supra*, 15 How. at 342-44; *Blake v. Stafford*, 3 Fed. Cas. 610, 612-13 (C.C.D. Conn. 1868) (No. 1,504) ("The office of the claim is to define the limits of the patented discovery claimed by the patentee as his exclusive property. . . . If, by the use of good sense, and the ordinary rules of interpretation, the court can clearly see the nature and limits of the invention, the claim will be upheld").

²² Act of April 10, 1790, ch. 7, § 2, 1 Stat. 109, 110. See also Act of Feb. 21, 1793, ch. 11, § 3, 1 Stat. 318, 321 ("a written description of his invention . . . in . . . full, clear and exact terms").

"The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further."

White v. Dunbar, 119 U.S. 47, 52 (1886); see also *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 435-37 (1902) (distinguishing claim from specification, which "is not addressed to lawyers, or even to the public generally"). Thus the current statute, 35 U.S.C. § 112, addresses the specification to "any person skilled in the art," but the claim required is not so limited.

IV. CONSTITUTIONAL POLICY REQUIRES PATENT CERTAINTY.

A. Patents Are Constitutionally Limited.

Just as "[t]he primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts,'" *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991), so the dominant interest in patents is the public's. As with copyrights, "[t]he sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public" *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932). "[F]ree exploitation of ideas will be the rule, to which the protection of a federal patent is the exception." *Bonito Boats*, *supra*, 489 U.S. at 151; see also *id.* at 147-48. The respective responsibilities of court and jury in infringement suits can be informed by recognizing that although infringement suits usually arise between private parties, patents themselves may be viewed as "public rights." See *In re Lockwood*, 50 F.3d 966, 981 (Fed. Cir.) (Nies, J., dissenting), *vacated sub nom. American Airlines, Inc. v. Lockwood*, 116 S. Ct. 29 (1995).²³

²³ "[T]he grant of a valid patent is primarily a public concern." *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604, *rehearing denied*,

Patent disputes could, if Congress chose, be assigned for resolution to an Article I court or an administrative agency, with appropriate judicial review, because "[t]he Seventh Amendment protects a litigant's right to a jury trial only if a cause of action is legal in nature and it involves a matter of 'private right.'" *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 n.4 (1989); see also *Wickwire v. Reinecke*, 275 U.S. 101, 105-06 (1927); *Mountain Timber Co. v. Washington*, 243 U.S. 219, 235 (1917). Congress instead has chosen to authorize legal actions for infringement and assign them to Article III courts, thus assuring the parties in infringement actions the right of jury trial. But in determining the assignment of issues between court and jury it is appropriate to bear in mind the "public" nature of the underlying patent right, and the public importance of proper construction of patent claims. See, e.g., *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1950).

B. Certainty Is Required in Patent Claims.

Certainty in patent claims is more than a convenience. It serves a constitutional purpose. "From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy." *Bonito Boats, supra*, 489 U.S. at 146. Congress is not allowed to "enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966). Yet the patent monopoly is broadened if a patentee can come in later and argue to a jury that the claim is broader than a court would understand the claim language to mean.

771 F.2d 480, 481 (Fed. Cir. 1985). "The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights." *Merrill v. Yeomans*, 94 U.S. 568, 573 (1877).

Jury interpretation of claims would mean that every patent granted, instead of fixing the patentee's claim in the document, would be surrounded by an uncertain penumbra of what one or another jury might decide was meant by words in a patent. And each of those jury verdicts, however inconsistent, would not be subject to review for error of law. Claims would lack clear boundaries, and new inventions would be chilled by the fear that a jury might be persuaded to misinterpret an earlier patent's claim.

"[I]f the public comes to believe (or fear) that the language of patent claims can never be relied on . . . then claims will cease to serve their intended purpose. Competitors will never know whether their actions infringe a granted patent."

London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed. Cir. 1991).²⁴ The scope of a patent,

"If it may be shown by parol evidence to the jury, as the plaintiff's counsel contend it may, then it may be fairly asked, cui bono? . . . As to the public at large . . . the evidence given in this cause, must be evanescent, and totally useless."

Evans v. Eaton, 8 Fed. Cas. 856, 860 (C.C.D. Pa. 1818) (No. 4,560) (Washington, J.), *aff'd*, 7 Wheat. 356 (1822); see also *Evans v. Hettick*, 8 Fed. Cas. 861, 868 (C.C.E.D. Pa. 1818) (No. 4,562), *aff'd*, 7 Wheat. 453 (1822); *Dixon v. Moyer*, 7 Fed. Cas. 758, 760 (C.C.D. Pa. 1821) (No. 3,931) (Washington, J.) (observing that "[i]t is not enough . . . to point out at the trial" what a patent means, because "[t]hird persons . . . can safely depend upon no other information that what the records of the secretary of state's office may afford"). Construction must be for the court because

²⁴ In 1968-70, only 13 of the 382 patent cases were jury trials. See *Blonder-Tongue Labs., Inc. v. University of Illinois Foundation*, 402 U.S. 313, 336 n.30 (1971). By 1994 the figure had risen to 70%. *In re Lockwood, supra*, 50 F.3d at 980 n.1 (Nies, J., dissenting).

"Unless this were so, there would be no certainty in the law, for a misconstruction by the court is the proper subject, by means of a bill of exceptions, of redress in a court of error, but a misconstruction by the jury cannot be set right at all effectually."

Neilson v. Harford, *supra*, Web. Pat. Cas. at 370. Cf. *United States v. Turner*, 11 How. 663, 668 (1850) (construction of land titles is for the court because "the titles to land in that State would become unstable and insecure . . . [if dependent on] the fluctuating verdicts of juries").

The Patent Clause anticipated a uniformity in patent policy. See *Bonito Boats*, *supra*, 489 U.S. at 156-57. "The Need for Increased Uniformity in Patent Law" was emphasized by the Congress as a major reason for establishing the Court of Appeals for the Federal Circuit. H.R. Rep. No. 97-312, 97th Cong., 1st Sess. 20 (1981). The Federal Circuit has been charged with developing a body of law to guide courts and provide consistency in claim construction.²⁵

Petitioners have history and precedent overwhelmingly against them. Their new interpretation of the Seventh Amendment would not only declare two centuries of practice unconstitutional. In addition, it would undermine the constitutional policy of the Patent Clause so severely that this is yet another instance in which "the consequences flowing from the view asserted are sufficient to refute it." *Galloway v. United States*, *supra*, 319 U.S. at 392.

CONCLUSION

For the reasons stated, the judgment should be affirmed, and the judgment in No. 94-2081 vacated and remanded.

²⁵ As of this week 30 district courts have issued opinions applying the Federal Circuit's decision here. None has expressed the slightest difficulty or dismay except the District of Delaware, whose criticism centered on the standard of appellate review. See Pet. Br. 48-49.

Respectfully submitted,

JOHN G. KESTER *

J. ALAN GALBRAITH

WILLIAM E. McDANIELS

WILLIAMS & CONNOLLY

725 12th Street, N.W.

Washington, D.C. 20005

(202) 434-5000

Attorneys for Amicus Curiae

Of Counsel:

ARTHUR R. MILLER

1545 Massachusetts Avenue

Cambridge, Mass. 02138

(617) 495-4111

THOMAS R. BREMER

Senior Vice President

and General Counsel

JOHN C. ANDRES

Chief Patent Counsel

United States Surgical

Corporation

150 Glover Avenue

Norwalk, Conn. 06856

(203) 845-1000

* Counsel of Record

December 8, 1995

DEC 8 1995

No. 95-26

CLERK

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

Herbert MARKMAN and POSITEK, Inc.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, Inc.
and ALTON ENTERPRISES, Inc.,
Respondents.

On Writ Of Certiorari To The United States
Court of Appeals for the Federal Circuit

BRIEF ON BEHALF OF THE
AMERICAN AUTOMOBILE
MANUFACTURERS ASSOCIATION
AS AN AMICUS CURIAE
IN SUPPORT OF THE RESPONDENTS

Phillip D. Brady
Andrew D. Koblenz
AMERICAN AUTOMOBILE
MANUFACTURERS
ASSOCIATION
Suite 900
1401 H Street, N.W.
Washington, D.C. 20005
Telephone: (202) 326-5500

Charles W. Bradley
Counsel of Record
Stanley L. Amberg
Lawrence B. Goodwin
Robert A. Cote
ORRICK, HERRINGTON & SUTCLIFFE
666 Fifth Avenue
New York, NY 10103-0001
Telephone: (212) 506-5000

Counsel for AMERICAN AUTOMOBILE MANUFACTURERS ASSOCIATION

50 p/2

TABLE OF CONTENTS

TABLE OF CONTENTS	i
TABLE OF AUTHORITIES	iii
I. THE INTEREST OF AMICUS CURIAE . . .	1
II. THE CERTIFIED QUESTION	1
III. SUMMARY OF ARGUMENT	2
IV. ARGUMENT	5
A. The Public Interest in Patents, and the Major Influence of Patents on Industrial Growth, Require that Patent Disputes be Decided on a Principled and Predictable Basis	5
B. When the Meaning of a Patent Claim is Clear from the Claims of the Patent, the Patent Specification and its Prosecution History, Claim Construction is an Issue of Law for the Court	7
C. Different Types of Extrinsic Evidence Concerning Patent Claims Require Different Consideration	12
1. A Guiding Hand	13
2. Opinion Testimony	13

3.	Evidence that Creates a Dispute as to Words or Phrases that are Unassociated with the Relevant Technology, or that Concern Grammatical Construction	14
4.	Evidence that Conflicts with the Patent or its Prosecution History	14
5.	Evidence concerning the Relevant Historical Meaning of a Word	14
D.	There is No Seventh Amendment Right To a Jury Trial for the Construction of a Patent Claim Even When Extrinsic Evidence of a Historical Meaning is Required and Introduced	15
E.	Other Factors	25
V.	CONCLUSION	29
Appendix 1 (containing 35 U.S.C §§ 102, 103, 112, 153, 154, 281-285)	A-1
Appendix 2 (A United States Patent Grant)	A-6
Appendix 3 (early English cases)	A-7

TABLE OF AUTHORITIES

CASE LAW

<i>Arkwright v. Nightingale</i> , Davis Patent Cases 37 (Common Pleas 1785)	18
<i>Aro Mfg. Co. v. Convertible Top Replacement Co.</i> , 365 U.S. 336, 81 S.Ct. 599 (1961)	7, 10
<i>Becton Dickinson And Co. v. C.R. Bard, Inc.</i> , 922 F.2d 792 (Fed. Cir. 1990)	13
<i>Blanchard v. Sprague</i> , 3 F.Cas. 648, 3 Sumn. 535, 2 Story, 164 (Cir. Ct. D. Mass. 1839)	24
<i>Bloomer v. Stolley</i> , 3 F.Cas. 729, 5 McLean 158, 8 West. Law J. 158 (Cir. Ct., D. Ohio 1850)	24
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141, 109 S.Ct. 971 (1989)	6, 24
<i>Bovill v. Moore</i> (C.P. 1816), John Davies, A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees 361 (London 1816) . . .	A-7
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 212 (1853)	6

<i>Burr v. Duryee</i> , 68 U.S. (1 Wal.) 531 (1863)	A-7
<i>Chandris, Inc. v. Latsis</i> , 115 S.Ct. 2172 (1995)	23
<i>Charles River Bridge v. Warren Bridge</i> , 36 U.S. (11 Peters) 420 (1837)	22
<i>Chauffeurs, Teamsters and Helpers Local No. 391 v. Terry</i> , 494 U.S. 558, 110 S.Ct. 1340 (1990)	16, 17
<i>Dairy Queen v. Wood</i> , 369 U.S. 469 (1962)	27
<i>Evans v. Eaton</i> , 3 Wheat (16 U.S.) 454 (1818)	24
<i>Genentech, Inc. v. Wellcome Foundation Ltd.</i> , 29 F.3d 1555 (Fed. Cir. 1994)	22
<i>General Electric Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364, 58 S.Ct. 899 (1938)	6
<i>Graham v. John Deere Company</i> , 383 U.S. 1, 86 S.Ct. 684 (1966)	10, 24
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33, 109 S.Ct. 2782 (1989)	17
<i>Hill v. Evans</i> , 4 De G.F. & J. 288, 45 E.R. 1195 (Ch. 1862)	19, 20

<i>Hill v. Thompson</i> , 150 Eng. Rep. 427 (Ex. D. 1818)	A-8
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 436 (1848)	10
<i>Intellicall, Inc. v. Phonometrics, Inc.</i> , 952 F.2d 1384 (Fed. Cir. 1992)	14
<i>Johnston v. Ivac Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989)	13
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. (5 Otto) 274 (1877)	9
<i>Leavenworth R.R. Co. v. U.S.</i> , 92 U.S. 733 (1875)	21
<i>Markman v. Westview Instruments</i> , 52 F.3d 983 (Fed. Cir. 1995)	10, 11
<i>McClain v. Ortmyer</i> , 141 U.S. 419, 12 S.Ct. 76 (1891)	6
<i>McDermott International Inc. v. Wilander</i> , 498 U.S. 337, 111 S.Ct. 807 (1991)	23
<i>Minter v. Wells</i> (Ex. 1834), 1 Thomas Webster, Reports and Notes of Cases on Letters Patent for Inventions 166 (London, A. Milliken and T. Clark 1841) 1 William Carpmael, Law Reports of Patent Cases 1 (London, A. MacIn- tosh 1851)	A-8, A-9

<i>Missouri, Kansas And Texas Ry. Co. v. Kansas Pacific Ry. Co.</i> , 97 U.S. 491 (1878)	21
<i>Morgan v. Seward</i> , (Ch. 1835) 1 Thomas Webster, Reports and Notes of Cases on Letters Patent for Inventions 166 (London, A. Milliken and T. Clark 184), 2 William Carpmael, Law Reports of Patent Cases 1 (London, A. MacIn- tosh 1851)	A-9, A-10
<i>Neilson v. Harford</i> , 8 M & W 806, 1 Webster Patent Cases 295, 151 E.R. 1266 (Exch. of Pleas 1841)	19, 20
<i>Rescue Army v. Municipal Court of Los Angeles</i> , 331 U.S. 549, 67 S.Ct. 1409 (1947)	12
<i>Roche Products v. Bolar Pharmaceutical Co.</i> , 733 F.2d 858 (Fed. Cir. 1984), cert. denied, 469 U.S. 856, S.Ct. 183 (1984)	17
<i>Root v. Railway Co.</i> , 105 U.S. 189 (1881)	16
<i>Ross v. Bernhard</i> , 396 U.S. 531, 90 S.Ct. 733 (1970)	17
<i>Schulenberg v. Harriman</i> , 88 U.S. (21 Wal.) 44, (1874)	20

<i>Shatterproof Glass Corp. v. Libbey-Owens Ford Co.</i> , 758 F.2d 613 (Fed. Cir. 1985), cert. denied, 474 U.S. 976, 106 S.Ct. 1640 (1985)	17
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	10
<i>Southwall Technologies v. Cardinal IG Co.</i> , 54 F.3d 1570 (Fed. Cir. 1995)	14
<i>The Attorney General v. The Cast-Plate Glass Company</i> , 1 Anst. 39, 145 E. R. 793 (1792)	22
<i>TSC Industries, Inc. v. Northway, Inc.</i> , 426 U.S. 438, 96 S.Ct. 2126 (1976)	23
<i>Tull v. United States</i> , 481 U.S. 412, 107 S.Ct. 1831 (1987)	16, 18
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1787)	18, 19
<i>U.S. v. Gaudin</i> , ___ U.S. ___, 115 S.Ct. 2310 (1995)	23
<i>United Carbon Co. v. Binney & Smith Co.</i> , 317 U.S. 228, 63 S.Ct. 165 (1942)	5
<i>United States v. Arredondo</i> , 31 U.S. (6 Pet.) 691 (1832)	20
<i>United States v. King et al.</i> , 48 U.S. 833 (7 How.) (1849)	20

<i>W.L. Gore & Associates, Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983)	13, 14
<i>Webster v. Uther</i> (K.B. 1824), 1 Benjamin Vaughn Abbott, Decisions on the Law of Patents for Inventions Rendered by English Courts Since the Beginning of the Seven- teenth Century 21 (Washington, Charles R. Brodix 1887)	A-8
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1853)	10
<i>Winona & St. Peter RR. Co. v. Barney</i> , 113 U.S. 618 (1884)	21
<i>Wisconsin Central R'D Co. v. Forsythe</i> , 159 U.S. 46 (1895)	21

STATUTES & RULES

35 U.S.C. § 102	10
35 U.S.C. § 103	10
35 U.S.C. § 112	8, 10, 26, 28
35 U.S.C. § 153	3
35 U.S.C. § 154	16
35 U.S.C. § 281	16
35 U.S.C. § 283	17
35 U.S.C. § 284	17
35 U.S.C. § 285	17
Patent Act of July 4, 1836, c. 357, 4 Stat. 577	8, 9, 24
Patent Act of July 8, 1870, c. 230, 16 Stat. 198	9
Rule 53, Fed. R. Civ. P.	27
U.K. Patents Act of 1883	9

Other Authority

3 Patent Law Perspectives, § 7.6 [2.-2], pp. 7-228.47-.48	18, 26
3 Sutherland Statutory Const. (4th Ed), § 63.01	22
13 Writings of Thomas Jefferson (Memorial ed. 1904)	6
37 CFR 1.2	8
37 CFR 1.75(d)(1)	8
Curtis, Law of Patents § 306 n.1 (3rd ed. 1867)	A-1
Senator Ruggles report to the Senate, April 28, 1836, reprinted in J. of the Pat. Office Society, Vol. 18, No. 7, pp. 92-94 (1936)	8
Trial By Jury, by Sir Patrick Devlin, Sweet & Maxwell Ltd., 1988	27

I. THE INTEREST OF AMICUS CURIAE

The American Automobile Manufacturers Association (AAMA) is a non-profit national trade association. Its member companies, Chrysler Corporation, Ford Motor Company, and General Motors Corporation, are principally engaged in the production and sale of motor vehicles.

The AAMA has no interest in which party prevails in this case. Its sole interest is in the law that this case may establish. Consent documents by both parties have been filed.

To compete effectively in the worldwide automotive market, the AAMA companies are heavily involved in technological development and the large financial investments needed to support that development. It is their view that decisions on when and how to undertake such investments cannot be made rationally without the assurance of a principled resolution of disputes concerning patents, and a consequent ability to determine effectively, generally without recourse to expensive litigation and unpredictable risks, the extent of existing patent rights. Hence, the AAMA supports the decision of the Court of Appeals for the Federal Circuit in this case holding that the construction of patent claims must be undertaken by a court trained in construing documents as a matter of law.

II. THE CERTIFIED QUESTION

Unlike patents in the 18th century, today's patents are required by the Patent Act to contain claims that set the metes and bounds of the patent grant. As a consequence, although the question certified in this case refers to "genuine factual disputes about the meaning of a patent," rather than, the "meaning of the **claims** of a patent," we understand the question to have reference specifically to the "claims" of a

patent. Also, the reference to "genuine factual disputes" should not becloud the fact that the inquiry in this case concerns the construction or interpretation of the words of a government grant.

III. SUMMARY OF ARGUMENT

In facing the issue of patent claim construction, one must be mindful that uncertainty and unpredictability inhibit needed investments in technology and encourage baseless suits. Principled claim construction, on the other hand, especially at an early phase of a complex patent suit, will foster settlement, streamline trials and promote efficient use of judicial resources.

The law appears to be settled, and the parties appear to be in agreement, that when the construction of a patent claim is clear from the basic documents that comprise the patent and its prosecution history before the Patent and Trademark Office, the issue of claim construction is for the court. The district court and ten of the eleven participating judges on the Court of Appeals found the meaning of the disputed word -- "inventory" -- to be clear from the Markman patent and its prosecution history. If this ruling is adopted, it may not be appropriate for the Court to undertake a review of the Constitutional issue that may arise when extrinsic evidence is required and that evidence projects a genuine dispute as to the meaning of a technical word to persons skilled in the relevant field.

If the Constitutional issue is addressed, care must be exercised not to treat all forms of extrinsic evidence the same. Some such evidence is merely testimony guiding the court through the basic documents, or opinion testimony as to the meaning of a phrase, or entire claim, without any first-hand testimony or other evidence of the meaning of a word in the relevant technology at the relevant time. Also,

extrinsic evidence may involve only grammatical construction, or the meaning of non-technical words, or evidence that contradicts the patent or its prosecution history. Only evidence concerning the meaning of a word of a claim to those skilled in the relevant technology at the relevant time -- which is less common than other forms of extrinsic evidence -- can raise a significant question as to a Seventh Amendment right to a jury trial concerning claim construction. We believe, however, that that question must be answered in the negative.

While the issue of patent infringement, in a suit for money damages, may well be for the jury, the same does not follow for all of the issues in suit. As this Court has held, it is the nature of the issue, rather than the nature of the overall action, that determines the right to a jury trial.

To place the issue in its proper perspective we are here dealing with a government grant that is defined by words, specifically the words of a patent claim. Under a Congressional mandate, and the delegation of Congressional power to reward inventors, the rights-defining words of the claim have been examined by the Patent and Trademark Office and found to be patentable in substance and sufficiently clear in expression.^{1/}

Turning to the case law in England in 1791, which is determinative of the right to a jury trial "preserved" by the Seventh Amendment, we find no parallel or analogy to modern patent claim construction in the English patent cases. At that time, claims were not employed to define the scope of a patent. Rather, fact findings were involved, first to

^{1/}For convenient reference, a patent grant, which encompasses the scope-defining claims is included in an Appendix 2. It illustrates that the grant issues in the name of the United States of America. See 35 U.S.C. § 153.

determine what subject matter in the specification of a patent was new, by a comparison of the description in the specification with the prior art of record, and second to determine whether infringement was present, by determining whether the accused device was the same as, or a colorable variation of, the subject matter found to be new. Today, claim construction is not such a factual test of sameness, but a judgmental assessment of the meaning of a word-defined government grant.

Rather than the early English **patent** cases, the closest analogy in the 18th century English cases is to be found in the construction or interpretation of government grants -- particularly government grants defined by words. One example was patents for land or land grants, and there are others. The construction of such grants was the province of the court.

Patents in the U.S. have on infrequent occasions resulted from direct Congressional enactments. There can be little doubt that, as in the case of other legislation, the scope of such patents must be construed by the court as a matter of law. Under the current Patent Act, Congress has delegated this legislative function to the Patent and Trademark Office (PTO), with specifically prescribed qualifying standards, and a mandate as to the manner in which the grant is to be defined.

Whether this legislative function is exercised directly by Congress, or through a proper and circumscribed delegation to the PTO, the construction of the resulting government grant must be a matter of law for the court -- as was true of the construction of government grants in England in 1791 -- using whatever assistance the court may find helpful to inform itself as to the meaning of words and the general nature of the relevant technology.

IV. ARGUMENT

A. The Public Interest in Patents, and the Major Influence of Patents on Industrial Growth, Require that Patent Disputes be Decided on a Principled and Predictable Basis

Since patent claims fix the boundary between proprietary rights and the public domain, the proper, consistent and predictable construction of such claims is critical to the rapid and fair advance of technological development. So long as claim scope is uncertain and unpredictable, investors must be wary and technological advance will suffer.

Modern automotive production plants in the United States require an investment of a billion dollars or more. And the same is true in other industries. Such an investment may be expected to face the risks of an economic downturn and other business factors, but it should not have to face the prospect of being at sea concerning how the claims of existing patents are likely to be construed.

If the investments that keep the advance of technology churning, and provide the fuel for U.S. industries to compete effectively, cannot be made in reliance on a principled and predictable resolution of patent rights, the only safe course will be to plot a wide course around any existing patent claims, with the attendant inability to use what is truly in the public domain. As this Court stated in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S.Ct. 165, 170 (1942):

A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage inven-

tion only a little less than unequivocal foreclosure of the field.

To the same effect is *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853); *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 58 S.Ct. 899, 902 (1938).

Uncertainty also undermines confidence in the patent system, and fans the fires of baseless suits. With the potential returns high in a patent suit, a patent owner need only survive summary proceedings to be able to roll the dice before an untrained, and generally overwhelmed, jury. Principled and predictable claim construction by the court can weed out baseless suits. Also, such claim construction can occur early in a litigation, once both sides have had an opportunity to determine the nature of the accused subject matter. Consequently, it will foster settlement, streamline trials and promote an efficient utilization of judicial resources.

In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 147-8, 109 S.Ct. 971, 975-6 (1989), this Court observed the careful balance that exists, under the law governing patents, between proprietary rights and those that are free to all. The Court quoted from the writings of Thomas Jefferson that:

... from the outset, federal patent law has been about the difficult business "of drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." 13 Writings of Thomas Jefferson (Memorial ed. 1904), at 335.

In today's patent system it is the claims of a patent that draw this line. *McClain v. Ortmyer*, 141 U.S. 419, 424, 12

S.Ct. 76, 77 (1891); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339, 81 S.Ct. 599, 601 (1961).

Some of the arguments opposing the Court of Appeals' ruling in this case sound in public policy, but they are generally addressed to the cherished status of the Seventh Amendment, and its asserted applicability to all factfinding, rather than the desirability *vel non* of having a lay jury determine the meaning of words in the modern world of complex technology. Indeed, it would be difficult to imagine a sound public policy that would favor giving to a jury an issue of determining the meaning of technological terms that may be too complex for a judge, with no real opportunity to redress errors. In any event, however, the public policy issue has been resolved by Congress. Having the power to do so, Congress has declined to provide in the Patent Act that the construction of patent claims is for the jury.

Thus, the issue is drawn. There is no legislative mandate for a jury trial on patent claim construction, and consequently this issue is for the court unless the Seventh Amendment compels its resolution by the jury.

**B. When the Meaning
of a Patent Claim is Clear
from the Claims of the Patent, the
Patent Specification and its
Prosecution History, Claim
Construction is an Issue
of Law for the Court**

As the majority opinion of the Federal Circuit in this case has observed, the Patent Act provides that a patent shall conclude with one or more claims that particularly point out and distinctly claim the subject matter that an applicant for

a patent regards as his or her invention. 35 U.S.C. § 112, ¶ 2.

Moreover, the rules of the Patent and Trademark Office (PTO), which have the effect of law, provide that:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 CFR 1.75(d)(1).

Also, in relation to the prosecution of patent applications before the PTO, its rules provide that:

All business with the Patent and Trademark Office should be transacted in writing. ... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. 37 CFR 1.2

These provisions are part of a congressional plan that began with the Patent Act of 1836, which, for the first time in any country, established a Patent Office, and provided a systematic examination process for the evaluation of applications for patents. Patent Act of July 4, 1836, c. 357, 4 Stat. 577. The 1836 act was intended to curb the abuses of granting patents without any real screening. See Senator Ruggles report to the Senate, April 28, 1836, reprinted in J. of the Pat. Office Society, Vol. 18, No. 7, pp. 92-94 (1936).

The 1836 Act was also the first Patent Act that made reference to claims, saying that the inventor "shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery". Section 6, 1836 Patent Act, *supra*. The effect was to place on the Patent Office the responsibility of ascertaining the scope of the invention and seeing that its boundaries are properly defined in words. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 278 (1877). Thereafter, the 1870 Patent Act made clear that a patent must include **claims to define the scope of the patent grant**. It provided that the inventor "shall particularly point out and distinctly claim" his invention or discovery. Section 26, Patent Act of July 8, 1870, c. 230, 16 Stat. 198.

Similarly, in England in 1791 there was no statutory requirement for patent claims, and no examination of patent applications. Instead, a jury had to sort through a patent granted without examination to determine what was new and what was old, and then determine whether the accused device was the same as, or a colorable variation of, what was found to be new. See the cases quoted in the accompanying Appendix 3, *infra*. British patents were first required to contain claims in 1883, by the Patents Designs and Trade Marks Act of 1883.^{2/}

In contrast to the situation in England and the U.S. in 1791, we now have patent claims. The Patent Act now

^{2/}Section 5 of the U.K. Patents Act of 1883, in pertinent part, was as follows:

(5). A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

requires that the PTO ensure that the claims allowed an applicant are unambiguous, that they meet other requirements, and that they do not encompass the earlier inventions of others or other prior art. 35 U.S.C. §§ 102, 103 & 112; *Graham v. John Deere Company*, 383 U.S. 1, 86 S.Ct. 684, (1966). This process results in a **governmental grant** of exclusivity, namely, the right to exclude others from operating within specified borders, **the scope of which is fixed by the words of the allowed claims.** *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. at 339, 86 S.Ct. at 601.

Thus, as will be discussed, whatever may have been the role of the jury under the different patent system that existed in 1791, both in England and in this country, the present-day patent system mandates that a patent contain rights-defining claims. Those claims being a government grant, it is for the Court to construe them as an issue of law -- the construction being performed with the aid of certain basic documents comprising the patent and its prosecution history, and any useful extrinsic evidence.²

²See, e.g., *Hogg v. Emerson*, 47 U.S. (6 How.) 436, 485 (1848) (The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles, as we have endeavored to on this occasion, ...); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853) (The construction of the claim was undoubtedly for the court.); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853) (The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them.); and the other authorities cited in the opinion below. *Markman v. Westview Instruments*, 52 F.3d 983, 977-8 (Fed. Cir. 1995).

The parties and the Court of Appeals appear to agree that patent claim construction is for the court when the meaning of the patent claim is clear from the basic documents.

In this regard, we note that the opinions expressed by ten of the eleven judges of the Court of Appeals who participated in the decision in this case, as well as that of the district court, held that the meaning of the disputed term "inventory" is clear from the basic documents, namely, the Markman patent and its prosecution history, as follows:

In this case, as fully discussed above, *the patent and prosecution history make clear* that "inventory" in claim 1 includes in its meaning "articles of clothing. ... based on the patent and prosecution history, that the claim term "inventory" means articles of clothing. (Emphasis added.) (*Markman* majority, 52 F.3d, at 983)

* * * *

Close examination of these cases, however, reveals that, *like the one before us today*, interpretation of the claims at issue before the deciding court *presented no real factual question*. (Emphasis added.) (*Markman*, J. Mayer concurrence, 52 F.3d, at 993)

* * * *

In this case, *the claims, specification, and prosecution history irrefutably show* that case transaction totals are not "inventory." (Em-

phasis added.) (*Markman*, J. Rader concurrence, 52 F.3d, at 998)

While, as an amicus, we decline to address the issue of the clarity of the basic documents to define the word "inventory", since this principally affects the parties, we agree with the view of the judges of the Court of Appeals, as well as the parties and the case law, that if the meaning of a patent claim is clear, from a review of the patent and its prosecution history before the PTO, construction of the claim is solely an issue of law for the court.

Also, we note that if such clarity exists in this case, it may be inappropriate for the Court to reach the Seventh Amendment constitutional issue in its review of the Court of Appeals judgment. *Rescue Army v. Municipal Court of Los Angeles*, 331 U.S. 549, 568-570, 67 S.Ct. 1409, 1419-1420 (1947).

C. Different Types of Extrinsic Evidence Concerning Patent Claims Require Different Consideration

Before discussing the question of the proper role of the court and jury in construing patent claims when extrinsic evidence is required and introduced, we note that it would be a mistake to treat all forms of extrinsic evidence the same. By extrinsic evidence we mean anything that is extrinsic to the basic documents, which are the patent at issue and its prosecution history. It must be recognized that extrinsic evidence can, and in patent cases often does, fall into at least the following distinct categories.

1. A Guiding Hand

Such evidence may take the form of guiding testimony of a technical expert or patent expert, leading the court through the patent and its prosecution history in order to earmark the portions thereof that are believed to be relevant to a proper construction of the claims. Such testimony is not uncommon, and while it may be helpful, it cannot lessen the obligation of the court to construe the claims as a matter of law.

2. Opinion Testimony

Another common form of extrinsic evidence is the opinion testimony of experts, based on their expertise in the field, as to how a word or phrase of a claim, or an entire claim, should be construed -- without supporting evidence as to the accepted meaning of a word in the claim, in the relevant field at the relevant time. This testimony, in effect, states merely how each expert would construe the claim if he or she were the judge, or at least how he or she proposes that the court or jury do so. Such testimony is to be distinguished from testimony by a witness based on first-hand knowledge, or relevant contemporaneous publications, concerning the accepted meaning of a word in a claim in the relevant field at the relevant time -- namely at the time the application for the patent was filed. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983). This opinion testimony is but a legal conclusion that cannot lessen the court's obligation to construe the claims as a matter of law. *Johnston v. Ivac Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989); *Becton Dickinson And Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 797 (Fed. Cir. 1990).

3. **Evidence that Creates a Dispute as to Words or Phrases that are Unassociated with the Relevant Technology, or that Concern Grammatical Construction**

This same rule should apply when the meaning of the words of a claim are in dispute, when the dispute involves only their ordinary meaning, unassociated with any particular technology, or when the dispute involves only punctuation or grammatical construction. The resolution of such disputes appears to be clearly the province of the court.

4. **Evidence that Conflicts with the Patent or its Prosecution History**

Extrinsic evidence may also take the form of evidence of claim meaning that is contrary to the specification or prosecution history -- but such evidence similarly cannot present a fact issue for the jury. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992); *Southwall Technologies v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

5. **Evidence concerning the Relevant Historical Meaning of a Word**

A different analysis may be required when the extrinsic evidence concerns the historical meaning of a word in the relevant technology, namely, first-hand testimony or documentary evidence of what a particular word in a patent claim meant in the relevant field at the time the application for the patent was filed. *Gore v. Garlock*, *supra*. If such evidence is not in conflict with the basic documents, since a meaning established by those documents prevails over the normal meaning in the field, *Southwall v. Cardinal*, *supra*,

and if a genuine dispute is presented by the evidence, a serious question as to the right to a jury trial is presented. Nevertheless, for reasons that will be discussed, we believe that even in this situation the extrinsic evidence is properly subsumed in the legal claim construction process.

Before leaving this point, we note that this discussion concerns the meaning of a "word" in the claim, rather than a phrase. It would equally be true where a phrase is involved, in the relatively few instances in which a phrase had a particular meaning in the field at the relevant time. More likely, however, when a phrase is involved, the contest is a grammatical one, namely, interpreting the construction of several words used in a particular pattern, the meaning of each of which is known. This appears to be clearly the province of the court.

In short, in considering the issue of extrinsic evidence, it is not appropriate to treat all such evidence with a broad brush. The question of a right to a jury trial is raised most squarely in relation to conflicting evidence concerning the historical meaning of a word in the claim, that is, testimony based on first-hand knowledge, or documentary evidence, concerning how a word in the claim was actually used, and understood, in the particular technology at the time in question.

As will be discussed, however, it is the view of this amicus that there is no Seventh Amendment right to a jury trial even as to this extrinsic, historical evidence.

D. There is No Seventh Amendment Right To a Jury Trial for the Construction of a Patent Claim Even When Extrinsic Evidence of a Historical Meaning is Required and Introduced

Turning to the issue of whether the Seventh Amendment gives rise to the right to a jury trial for the construction

of a patent claim when extrinsic evidence of the historical meaning of a word is required and introduced, as far as we have been able to discern, this is an issue of first impression for this Court.^{4/}

We note first that the Seventh Amendment provides that "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved..." The term "preserved" speaks as of the year the Seventh Amendment was ratified, in 1791, and, as this Court has held, it relates to the law in the English courts at that time. *Tull v. United States*, 481 U.S. 412, 417, 107 S.Ct. 1831, 1835 (1987). The reference to "Suits at common law" concerns "'suits in which legal rights [are] to be ascertained and determined, in contradistinction to those where equitable rights alone [are] recognized, and equitable remedies [are] administered.'" *Chauffeurs, Teamsters and Helpers Local No. 391 v. Terry*, 494 U.S. 558, 564, 110 S.Ct. 1340, 1344 (1990). This includes "causes of action created by Congress," *Chauffeurs*, 494 U.S. at 564-565, 110 S.Ct. at 1344, including patent causes, *Root v. Railway Co.*, 105 U.S. 189 at 206-207 (1881).^{5/}

^{4/}As mentioned previously, the Court need not reach this issue if it concludes that the meaning of the disputed claim word -- "inventory" -- is clear from the patent and its prosecution history.

^{5/}The statutory cause of action in this case is a "civil action for infringement" of a patent. 35 U.S.C. § 281. A patentee is granted the "right to exclude others from making, using, or selling the invention..." and, in the case of process claims, "the right to exclude others from using or selling in the United States, or importing into the United States," (continued...)

In *Ross v. Bernhard*, 396 U.S. 531, 538, 90 S.Ct. 733, 738 (1970), the Court ruled that the right to a trial by jury depends on the nature of the issue to be tried, rather than the character of the overall action. To resolve that right for a particular issue, the Court requires a two-step examination, first, of the nature of the issue and, second, of the remedy sought. *Chauffeurs*, 494 U.S. at 565, 110 S.Ct. at 1344. While the Court has held that the second prong of this two-part test is the more important, *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42, 109 S.Ct. 2782, 2790 (1989), since legal damages were sought in this suit, only the first prong need be considered.

As the issue here is the construction of a patent claim when extrinsic evidence of the historic meaning of one or more words in the claim is required and introduced, this

^{5/}(...continued)

products made by that process." 35 U.S.C. § 154. Section 281 vindicates those rights by giving to the patentee the "remedy" of "civil action for infringement of his patent." Sections 283 (injunctions), 284 (damages adequate to compensate for the infringement) and 285 (attorney fees) provide the forms of relief that are available to the patentee pursuant to that remedy. Only damages are mandated ("shall award"). The grant of an injunction is discretionary ("may grant ... principles of equity"), *Roche Products v. Bolar Pharmaceutical Co.*, 733 F.2d 858, 865 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 856, 105 S.Ct. 183 (1984), as is the award of reasonable attorneys fees ("may"), *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 629 (Fed. Cir. 1985), *cert. denied*, 474 U.S. 976, 106 S.Ct. 1640 (1985). The same right/remedy/relief trilogy has been present since the first patent statute, in 1790, with varying limitations on the forms of remedy and relief.

issue must be compared to the most closely analogous 18th-century counterpart in England. *Tull v. United States*, 481 U.S. at 417, 107 S.Ct. at 1835.

As already noted, in 1791 patents in England were not required by statute to contain claims. Thus, there was no direct parallel in England in 1791 to the issue of construing a patent claim. Rather, as already noted, a resolution of the issue of infringement in England at that time required the jury to sort out what in the specification was new, from that which was old, and determine whether the accused device was the same as the new device, or a "mechanical equivalent" or "colourable variation" thereof. See the cases quoted in the Appendix 3 hereto, *infra*. This process involved factual determinations. The specification was compared with the prior art of record to determine what was new, and the elements or apparatus thus determined to be new were compared to the accused apparatus.

There are thus two factors that are relevant here. First, the process followed in the 1791 infringement analysis in England does not provide an analogous issue to today's claim construction, and, second, in addition to the lack of any direct analogy, the nature of the determinations is different -- one being a factual determination of sameness, as compared to the prior art and to the accused device -- while the other is a judgmental construction of a definitive expression of the metes and bounds of a particular type of government grant. See 3 Patent Law Perspectives, § 7.6 [2.-2], pp. 7-228.47-.48.

The petitioner cites early English cases for the view that English juries were instructed to decide questions that required them to interpret terms of art in patents, citing *Arkwright v. Nightingale*, Davis Patent Cases 37 (Common Pleas 1785); and *Turner v. Winter*, 1 T.R. 602, 605 (K.B. 1787). Significantly, in neither of these cases was there a dispute over the meaning of any words in the specification of

the patent in suit. The opinion in the *Turner* case, for example, sets forth the relevant portion of the specification. There is no indication that the meaning of any of the words in the quoted portion of the specification was in dispute. Instead, not all of the disclosed fossil salts were found to work; indeed, only one such salt, "sal gem", was found to work. A question arose, therefore, whether the specification was calculated to mislead by its reference to fossil salts generally.

Later cases in England are more enlightening, but it is not clear that they reflect the law as of 1791. *Neilson v. Harford*, 8 M & W 806, 1 Webster Patent Cases 295, 151 E.R. 1266 (Exch. of Pleas 1841); *Hill v. Evans*, 4 De G.F. & J. 288, 45 E.R. 1195 (Ch. 1862). In the *Neilson* case, the court, rather than the jury, interpreted the word in the specification that was in question -- "effect" -- but the court suggested the following general rule:

Then we come to the question itself, which depends on the proper construction to be put on the specification. It was contended that of this construction the jury were to judge. We are clearly of a different opinion. The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury: and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art, or phrases used in commerce, and no surrounding circumstances to be ascertained; or conditionally, when those words or circum-

stances are necessarily referred to them. Unless this were so, there would be no certainty in the law; for a misconstruction by the Court is the proper subject, by means of a bill of exceptions, of redress in a Court of Error; but a misconstruction by the jury cannot be set right at all effectually. *Neilson v. Harford*, 151 E.R. at 1273

This rule was restated in *Hill v. Evans*, 45 E.R. at 1197, a suit in equity.

Assuming therefore that in resolving the issue of novelty or infringement in England in 1791, by comparing the described device with the prior art or the accused device, the jury was left to determine the meaning of disputed technical terms in the description, that determination has little to do with construing the words of a patent claim, which, in today's patent system, is a **definitive government grant**. Rather, a closer parallel to a government grant defined by a patent claim is the interpretation in the English cases in 1791 of government grants by parliament or the Crown.

The cases make clear that the construction of early government grants was an issue of law for the court. In *United States v. King et al.*, 48 U.S. 833 (7 How.) (1849), while neither party demanded a jury trial, *Id.*, at 844, the Court held that the construction of a land grant is a question of law to be decided by the court. *Id.*, 847. See, also *Schulenberg v. Harriman*, 88 U.S. (21 Wal.) 44, 62 (1874) ("A legislative grant operates as a law as well as a transfer of the property, ..."). Also, in the case of *United States v. Arredondo*, 31 U.S. (6 Pet.) 691 (1832), the land grant provided that proceedings concerning it were to be undertaken according to the rules of a Court of equity, and there was no Seventh Amendment challenge to this provision.

In *Missouri, Kansas And Texas Ry. Co. v. Kansas Pacific Ry. Co.*, 97 U.S. 491, 497 (1878), the Court stated in reference to land grants that:

It is always to be borne in mind, in construing a congressional grant, that the act by which it is made is a law as well as a conveyance, and that such effect must be given to it as will carry out the intent of Congress. That intent should not be defeated by applying to the grant the rules of the common law, which are properly applicable only to transfers between private parties.

To the same effect is *Winona & St. Peter RR. Co. v. Barney*, 113 U.S. 618, 625 (1884) and *Wisconsin Central R'D Co. v. Forsythe*, 159 U.S. 46, 55 (1895).

And in *Leavenworth R.R. Co. v. U.S.*, 92 U.S. 733, 740 (1875), the Court ruled that:

All grants of this description are strictly construed against the grantee; nothing passes but what is conveyed in clear and explicit language ...

* * * *

If these terms are plain and unambiguous, there can be no difficulty in interpreting them; but, if they admit of different meanings, -- one of extension, and the other of limitation, -- they must be accepted in a sense favorable to the grantor. ... In other words, what is not given expressly, or by necessary implication, is withheld.

To the same effect is *Charles River Bridge v. Warren Bridge*, 36 U.S. (11 Peters) 420, 543-4 (1837); and the recent patent case of *Genentech, Inc. v. Wellcome Foundation Ltd.*, 29 F.3d 1555, 1564-5 (Fed. Cir. 1994).

Government grants that convey land or other benefits are thus subject to the same rules of interpretation as other statutes. 3 Sutherland Statutory Const. (4th Ed), § 63.01, at 134. The case of *The Attorney General v. The Cas:-Plate Glass Company*, 1 Anst. 39, 145 E. R. 793, 795 (1792) indicates how statutes were being construed in England circa 1791 in relation to the interpretation of the word "square" as used in the trade. In this case, the Court stated that:

In explaining an act of parliament, it is impossible to contend, that evidence should be admitted; for that would be to make it a question of fact, in place of a question of law. The judge is to direct the jury as to the point of law, and in doing so, must form his judgment of the meaning of the legislature in the same manner as if it had come before him by demurrer, where no evidence could be admitted. Yet on demurrer, a Judge may well inform himself from dictionaries or books on the particular subject concerning the meaning of any word. If he does so at Nisi Prius, and shews them to the jury, they are not to be considered as evidence, but only as the grounds on which the Judge has formed his

opinion, as if he were to cite any authorities for the point of law he lays down.⁸²

Turning to patents for inventions, we note that the power of Congress to grant patents stems from Article I, Section 8, of the Constitution, which grants to Congress the power to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the

⁸²The amicus brief filed on behalf of Litton cites cases for the view that the interpretation of the words of statutes is for the jury, but in those cases the jury decided only the application of the statutes to the facts, rather than construing the terms of the statute. *U.S. v. Gaudin*, ___ U.S. ___, 115 S.Ct. 2310 (1995) (the meaning of the statutory word "material" is an issue of law); *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438, 96 S.Ct. 2126 (1976) (same); *Chandris, Inc. v. Latsis*, 115 S.Ct. 2172 (1995) (the same as to the word "seaman"); *McDermott International Inc. v. Wilander*, 498 U.S. 337, 111 S.Ct. 807 (1991) (the same as to "Member of the crew"): In these cases, this Court stated that:

Because statutory terms are at issue, their interpretation is a question of law and it is the court's duty to define the appropriate standard.

Chandris, 115 S.Ct. at 2190.

"Member of a crew" and "seaman" are statutory terms; their interpretation is a question of law.

McDermott, 498 U.S. at 356, 111 S.Ct. at 818.

exclusive right to their respective writings and discoveries." This Court has held that this clause is limited in the respect that the exclusive rights that Congress grants must be "to promote science and useful arts", *Graham v. John Deere Company*, 383 U.S. 1, 5; 86 S.Ct. 684, 687 (1966), *Bonito Boats v. Thunder Craft Boats*, *supra*, but the manner in which this Congressional power is to be exercised is generally said to be unrestricted. *Blanchard v. Sprague*, 3 F.Cas. 648, 3 Sumn. 535, 2 Story, 164 (Cir. Ct. D. Mass. 1839). Thus, it has been held that Congress could itself grant patents as private enactments. See *Evans v. Eaton*, 3 Wheat (16 U.S.) 454 (1818); *Bloomer v. Stolley*, 3 F.Cas. 729, 5 McLean 158, 8 West. Law J. 158 (Cir. Ct., D. Ohio 1850). In the *Bloomer* case, the Court stated that:

There would seem to be no doubt that the constitutional power in question might have been fully exercised by congress in making special grants; this might have engrossed much of the time of congress, and it might not be thought the most competent body to investigate the facts and do equal justice to inventors; but this would be a question of expediency, and not of constitutional power.

There would also seem to be no doubt that the construction of the grant of such an enactment is a matter of law for the court. *Evans v. Eaton*, *supra* (albeit the Court was not dealing with a definitive patent claim).

Since 1836 Congress has delegated its legislative power to grant patents to the Patent and Trademark Office. Today the grant can only be made by a definite recitation in the form of a patent claim that sets the boundaries of the grant, in keeping with a detailed statutory framework. Moreover, Congress retains oversight responsibility and the

power, within Constitutional limits, to prescribe the standards and the nature and duration of the grants.

Whether a patent is issued by direct Congressional enactment, or indirectly through the offices of the PTO acting under standards and guidelines set by Congress, exercising the power delegated to it by the legislature, a determination of the scope of the grant delimited by the words of a patent claim must remain a question of law for the courts. This is particularly true since the metes and bounds of the grant -- according to which the application for it has been tested and allowed -- is fixed by the words of the claims.^{2/}

E. Other Factors

It has been asserted that Congress does not have the power to abrogate the Seventh Amendment right to a jury trial. We agree. Thus, assuming that a right existed in England in 1791 for the jury to determine from the specification of a patent what is old and what is new, and to compare the new portion to the accused device, Congress could not interfere with that jury trial right if it had maintained that mode of deciding patent cases. For a detailed discussion, see

^{2/}This is not to say that a patent is merely analogous to a statute. Nor is it the view of this amicus that a patent can never be viewed as being analogous to a contract or deed for some purposes, although we recognize that the logic of analogy is a minefield. Rather, it is the position of this amicus that a few patents have been granted by statutes, not merely analogous to statutes, and that whether in fact created by statute or the exercise of power delegated by Congress, patent claims constitute government grants in words -- the meaning of which is an issue of law for the court.

3 Patent Law Perspectives, p. 7-228.48. Congress does have the power, however, to change the nature of a patent grant, either to make specific grants through its own enactments, or to delegate that authority, as it has done, to an administrative agency under a legislative command to grant patents having definitive, rights-defining claims. 35 U.S.C. § 112, ¶ 2. Either way, the construction of a patent grant, whether made through direct Congressional enactment or by its delegation, should be construed in accordance with the manner in which government grants of specifically-defined rights were construed in England in 1791 -- by the court as a matter of law.

To be sure, Congress could have specified in the current Patent Act that the construction of a patent claim is for the jury -- even though not compelled to do so by the Seventh Amendment. But, unlike the 1790 Patent Act, which specifically relegated certain issues to the jury, the current Patent Act contains no such provision.

It has also been asserted that a jury is an appropriate vehicle for construing patent claims because juries do the "right thing." However much the communal experience of jurors may lend itself to an assessment of the facts and the application of such facts to a standard of reasonable care, as in a negligence action, there is no communal experience or insight that jurors bring to a construction of a patent claim or to an understanding of the arcane nuances of patent law or patent documents. Thus, after a litany of instructions that would numb the mind even of one steeped in patent law, the jury is set adrift to determine what one or two, or a hundred, patent claims may mean as they are used in an abstruse area of modern technology. And no one can predict what the result might be until the jury returns.

Further, it has been asserted that the Court of Appeals is not an appropriate forum in which to determine the scope of a patent claim. It is unclear, however, why a district

court cannot develop an appropriate record, and set forth the basis for its ruling on claim construction -- so that the ruling can be effectively reviewed on appeal. That this may require appropriate handling at the trial level is something that the district courts have successfully faced in many other contexts. As this Court ruled in *Dairy Queen v. Wood*, 369 U.S. 469, 478 (1962), a special master might be employed, under Rule 53, Fed. R. Civ. P., where appropriate. That a complex interpretive issue can be avoided by passing it to the jury is not a sufficient reason for relieving the district courts, and subsequently the Court of Appeals, of their obligation to resolve this issue.

The alternative is to leave claim construction to the jury, with no effective review so long as there is substantial evidence to support its ruling -- right or wrong -- and with a potential for different constructions by different juries, none of which, if supported by substantial evidence, can be corrected on appeal. In contrast, a government grant circumscribed by words that are required by statute to be definite must have one meaning. There must be uniformity. Difficult or not, it must be for the court to declare that meaning as a matter of law.^{8/}

It has also been asserted that the meaning of a word in a claim is what the word meant to one of ordinary skill in the relevant field at the relevant time -- and therefore it must be a task for the jury to determine who is a person of

^{8/}In the view of Sir Patrick Devlin, "Where there is need for uniformity a jury is no use." *Trial By Jury*, by Sir Patrick Devlin, Sweet & Maxwell Ltd., 1988, pp. 98-99.

The policy of uniformity is reflected by the act of Congress setting up the Court of Appeals for the Federal Circuit.

ordinary skill, en route to construing the claims. The fallacy of this assertion is twofold. First, in over forty years counsel for this amicus has never seen a case in which a word in a claim had a different meaning for those of ordinary skill in the field, as compare to those of lesser or greater skill. The closest one might come to this situation is where one person knows the meaning and another does not, or where one has a misconception of the meaning -- but these factors do not affect the accepted meaning in the field. Secondly, should such a rare situation exist, a court can secure from the jury an appropriate description of a person having ordinary skill in the field -- which is often stipulated - and then undertake the court's task of construing the claims.

One amicus asks how a court will be able to determine the meaning of the phrase:

"first electrical comparator connected to the load measuring means measuring the polished rod load relative to the present load point."

Aside from determining what in the specification corresponds to the claimed "means," as required by 35 U.S.C. § 112, ¶6, there is no word in this phrase that has a disputable meaning in the field. If the court needs to inform itself on the relevant technology, it should do so; it is not without the resources to do so. This can be done by scheduling one or more hearings, asking questions, requesting applicable documents that contain the standard definitions of terms, requesting the use of demonstrative aids, advising the parties where more enlightenment is needed, appointing a special master or a court-appointed expert, or whatever may be appropriate. Simply admitting testimony by experts for both sides, each of whom advocate the position of one of the parties, and passing the issue to the jury, can only produce

confusion. It will create artificial factual disputes when there is none, when the real issue is the legal construction of the grant that is defined such as by the above phrase.

Actually, the court will have to inform itself concerning the relevant technology even to be able to determine whether there is truly a genuine dispute concerning the meaning of the word, or merely one that has been manufactured by a paid expert.

Other examples of phrases containing technical words that present no real meaning dispute are presented by another amicus. They similarly show the irrationality of letting each party present an expert who will subscribe to a meaning that meets the needs of the party's case, and then laying on an overwhelmed jury the unenviable burden of making a choice -- when the real issue is the scope of a word-defined government grant.

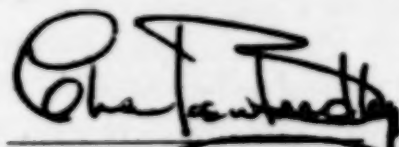
In short, the construction of a patent grant, as specifically defined in patent claims -- whether derived from a special act of Congress or through the power it has delegated to the PTO -- is properly an issue of law for the court.

V. CONCLUSION

A principled and rational construction of the claims of a patent requires that claim construction be undertaken by the court, using all of the faculties available to it. This is particularly true when the meaning of the claim is clear from the basic documents, formed by the patent and its prosecution history, when the construction is based on the ordinary meaning of words, unassociated with any particular technology, or when it is based on punctuation or grammatical construction aside from technology. Moreover, claim construction should properly be an issue of law for the court even when extrinsic evidence is required and introduced

concerning the historical meaning of a particular word in a particular field on a particular date. A patent claim is a definitive government grant, and, as in the case of government grants in England in 1791, construction of that grant is properly for the court to decide as an issue of law.

Respectfully,



Charles W. Bradley

Counsel of Record

Stanley L. Amberg

Lawrence B. Goodwin

Robert A. Cote

ORRICK, HERRINGTON & SUTCLIFFE

666 Fifth Avenue

New York, NY 10103-0001

Telephone: (212) 506-5000

Attorneys for

AMERICAN AUTOMOBILE

MANUFACTURERS ASSOCIATION

Of Counsel:

Phillip D. Brady

Andrew D. Koblenz

AMERICAN AUTOMOBILE

MANUFACTURERS ASSOCIATION

1401 H Street, N.W.

Suite 900

Washington, D.C. 20005

Telephone: (202) 326-5500

Appendix 1

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; November 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691.)

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Added November 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384.)

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; November 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691.)

§ 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent and Trademark Office. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

§ 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. (Amended July 24, 1965, Public Law 89-83, sec. 5, 79 Stat. 261; December 12, 1980, Public Law 96-517, sec. 4, 94 Stat. 3018; August 23, 1988, Public Law 100-418, sec. 9002, 102 Stat. 1563.)

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

§ 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

§ 284. Damages

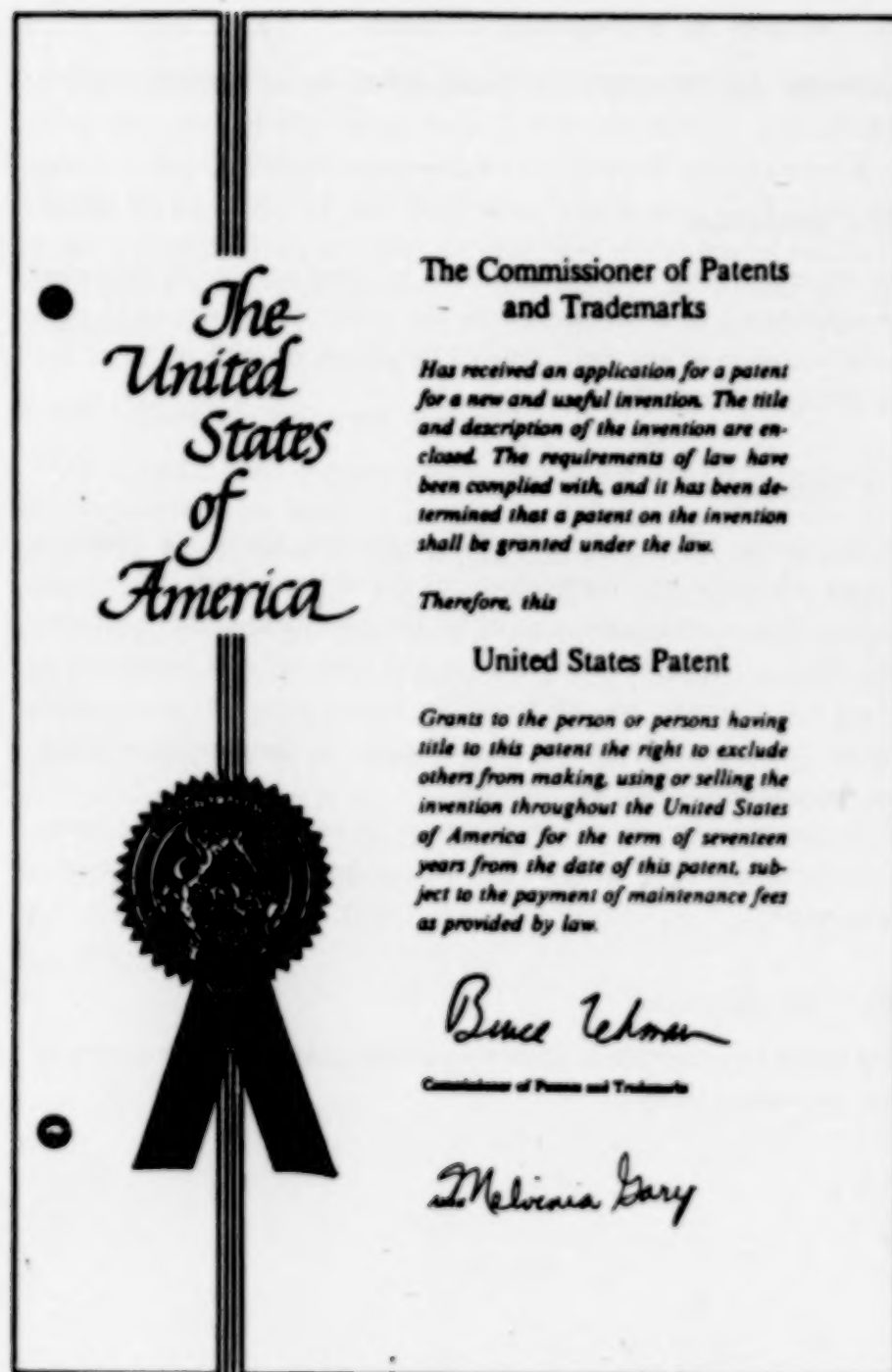
Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

§ 285. Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party.



In *Bovill v. Moore* (C.P. 1816), available in John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees* 361 (London 1816), tried in 1816 in the Court of Common Pleas, Lord Chief Justice Gibbs instructed the jury:

I remember that that was the expedient used by a man in Cornwall, who endeavored to pirate the steam-engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's: - where you looked for the head, you found the feet, and where you looked for the feet, you found the head; but it turned out that he had taken the principle of Boulton and Watt's -- it acted as well one way as the other; but if you set it upright, it was exactly Boulton and Watt's engine. So here, I make the observation, because I observe it is stated that one acts upwards, and the other downwards, one commences from the bottom and produces the lace by an upward operation, the other acts from above and produces it by an operation downwards; but that, if the principle be the same, must be considered as the same in point of invention. *Id.*, at 405-6.²⁷

²⁷It should be noted that the term "principle" is often defined by the early cases as meaning the "mode of operation," rather than some basic law of nature. *Burr v. Duryee*, 68 U.S. (1 Wal.) 531, 572-573 (1863); Curtis, *Law of Patents* § 306 n.1 (3rd ed. 1867).

In *Hill v. Thompson*, 150 Eng. Rep. 427 (Ex. D. 1818), the jury returned a verdict for the plaintiff and the defendant obtained a rule *nisi* to set the verdict aside or have a new trial. At the hearing, in 1818, of the rule to set aside the jury verdict, Judge Dallas delivered the judgment of the court, stating, in relevant part:

It is scarcely necessary here to observe, that a slight departure from the specification for the purpose of evasion only would, of course, be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the Defendant has or has not been essentially or substantially different. *Id.* at 434-5.

In *Webster v. Uther* (K.B. 1824), available in 1 Benjamin Vaughn Abbott, *Decisions on the Law of Patents for Inventions Rendered by English Courts Since the Beginning of the Seventeenth Century* 21 (Washington, Charles R. Brodix 1887) at 369, the invention was the addition of a bolt sliding or moving in a groove by which the roller magazine was then fixed in a percussion gun lock. The defendant's lock had a spring in the bolt. The jury heard evidence from machines that a spring in the bolt was the same thing as a bolt sliding in a groove, and found that the defendant had infringed.

In *Minter v. Wells* (Ex. 1834), available in 1 Thomas Webster, *Reports and Notes of Cases on Letters Patent for Inventions* 166 (London, A. Milliken and T. Clark 1841) (hereinafter "*Webster*") at 127, 1 William Carpmael, *Law Reports of Patent Cases* 1 (London, A. MacIntosh 1851) (hereinafter "*Carpmael*") at 622, tried in 1834 in the Court of Exchequer before Mr. Baron Alderson and a special jury,

the jury returned a verdict for the plaintiff after being charged:

If you are of the opinion that the plaintiff is the first and true inventor, that the invention is useful, and that he has given such a description in his specification as would make an experienced workman able to make the chair from it, there seems no doubt that the defendant's chair is an infringement of that patent, because undoubtedly it is a colourable variation, and a colourable variation only. There is a celebrated case which Mr. Justice Buller mentions, where a party produced a machine which at first sight appeared to be wholly different from that which was the subject of the patent; but when you came to consider it, all the difference was, that the head was where the tail should be, and the tail where the head should be; but they operated on the same principle; and so it is precisely here; both the parts are turned. 1 Webster, *supra* at 133-4, 1 Carpmael, *supra* at 639.

In *Morgan v. Seward*, (Ex. 1836), available in 1 Webster, *supra* at 170, 2 Carpmael, *supra* at 37, tried in 1836 in the same court before the same judge, the jury returned a verdict for the plaintiff after being charged:

I think, gentlemen, this case lies within a very narrow compass. The plaintiffs complain of the defendants for infringing their patent; the defendants make several defenses; the first that they did not infringe the patent. Upon the fact you have expressed your opin-

ion, that you have no doubt about it, that the one is an infringement of the other, the principle of which would be simply whether the defendants' machine either differed colourably, or only in those things which were mechanical equivalents, the one for the other. Now, I think when you are told what the plaintiffs' invention really is, you will see that those differences which Mr. Donkin and others pointed out as the differences between the one machine and the other, are, in truth, differences which do not affect the principle of the plaintiffs' patent at all. The two machines are alike in principle, and the one who made the first invention of that, suggested the principle to the other; though he may have carried it into effect by substituting one mechanical equivalent for another. You are to look to the substance, and not to the mere form. If in substance it is an infringement of it, you ought to find it so; but if you think that in substance it is not the same, if it was in principle really different, then you will find it not to be an infringement, though it might have a resemblance in its parts. 1 Webster, *supra* at 171, 2 Carpmael, *supra* at 89-90.

No. 95-26

(24)

Supreme Court, U.S.

FILED

DEC 8 1995

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN and POSITEK, INC.,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF AMICUS CURIAE OF
INTELLECTUAL PROPERTY OWNERS
IN SUPPORT OF RESPONDENTS**

CONSTANTINE L. TRELA
JAMES B. SPETA
SIDLEY & AUSTIN
One First National Plaza
Chicago, Illinois 60603
(312) 853-7000

REX E. LEE
CARTER G. PHILLIPS *
MARK E. HADDAD
SIDLEY & AUSTIN
1722 Eye Street, N.W.
Washington, D.C. 20006
(202) 736-8000

Counsel for Amicus Curiae

December 8, 1995

* Counsel of Record

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

BEST AVAILABLE COPY

53 PP

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTEREST OF <i>AMICUS CURIAE</i>	1
INTRODUCTION AND SUMMARY OF ARGUMENT	2
ARGUMENT	6
I. THE USE OF EXTRINSIC EVIDENCE DOES NOT NECESSARILY CREATE A QUESTION FOR THE JURY	6
II. BECAUSE THE PATENT LAWS REQUIRE THAT PATENT CLAIMS STATE PRECISELY THE NEW INVENTION AS DETERMINED BY THE PATENT AND TRADEMARK OFFICE, CLAIM CONSTRUCTION IS IN EFFECT THE PROCESS OF DETERMINING WHAT ACTION THE PATENT OFFICE TOOK AND THEREFORE INCLUDES NO ROLE FOR THE JURY IN DETERMINING "FACTS"	15
CONCLUSION	25

TABLE OF AUTHORITIES

Cases	Page
<i>Beacon Theatres, Inc. v. Westover</i> , 359 U.S. 500 (1959)	13
<i>Bender v. Williamsport Area School Dist.</i> , 475 U.S. 534 (1986)	9
<i>Bischoff v. Wethered</i> , 76 U.S. (9 Wall.) 812 (1869)	24
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 212 (1854)	18
<i>Brown v. Piper</i> , 91 U.S. 37 (1875)	7
<i>Brubaker v. King</i> , 505 F.2d 534 (7th Cir. 1974)	23
<i>Cadence Indus. Corp. v. Ringer</i> , 450 F. Supp. 59 (S.D.N.Y. 1978)	22
<i>Carnegie Steel v. Cambria Iron Co.</i> , 185 U.S. 403 (1902)	17
<i>Chance v. E.I. DuPont de Nemours & Co.</i> , 57 F.R.D. 165 (E.D.N.Y. 1972)	10
<i>Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry</i> , 494 U.S. 558 (1990)	7
<i>Cimotti Unhairing Co. v. American Fur Refining Co.</i> , 198 U.S. 399 (1905)	18
<i>Connell v. Sears, Roebuck & Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)	21
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	24
<i>Dairy Queen, Inc. v. Wood</i> , 369 U.S. 469 (1962)	13
<i>Eibel Process Co. v. Minnesota & Ontario Paper Co.</i> , 261 U.S. 45 (1923)	18
<i>Ethicon, Inc. v. Quigg</i> , 849 F.2d 1422 (Fed. Cir. 1988)	21
<i>Gilbert v. David</i> , 235 U.S. 561 (1915)	9
<i>Gough v. Rossmoor Corp.</i> , 487 F.2d 373 (9th Cir. 1973)	9
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	21
<i>Granfinanciera, S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	24
<i>In re Corkill</i> , 771 F.2d 1496 (Fed. Cir. 1985)	18
<i>Intervet America, Inc. v. Kee-Vet Labs., Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	21
<i>Kendall v. Winsor</i> , 62 U.S. (21 How.) 322 (1859) ..	25
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	16

TABLE OF AUTHORITIES—Continued

	Page
<i>Levy v. Gadsby</i> , 7 U.S. (3 Cranch) 180 (1805)	6
<i>Lujan v. Defenders of Wildlife</i> , 504 U.S. 555 (1992)	9
<i>Marra v. Bushee</i> , 447 F.2d 1282 (2d Cir. 1971)	10
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891) ..16, 17, 18, 19	
<i>McNutt v. General Motors Acceptance Corp.</i> , 298 U.S. 178 (1936)	9, 10
<i>Mercoid Corp. v. Mid-Continent Inv. Co.</i> , 320 U.S. 661 (1944)	18, 25
<i>Merrill v. Yeoman</i> , 94 U.S. 568 (1876)	16, 17
<i>MGPC, Inc. v. Canadian Hidrogas Resources, Ltd.</i> , 725 F.2d 1376 (TECA), cert. denied, 464 U.S. 961 (1983)	13
<i>Moeller v. Ionetics, Inc.</i> , 794 F.2d 653 (Fed. Cir. 1986)	20
<i>Motion Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	25
<i>North Pacific Steamship Co. v. Soley</i> , 257 U.S. 216 (1921)	10
<i>O'Reilly v. Morse</i> , 56 U.S. (15 How.) 61 (1854)	16
<i>Orthokinetics, Inc. v. Safety Travel Chairs, Inc.</i> , 806 F.2d 1565 (Fed. Cir. 1986)	18
<i>Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.</i> , 324 U.S. 806 (1945)	25
<i>Ross v. Bernhard</i> , 396 U.S. 531 (1970)	8, 9
<i>Silsby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	24
<i>Simler v. Conner</i> , 372 U.S. 221 (1963)	9
<i>Standard Oil Co. v. Department of Energy</i> , 596 F.2d 1029 (TECA 1978)	13
<i>Texas Instr. v. United States ITC</i> , 805 F.2d 1558 (Fed. Cir. 1986)	18
<i>Tucker v. Spalding</i> , 80 U.S. (13 Wall.) 453 (1871)	24
<i>Tull v. United States</i> , 481 U.S. 412 (1987)	7
<i>United States v. Edge</i> , 989 F.2d 871 (6th Cir. 1993)	13
<i>United States v. SCRAP</i> , 412 U.S. 669 (1973)	22

TABLE OF AUTHORITIES—Continued

	Page
<i>Universal Oil Products Co. v. Globe Oil & Refining Co.</i> , 322 U.S. 471 (1944)	17
<i>Vaz Borralho v. Keydril Co.</i> , 696 F.2d 379 (5th Cir. 1983)	10
<i>Walton v. Arabian Am. Oil Co.</i> , 233 F.2d 541 (2d Cir.), <i>cert. denied</i> , 352 U.S. 872 (1956)	11
<i>Wetmore v. Rymer</i> , 169 U.S. 115 (1898)	9
<i>Williamson v. Tucker</i> , 645 F.2d 404 (5th Cir.), <i>cert. denied</i> , 454 U.S. 897 (1981)	9
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 330 (1854)	18
<i>Constitutional Provisions, Statutes and Rules</i>	
U.S. CONST. amend. VII	8
U.S. CONST. art. I, § 8, cl. 8	17, 24
35 U.S.C. § 111	19
35 U.S.C. § 112	16, 19
35 U.S.C. § 131	19
25 U.S.C. § 282	21
47 U.S.C. § 204	22
49 U.S.C. §§ 10707-10708 (superseding in part 49 U.S.C. § 15)	22
37 C.F.R. § 1.104(a)	20
37 C.F.R. § 1.51	20
37 C.F.R. § 1.56(a)	20
FED. R. CIV. P. 38(b)	9
FED. R. CIV. P. 44.1	4, 10-12, 14
FED. R. CIV. P. 49(a)	23
<i>Miscellaneous</i>	
John R. Brown, <i>44.1 Ways To Prove Foreign Law</i> , 9 MARITIME LAW 179 (1984)	11
H.R. REP. NO. 1476, 94th Cong., 2d Sess. 157 (1976), <i>reprinted in</i> 1976 U.S.C.C.A.N. 5659....	21
Manual of Patent Examining Procedure § 706.03(d) (Revision 16, 1990)	20
Arthur R. Miller, <i>Federal Rule 44.1 and the "Fact" Approach To Determining Foreign Law: Death Knell for a Die-Hard Doctrine</i> , 65 MICH. L. REV. 613 (1967)	11, 12

TABLE OF AUTHORITIES—Continued

	Page
5 MOORE'S FEDERAL PRACTICE (1988)	8, 13
2 NIMMER ON COPYRIGHT (1995)	22
RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 188	10
RESTATEMENT (SECOND) OF CONTRACTS § 212(2) ..	19
9, 18 CHARLES A. WRIGHT, ET AL., FEDERAL PRACTICE AND PROCEDURE (1981)	9, 23

IN THE
Supreme Court of the United States

OCTOBER TERM, 1995

No. 95-26

HERBERT MARKMAN and POSITEK, INC.,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF AMICUS CURIAE OF
INTELLECTUAL PROPERTY OWNERS
IN SUPPORT OF RESPONDENTS**

INTEREST OF AMICUS CURIAE

With the consent of the parties,¹ the Intellectual Property Owners ("IPO") hereby submits this brief *amicus curiae* in support of respondents. Although neither IPO nor any of its members has a direct interest in the outcome of this case on the merits, IPO and its members have a substantial interest in the issue presented for review by this Court. Many of IPO's members are patent owners and assignees, and the method by which those patents are construed is a fundamental concern to those members. The Federal Circuit's decision rationalizes the con-

¹ Letters reflecting the parties' consent to the filing of this brief have been filed with the Clerk of the Court.

struction of patent claims by recognizing that such construction always involves questions that are solely matters of law. This holding not only is commanded by patent law but also will promote the consistency and uniformity necessary both for patent owners and the public. Although IPO does not in this brief address the parties' contentions based upon the practice of claim construction at common law, IPO believes that the statutory requirements of current patent law preclude any role for the jury in the claim construction process.

IPO is a national organization founded in 1972 which represents the interests of owners of intellectual property in the United States. IPO's members currently include nearly 100 large and mid-size companies and more than 300 small businesses, universities, independent inventors, authors, executives and attorneys who own or are interested in patents, trademarks, copyrights and other intellectual property rights. Members of IPO's Board of Directors, which pursuant to IPO's by-laws approved the position taken in this *amicus* brief by a three-fourths vote, are listed in the Appendix to this brief. IPO is a non-profit association exempt from federal income tax under Internal Revenue Code § 501(c)(6).

INTRODUCTION AND SUMMARY OF ARGUMENT

The Federal Circuit's *en banc* decision that the construction of patent claims is exclusively a matter of law for the court at last harmonizes the process of claim construction with the patent laws' substantive claiming requirements and the canons of patent claim construction dictated by the Patent Clause of the Constitution and the patent statutes. The Federal Circuit properly held that claim construction is a matter of law for the court notwithstanding the need, in some cases, for a court to consider "extrinsic evidence," including expert testimony. The patent laws require that each patent's claims be set out clearly, to provide notice to those skilled in the rele-

vant art of what invention the patent protects, and that the Patent Office make an affirmative finding that a patent application presents an invention patentable under the statutory criteria that is claimed with the requisite precision. By virtue of these dual requirements, although extrinsic evidence occasionally may be needed to illuminate claim terms, construction should never devolve to an indeterminate "choice" between conflicting reasonable interpretations of the claims. There is, therefore, no role for a jury (or other factfinder) to play in the process of claim construction.

1. The Federal Circuit properly held that interpretation of patent claims is a matter for the court, notwithstanding that the patentee has sued for damages and that the Seventh Amendment therefore guarantees the parties the right to a jury trial on the merits of the infringement claim. The Federal Circuit also properly recognized that courts often would be required to consider matters outside the four corners of the patent's claims and specification, such as the prosecution history of the patent and evidence defining the state of the art at the time the patent was issued. The Federal Circuit moreover recognized that expert testimony could prove useful to illuminate the meaning of claim terms in light of the relevant state of the art.

Petitioners' attack on the Federal Circuit's holding turns on the argument that consideration of extrinsic evidence, especially expert testimony and especially where such evidence may be disputed, necessarily converts some or all of the claim construction process into a "factual" inquiry that the Seventh Amendment requires a jury to decide. This argument presumes that, once an action has been identified as one that gives rise to a right to jury trial under the Seventh Amendment, each and every "factual issue" (as petitioners and their *amici* have defined such issues) must be determined by the jury and subject to deferential review by appellate courts.

Petitioners' underlying presumption is false, for there are numerous issues in every jury case that the court decides. Among these issues are: questions of jurisdiction; questions of transfer, forum *non conveniens* and choice of law; questions of foreign law (*see* FED. R. CIV. P. 44.1); and, in rare but permissible instances, statutory construction. The Seventh Amendment does not require that the factual predicates of these issues, even where disputed, be submitted to the jury. Although not all of the possible Seventh Amendment issues have been definitively resolved by this Court, in each of these contexts, the consensus of the courts of appeals that have squarely faced these issues is that the Seventh Amendment does not require that the disputed facts be decided by the jury. And this Court, in approving Federal Rule of Civil Procedure 44.1, permitted courts to "consider any relevant material or source, including testimony" in order to rule on questions of foreign law. FED. R. CIV. P. 44.1. Therefore, petitioners' characterization of the Federal Circuit's decision as anomalous simply because it identifies claim construction disputes as matters for the court to decide before submitting the merits of the ultimate question of infringement to the jury is erroneous.

2. Congress' substantive requirement in the patent laws that a patent claim the protected invention in precise terms, and Congress' commitment of primary responsibility over the patent process to an expert administrative agency, together create a structure under which the jury has no appropriate role in construing patent claims. The patent laws require that patent claims be clearly and precisely stated. This requirement serves two fundamental purposes. First, it apprises the public of the advance that the patentee has made beyond the then-existing state of the art, so that the public may use the invention after the patentee's limited monopoly expires. This, in fact, is the fundamental *quid pro quo* of the patent laws: The in-

ventor receives a limited, exclusive right to exploit the invention in order to encourage the advance of the sciences generally. Second, the requirement that patent claims be clearly and precisely stated ensures that the patentee enjoys the full scope of this monopoly, but also simultaneously provides other practitioners of the art, and the public generally, notice of the precise boundaries of the protected invention so that they may avoid infringement.

Congress, in the exercise of the power the Constitution grants it to establish patents, has statutorily defined the criteria of patentability. Moreover, because of the technical, specialized questions involved in determining patentability, Congress has simultaneously committed initial and primary responsibility for the patent process to an expert administrative agency, the Patent and Trademark Office ("PTO"). Patent applicants must submit to the PTO with their applications a review of the state of the art, and the PTO must conduct an examination to determine both that an invention is patentable and that the patent claims are clearly stated. Although private parties may contest the validity of patents in subsequent litigation, either as a defense to an infringement suit or in an action seeking a declaratory judgment of invalidity, Congress has recognized the primacy of the PTO's determinations by according patents a presumption of validity such that only clear and convincing evidence can justify a finding of invalidity. The findings of the PTO are embodied in the patent's claims, and those claims therefore are most properly analogized to a statute, as the Federal Circuit did in the decision below, or to an administrative agency's regulation.

These dual features of the patent laws demonstrate that no jury trial right exists on the issue of claim construction. The power of Congress to have created such a statutory scheme cannot be doubted. A patent is a right created pursuant to the authority vested in Congress by the Constitution, and the patent monopoly is a creature

of the public interest and not a matter of private property rights. Therefore, the granting, validity and construction of patents are matters of "public right" that Congress may, consistently with the Seventh Amendment, commit to administrative tribunals or to determination by a court without a jury.

ARGUMENT

I. THE USE OF EXTRINSIC EVIDENCE DOES NOT NECESSARILY CREATE A QUESTION FOR THE JURY.

As the Federal Circuit properly held in this case, the process of claim construction will sometimes require the court to consider evidence outside the four corners of the patent's claims and specifications. Petitioners and *amici* supporting petitioners rest their argument for reversal on the proposition that, in a case in which a jury trial is otherwise required, each and every question that requires the evaluation of extrinsic evidence presents an issue that a jury must decide. But that is not the law. There are numerous questions that the court decides in the context of a jury case, without turning to the jury for the underlying factfinding, that require or permit the consideration of extrinsic evidence.

The Federal Circuit's analysis begins with the proposition, which neither petitioners nor their *amici* dispute, that "[i]t has long been and continues to be a fundamental principle of American law that 'the construction of a written evidence is exclusively with the court.'" 26a (quoting *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805)). The Federal Circuit also holds, consistently with well-established patent law, that the construction of the written claims will nevertheless sometimes require consideration of material outside the four corners of the patent, including the prosecution history and expert testimony regarding the state of the art. 31a-34a. "This evidence may be helpful to explain scientific principles, the

meaning of technical terms, and terms of art that appear in the patent and prosecution history. Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful 'to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.'" 32a-34a (quoting *Brown v. Piper*, 91 U.S. 37, 41 (1875)).

Petitioners and their *amici* take the position that the need to consider any extrinsic evidence necessarily requires that the claim construction decision be committed to a jury as trier of fact. See Pet. Br. 18 ("when a tribunal—judge or jury—resolves issues by considering testimony and evidence, . . . this is a classic issue—a factual dispute—to be submitted to the jury"); Litton Br. 10 ("[r]esolving disputes over [extrinsic evidence] produces a *factual* finding" that must be made by the jury). At bottom, this argument presumes that whenever the court must resort to extrinsic evidence to decide any aspect of a question of law, that issue, by virtue of the need to consider the extrinsic evidence, becomes one for the jury.

To the contrary, the need for "extrinsic evidence" cannot be the touchstone for determining whether the right to trial by jury under the Seventh Amendment is implicated. As an initial matter, the decision whether there is a right to a jury trial on a given claim for relief is made by reference to the status of such claims at common law and, more importantly, the nature of the relief sought. See *Tull v. United States*, 481 U.S. 412, 417-18 (1987); *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990). In deciding whether the action is one "at common law" to which the Seventh Amendment applies, the test does not require a court to consider whether the case involves issues on which the trial judge will hear or evaluate extrinsic evidence. Clearly, in a case in which the only claim is a patentee's request for an injunction preventing infringement, the process of claim construction is identical to that in a damages case, and yet the Seventh Amendment does not require that a jury

be empaneled to hear the evidence.² See generally *Ross v. Bernhard*, 396 U.S. 531, 535 (1970) (solely equitable causes of action present "no Seventh Amendment problems").

Moreover, even in cases in which the Seventh Amendment requires that a claim be tried to a jury, there are numerous ancillary legal issues that the court decides as to which the judge is permitted or required to evaluate extrinsic evidence. *Amicus* Litton Systems contends that the only inquiry the Seventh Amendment requires is whether a "lawsuit fall[s] inside or outside the historic category of 'suits at common law,'" and that, if the "lawsuit" requires a trial by jury, then the Seventh Amendment further requires that all "factual disputes" that arise in the lawsuit be decided by the jury. See *Litton Br.* 10-11. To the contrary, as numerous examples demonstrate, it is neither "entirely novel" nor "incompatible with the Seventh Amendment" to decide that certain "factual disputes, embedded within lawsuits undeniably falling inside the historic jury-trial category, nonetheless appear so 'legal' in character that those facts may be decided by the court rather than the jury." *Id.* at 11 (emphasis and footnote omitted). As Professor Moore states, "While most actions of a legal nature are triable to a jury on timely demand, . . . not all issues of fact in a legal action are so triable." 5 MOORE'S FEDERAL PRACTICE ¶ 38.38[4], at 38-359 (1988).³

² It is true, as petitioners point out and *amicus* Litton Systems elaborates (*Pet. Br.* 31 n.16; *Litton Br.* 12-15), that the Seventh Amendment contains "two clauses." But the Reexamination Clause constricts appellate review only of those "fact[s] tried by jury." U.S. CONST. amend. VII. It therefore brings nothing independent to the question whether a given fact must be "tried by jury."

³ This Court, albeit in the converse context of recognizing a right to a jury where a stockholder's derivative action (traditionally brought in equity) presented a legal claim against the defendant directors and officers, explicitly rejected the notion that a determination at the level of the action resolved all of the Seventh Amendment questions. "The Seventh Amendment question depends

Courts, for example, determine their own jurisdiction; jurisdiction is not a factual matter committed to decision by the jury, even where the determination involves the resolution of disputed facts. This Court reiterated in *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 561 (1992), that, at each stage of the litigation, beginning with the pleading stage and progressing through an ultimate factual showing, the plaintiff must demonstrate standing to bring an action. But even though such jurisdictional determinations often require "full development of the relevant facts" (see *Bender v. Willamsport Area School Dist.*, 475 U.S. 534, 541 (1986)), this Court has never held that a jury periodically must be empaneled to find the facts on standing. To the contrary, this Court has held that the determination whether the parties are diverse, which undoubtedly involves an underlying factual issue, is one that need not be submitted to the jury. See *Gilbert v. David*, 235 U.S. 561, 567 (1915) ("while the court might have submitted the question to the jury, it was not bound to do so, the parties having adduced their testimony, pro and con, it was the privilege of the court, if it saw fit, to dispose of the issue upon the testimony which was fully heard upon that subject") (citing *Wetmore v. Rymer*, 169 U.S. 115 (1898)); see also *McNutt v. General Motors Acceptance Corp.*, 298 U.S. 178, 186 (1936); *Williamson v. Tucker*, 645 F.2d 404, 412-13 (5th Cir.), cert. denied, 454 U.S. 897 (1981); *Gough v. Rossmoor Corp.*, 487 F.2d 373, 377 (9th Cir. 1973). And, the court decides whether the plaintiff meets any jurisdictional amount requirement, without subsidiary

on the nature of the issue to be tried rather than the character of the overall action." *Ross*, 396 U.S. at 538; see also *Simler v. Conner*, 372 U.S. 221, 223 (1963); 9 CHARLES A. WRIGHT & ARTHUR R. MILLER, *FEDERAL PRACTICE AND PROCEDURE* § 2302, at 20 (1981) ("[T]he basic decisional unit in determining the existence of a right to jury trial is not the case. It is the particular issue within a case on which a jury trial is demanded."). Compare *FED. R. CIV. P.* 38(b) (jury trial on "any issue triable of right by a jury") (emphasis added).

factfinding by the jury. *North Pacific Steamship Co. v. Soley*, 257 U.S. 216, 221-23 (1921); *McNutt*, 298 U.S. at 186-87.

Issues unrelated to jurisdiction are similarly decided, sometimes on the basis of extrinsic evidence, by the court without aid of the jury. For example, transfer, forum *non conveniens* and choice of law decisions often turn on which of two or more states has more "contacts" or greater "interest" in the events giving rise to the litigation. In a typical contract case, for example, the choice of law determination will include consideration of where the contract was negotiated, formed and performed, among other things. See generally RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 188. These questions often cannot be answered by consideration of the written documents alone, and yet there is no right to have a jury determine these underlying facts. In *Chance v. E.I. DuPont de Nemours & Co.*, 57 F.R.D. 165 (E.D.N.Y. 1972), Judge Weinstein held that factual issues relating to choice of law bearing on transfer and severance issues need not and should not be submitted to a jury. "Since the jury will still determine the ultimate facts on the merits, preliminary judicial resolution of the factual issues relevant to choice of law does not impinge upon the right to jury trial." *Id.* at 171; see also *Vaz Borralho v. Keydril Co.*, 696 F.2d 379, 386-89 (5th Cir. 1983) (district court entitled to decide choice of law and forum *non conveniens* issues without jury, notwithstanding that there were contested issues of fact). But cf. *Marra v. Bushee*, 447 F.2d 1282 (2d Cir. 1971) (jury required to decide disputed issue of situs of the tortious activity, determining choice of law).

One of the most telling areas in which the court determines a question of law and often employs expert testimony, learned treatises, and other "extrinsic" evidence is the determination of questions of foreign law under Federal Rule of Civil Procedure 44.1. From the

time this Court adopted Rule 44.1 in 1966, the determination of foreign law in the federal courts has been a question of law. FED. R. CIV. P. 44.1. Anglo-American courts and commentators, however, historically had treated the determination of foreign law as a question of fact. See, e.g., *Walton v. Arabian Am. Oil Co.*, 233 F.2d 541, 543 & n.6 (2d Cir.) (collecting cases), *cert. denied*, 352 U.S. 872 (1956). As a question of fact, foreign law had to be pleaded and proved by the party whose cause of action or defense depended upon it, proof offered was subject to the rules of evidence, and findings were reviewed under the deferential standards applicable to factual findings. John R. Brown, *44.1 Ways To Prove Foreign Law*, 9 MARITIME LAW, 179, 181 (1984).

Professor Miller suggests that the characterization of foreign law issues as questions of fact prior to Rule 44.1 reflected the practice of the English common law courts. The treatment of foreign law as a question of fact, he writes,

was a natural product of the high degree of jurisprudential isolation afforded by the English Channel, the concept that trial by jury required trial *per pais*, which called for a jury whose members were drawn from the vicinage where the facts occurred and theoretically had no cognizance of matters beyond their own locale, and the insistence that all causes fit within the existing, highly stylized forms of action.

Arthur R. Miller, *Federal Rule 44.1 and the "Fact" Approach To Determining Foreign Law: Death Knell for a Die-Hard Doctrine*, 65 MICH. L. REV. 613, 618 (1967). American courts adopted this common law view of treating foreign law issues as questions of fact, and probably perpetuated that view in part because foreign law materials were not readily available. *Id.* at 619.

Federal Rule of Civil Procedure 44.1 ended this practice in federal courts and provides that "[t]he court's determination" of foreign law "shall be treated as a ruling

on a question of law.”⁴ Notwithstanding that, under Rule 44.1, courts determine foreign law as a matter of law, courts may (and often do) consider extrinsic evidence, including testimony. Indeed, the Rule itself states that the court, “in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.” FED. R. CIV. P. 44.1. Even though this testimony may require courts to make credibility determinations, there never has been any suggestion, either by this Court when it adopted Rule 44.1 or by courts or commentators since then, that judicial consideration of testimony regarding the content of foreign law violates the Seventh Amendment.⁵ That petitioners’ and their *amici*’s position requires the conclusion that this Court in 1966 adopted a facially unconstitutional Federal Rule of Civil Procedure makes plain that their theory is fundamentally flawed.

Courts have even used expert testimony and evidence other than traditional legislative history to assist in the construction of statutes and regulations, where the statutes contained terms of art or where the court needed assistance in interpreting the regulations. These few examples arose in actions without juries, but further demonstrate that petitioners’ reliance on extrinsic evidence as the touch-

⁴ Rule 44.1 provides in whole:

A party who intends to raise an issue concerning the law of a foreign country shall give notice by pleadings or other reasonable written notice. The court, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence. The court’s determination shall be treated as a ruling on a question of law.

FED. R. CIV. P. 44.1.

⁵ Professor Miller concludes that judicial determination of foreign law does not violate the Seventh Amendment. Miller, 65 MICH. L. REV. at 684-88.

stone for the existence of factual issues requiring jury determination is erroneous. Petitioners do not dispute that statutory construction is always a question of law, and whatever interpretative aid a court employs cannot alter that conclusion. See, e.g., *United States v. Edge*, 989 F.2d 871, 876-79 (6th Cir. 1993) (court considered expert testimony of botany professor as to meaning of term “plant” in sentencing guideline); *MGPC, Inc. v. Canadian Hidrogas Resources, Ltd.*, 725 F.2d 1376 (TECA) (use of expert testimony to interpret pricing regulations), *cert. denied*, 464 U.S. 961 (1983); *Standard Oil Co. v. Department of Energy*, 596 F.2d 1029 (TECA 1978) (trial court looked to agency correspondence and memoranda for assistance in interpreting regulations). Petitioners are simply incorrect, therefore, that “no court would permit . . . experts[] to present testimony about the meaning of a statute.” Pet. Br. 45.

These examples demonstrate that, even in the context of a lawsuit to which a right to jury trial attaches, numerous legal issues arise that may involve factual disputes and resolution of those disputes need not be committed to the jury. These examples also demonstrate that the Federal Circuit’s decision in this case does not ignore *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959), in which this Court held that issues of fact common to jury and nonjury questions must be submitted to the jury to preserve the parties’ Seventh Amendment rights. See Pet. Br. 21; Litton Br. 11-12. Even assuming that a court cannot resolve an “underlying factual question on an issue of law that is intertwined with the “merits” questions properly committed to the jury, compare 5 MOORE’S FEDERAL PRACTICE ¶ 38.36 [2.-2], at 38-335 to 38-336, that proposition does not implicate the Federal Circuit’s decision. Similarly, although claim construction might have “dispositive” impact on the question of infringement (Pet. Br. 17 n.8)—just as determinations of foreign law might have

dispositive impact in cases governed by such law or choice of law might have dispositive impact if the choice, for example, has statute of limitations consequences—that does not mean there are any “factual” questions in common between the construction question and the issue of infringement. In fact, there are not. Once the patent has been properly construed, the central factual issue presented by an infringement claim is the comparison between the patented invention and the allegedly infringing device or process. That factual issue remains an independent jury question.

In sum, the Federal Circuit’s decision is not “sleight of hand,” nor is it a “recharacterization” of a question of fact into a question of law by *ipse dixit* (Pet. Br. 21), any more than was this Court’s adoption of Federal Rule of Civil Procedure 44.1. It is, instead, perfectly consistent with judicial resolution of numerous other legal issues in jury cases. Questions of statutory construction are inquiries into the sovereign acts of a coordinate branch of government, and questions of foreign law likewise attempt to identify the sovereign acts of a foreign government. Similarly, jurisdictional questions are addressed to the court’s authority, as delimited by the Constitution and Acts of Congress, over the controversy before it. Properly conceived, claim construction is akin to these inquiries because the court is required to determine the action taken by the United States Patent and Trademark Office in granting, pursuant to constitutional and statutory standards, the limited patent monopoly. *See Part II, infra.*

II. BECAUSE THE PATENT LAWS REQUIRE THAT PATENT CLAIMS STATE PRECISELY THE NEW INVENTION AS DETERMINED BY THE PATENT AND TRADEMARK OFFICE, CLAIM CONSTRUCTION IS IN EFFECT THE PROCESS OF DETERMINING WHAT ACTION THE PATENT OFFICE TOOK AND THEREFORE INCLUDES NO ROLE FOR THE JURY IN DETERMINING “FACTS.”

1. As the Federal Circuit recognized, the patent laws require that a patent describe, in clear terms, the claimed invention. This fundamental requirement informs the public both of the advance the inventor has made, which is the *quid pro quo* for the temporally limited monopoly granted to the inventor, and of the scope of the monopoly so that infringement might be avoided. A patent that does not set forth its claims in sufficiently clear terms is void, and the interpretation of any patent whose claims are susceptible of more than one construction by those skilled in the relevant art is governed by well-established rules of claim construction derived from the patent laws themselves. There is, therefore, no role for the jury, or other finder of fact, to choose between disputed interpretations of patent claims.⁶

It is a fundamental tenet of patent law that, “[b]y statute, the patent must provide a written description of the invention that will enable one of ordinary skill in the art to make and use it.” 27a. The statute provides, in relevant part:

The specification shall contain a written description of the invention, and of the manner and process

⁶ IPO concedes that the weight of authority in the Federal Circuit prior to the decision in this case stated, albeit without any substantial analysis, that there were “factual” questions underlying the “legal” issue of claim construction. *See* Pet. Br. 17-18 & n.9. That authority, which was by no means uniform, *see* 25a (collecting cases), adds nothing to petitioners’ argument in this Court.

of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. § 112.

As this Court has held on numerous occasions, the claims are the measure of the patent's scope. Everything claimed, if it is rightfully patentable, is protected; everything not claimed, even if it would have been patentable by the inventor, is not protected, but is dedicated to the public. In *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274 (1877), this Court wrote that the claiming requirement of section 112, added by the patent law revision of 1836, meant that the "scope" of a patent's claim "always should be . . . clear and distinct." *Id.* at 278; see also *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) ("The claim is the measure of [the patentee's] right"); *O'Reilly v. Morse*, 56 U.S. (15 How.) 61, 119 (1854). The Court in *Keystone Bridge* also held that the claiming provision was intended to put an end to judicial uncertainty as to (and judicial inquiry into) the scope of a patentee's claim. "This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture." *Keystone Bridge*, 95 U.S. at 278. As this Court said as early as 1876: "The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions." *Merrill v. Yeoman*, 94 U.S. 568, 573 (1876). Therefore, although the statute requires sufficient clarity

to instruct one skilled in the art (as contrasted with lawyers or judges) in the patent and the scope of the claimed invention, see *Carnegie Steel v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902); Pet. Br. 17; Litton Br. 8, 25, the claiming requirements also ease construction by the courts, which can be instructed in the art (*inter alia*, by experts).

This requirement that a patent's claims precisely describe the invention is imposed for dual purposes. On the one hand, it ensures that the patentee gains protection for the new and valuable aspects of the invention—*i.e.*, the advances in the "Progress of Science and useful Arts" (U.S. CONST. art. I, § 8, cl. 8)—and, on the other hand, it ensures that the public is provided notice of the monopoly given to the inventor so that infringement can be avoided. "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them." *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891); *Merrill*, 94 U.S. at 573 ("The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights."). The specification and claiming requirements also serve the public interest by requiring the inventor, as a condition of the grant of the patent, to inform the community of the invention "in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired." *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944); compare also *id.* ("the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted").

As adjuncts to the claiming requirements, the courts have developed clear standards to determine the scope of a claim that is not precisely stated. First, if the patent fails to comply with the statute altogether and fails to state the

invention claimed in detail sufficient to permit a person skilled in the art to ascertain the claimed invention, then the patent is void. See *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 214-15 (1854); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575-76 (Fed. Cir. 1986); *In re Corkill*, 771 F.2d 1496 (Fed. Cir. 1985). Second, if the claims do state some patentable invention, the court construes the scope of the patent to preserve the invention in light of the state of the art existing at the time the patent application was made. See generally *McClain*, 141 U.S. at 425 ("where the claim is fairly susceptible of two constructions, that one will be adopted which preserves to the patentee his actual invention"); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 361-61 (1854). More specifically, a patent claim in a "crowded field," which makes a small advance on the state of the art, will be construed narrowly. See generally *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 63 (1923) ("If what he has done works only a slight step forward, . . . then his patent, if sustained, will be given a narrow scope"); *Cimotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399, 406-09 (1905). And conversely, a "pioneer" patent will be given a broad construction, to preserve for the inventor the maximum protection for his exceptionally innovative invention. *Eibel Process Co.*, 261 U.S. at 63; *Texas Instr. v. United States ITC*, 805 F.2d 1558, 1562 (Fed. Cir. 1986).

Nevertheless, the fundamental rule is that a patent cannot be given a meaning that does not provide persons skilled in the relevant art notice of the monopoly. For example, in *Mercoird Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944), the Court tied this narrowing rule of interpretation to the public interest upon which the entire patent system is based. "It is the protection of the public in a system of free enterprise which alike nullifies a patent where any part of it is invalid and denies to the patentee after issuance the power to use it in such a way as to

acquire a monopoly which is not plainly within the terms of the grant." *Id.* at 665-66 (citations omitted); see *McClain*, 141 U.S. at 425.

Acting in combination, the claiming requirements of section 112 and the attendant rules of construction dictate that a court will not "choose" between competing reasonable interpretations of patent claims. In those rare situations in which the extrinsic evidence does not yield a single interpretation,⁷ the court will either declare the patent void for insufficient claiming or will select the appropriate interpretation in accord with the rules of construction. There is, in these circumstances, no "choice" between competing interpretations of the patent claims, and no factual issue to be resolved by a jury.

2. Congress has committed initial and principal responsibility for administration of the patent system to the Patent and Trademark Office. Pursuant to the governing statutes and regulations, a patent applicant must specify and claim his invention in a way that demonstrates its patentability, and the PTO must conduct an examination to determine that the invention is patentable and is clearly and precisely claimed. Thus, section 111 requires that an application for a patent be made to the Commissioner of the PTO, section 112 requires that the new advance be specified and precisely claimed, and section 131 requires the PTO to conduct "an examination . . . of the application and the alleged new invention." 35 U.S.C. §§ 111, 112, 131. "[I]f on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor." *Id.* § 131.

⁷ Of course, where the extrinsic evidence yields only a single reasonable interpretation of a written document, there is no issue for the jury in any event. Compare RESTATEMENT (SECOND) OF CONTRACTS § 212(2) ("A question of interpretation of an integrated agreement is to be determined by the trier of fact if it depends on the credibility of extrinsic evidence or on a choice among reasonable inferences to be drawn from extrinsic evidence. Otherwise a question of interpretation of an integrated agreement is to be determined as a question of law.").

The attendant regulations require that an applicant submit to the Patent Office all information which is "material to patentability," 37 C.F.R. § 1.56(a), including all prior art references necessary to establish the state of the art and the patentability of the invention claimed. *See also generally* 37 C.F.R. § 1.51 *et seq.* (required details of application).

The applicable regulations make clear the duty of the PTO to inquire into all questions of patentability and compliance with the patent laws.

On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

37 C.F.R. § 1.104(a). Indeed, through the device of an "examiner's amendment," the examiner may not only determine that claim language complies with statutory requirements but may himself propose specific claim language. *See* 48a; *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 659 (Fed. Cir. 1986) ("the purpose of the examiner's amendment, as expressly stated, was to more particularly point out the invention"). In either event, the Manual of Patent Examining Procedure provides that the examiner shall assure that the claims meet the clarity requirements of the statute: "The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope." Manual of Patent Examining Procedure § 706.03(d) (Revision 16, 1990).

Congress has affirmed the primacy of the PTO's determination of patentability and compliance with the stat-

ute's other requirements by providing that "[a] patent shall be presumed valid." 35 U.S.C. § 282. The courts, recognizing the PTO's primary role, have further held that only clear and convincing evidence can establish a patent's invalidity in the face of the statutory presumption. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549 (Fed. Cir. 1983). *Compare also* *Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) ("the primary responsibility of sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system."); *Intervet America, Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1054 (Fed. Cir. 1989) ("The presumption of validity under 35 U.S.C. § 282 carries with it a presumption the examiner did his duty and knew what claims he was allowing.").

3. Given the highly structured nature of the patentability decisions made by the PTO as an expert agency, the Federal Circuit's analogy of patent construction to statutory interpretation is precisely on point. *See* 51a-52a. The affirmative judgment that the PTO makes upon examination and that is embodied in the approved and issued claims of the patent makes the subsequent judicial inquiry on claim construction a matter of determining what action the PTO took: *i.e.*, precisely what claim did the PTO approve and find patentable. None of the other questions of patent law to which *amicus* Litton Systems refers as threatened by the decision below (Litton Br. 17-18) involves a determination of what action was taken by the agency; each involves application of the principles of patent law to the patent *as approved by the PTO*.⁸

⁸ Although the patentee drafts the claims in the first instance, *see* 31a ("a patentee is free to be his own lexicographer"), the PTO process is different from that under the Copyright laws, where the Copyright Office, although it may reject clearly insufficient applications, is not required to (and does not) determine the copyrightability of works submitted. *See* H.R. REP. NO. 1476, 94th Cong., 2d Sess. 157 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659,

Moreover, the rules of patent claim construction (*see supra*, at 17-19) play the same role here as rules of statutory construction play in that context. *Compare* Litton Br. 23-24. *See* 28a ("it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude. They may understand what is the scope of the patent owner's rights by obtaining the patent and prosecution history—the undisputed public record—and applying established rules of construction to the language of the patent claim in the context of the patent.") (citations omitted).

4. The Federal Circuit's decision will also promote uniformity and predictability in the process of patent interpretation, both as to each individual patent subjected to litigation and as to the process of patent construction generally. 28a-30a. Treating claim construction as a matter of law subject to *de novo* review by the Federal Circuit will require that the trial court clearly articulate its interpretation of the patent, which will provide both the parties to the litigation and interested nonparties notice as to the scope of the patent in suit. In contrast, in litigation in which both interpretation and infringement are submitted to the jury, the jury's interpretation of the patent

5773 ("unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued") (emphasis added); 2 NIMMER ON COPYRIGHT § 7.21[A] (1995); *Cadence Indus. Corp. v. Ringer*, 450 F. Supp. 59, 65 (S.D.N.Y. 1978) ("The Copyright Office has neither the facilities nor the authority to rule upon the factual basis of applications for registration"). The process of patent approval is also unlike that under the laws derived from the Interstate Commerce Act that require the filing of tariffed rates, where the filed tariffs become effective unless the agency disapproves them, *see* 49 U.S.C. §§ 10707-10708 (superseding in part 49 U.S.C. § 15); 47 U.S.C. § 204 (Communications Act); *United States v. SCRAP*, 412 U.S. 669, 697 (1973) ("Congress was aware that if the Commission did not act within the suspension period, then the new rates would automatically go into effect"). *See also supra*, at 20.

will not necessarily appear simply from its verdict for one of the parties.

Although as an issue of law, issue preclusion will not apply between district courts on the question of claim construction, *compare* Pet. Br. 38, any decision by the Federal Circuit will bind all of the district courts through *stare decisis*. Moreover, issue preclusion presently does not arise with any frequency with respect to issues of claim construction decided by juries (*compare id.* at 38 n.20), because collateral estoppel requires identifying the precise finding of the jury on claim construction. *Brubaker v. King*, 505 F.2d 534, 538 (7th Cir. 1974); 18 CHARLES A. WRIGHT, ET AL., *FEDERAL PRACTICE AND PROCEDURE* § 4417 (1981). Where the jury returns a verdict on infringement, its ultimate construction of the patent, which may have been one of the constructions offered by the parties or another construction altogether, is not readily apparent. And this problem cannot be solved by the use of special verdicts or interrogatories, *compare* Pet. Br. 40 n.21; Litton Br. 28 & n.44, because a special verdict or interrogatory cannot ask the jury to describe in narrative form its construction of the patent. *See* FED. R. CIV. P. 49(a) ("the court may submit to the jury written questions susceptible of categorical or other brief answer"). Moreover, even if the decision of a single district court does not bind subsequent district courts, the first court's written reasoning will be helpful to subsequent courts. Explicit construction of the claims by the court, as compared to implicit construction by a jury, will provide much needed notice to other participants in the relevant product or process market of the precise scope of the patentee's monopoly.

5. This approach presents no square conflict with prior decisions of this Court. As petitioners concede, none of this Court's cases "addressed the Seventh Amendment

explicitly." Pet. Br. 31.⁹ That is because this Court's prior holdings indicating that disputed facts must be tendered to the jury almost always arose in the context of the ultimate infringement question, such as comparing the equivalency of two products or processes, and not in the initial step of declaring what an individual patent's claims mean. See, e.g., *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1869); *Coupe v. Royer*, 155 U.S. 565, 574-79 (1895); *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455-56 (1871); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853).

6. Finally, there can be no constitutional objection, as Litton Systems suggests, to Congress taking from the jury any role it might otherwise have had (for example, at common law) in construing patent claims. Litton Br. 24-25. Under *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33 (1989), Congress clearly has the power, notwithstanding the Seventh Amendment, to commit "the adjudication of [patent law issues to] a nonjury factfinder" because patents are public rights. *Id.* at 54. In *Granfinanciera*, the Court made clear that matters of public right do not arise only "between the government and others," but instead involve questions where "Congress, acting for a valid legislative purpose pursuant to its constitutional powers under Article I, has created a seemingly 'private' right that is . . . closely integrated into a public regulatory regime." *Id.* (citations omitted).

The patent laws are of course enacted pursuant to Congress' authority under Art. I, § 8, cl. 8 of the Constitution, and this Court has made clear on innumerable occasions that the underlying interest of the patent system, and of any patent grant, is the public interest, not the private rewards to an inventor. The private rewards are justified only by the benefit they provide to the public through incentives for the advancement of science. See

⁹ But see Litton Br. 15 (asserting that the decision below creates a "square conflict" with prior decisions of this Court).

Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 816 (1945) ("A patent by its very nature is affected with a public interest. . . . The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest"); *Mercoind Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661, 665 (1944) ("It is the public interest which is dominant in the patent system."); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 511 (1917) ("the primary purpose of our patent laws is not the creation of private fortunes for the owners of patents but is 'to promote the progress of science and useful arts'"); *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 328 (1859) ("the benefit to the public . . . was . . . doubtless the primary object in granting and securing that monopoly"). To ensure that the public's interest is fully vindicated, the discrete legal issue of claim construction should be left to the courts. And nothing in the Seventh Amendment commands a different approach.

CONCLUSION

For all the foregoing reasons, the judgment of the court of appeals should be affirmed.

Respectfully submitted,

CONSTANTINE L. TRELA
JAMES B. SPETA
SIDLEY & AUSTIN
One First National Plaza
Chicago, Illinois 60603
(312) 853-7000

REX E. LEE
CARTER G. PHILLIPS *
MARK E. HADDAD
SIDLEY & AUSTIN
1722 Eye Street, N.W.
Washington, D.C. 20006
(202) 736-8000

Counsel for *Amicus Curiae*

December 8, 1995

* Counsel of Record

APPENDIX

APPENDIX

MEMBERS OF BOARD OF DIRECTORS OF
INTELLECTUAL PROPERTY OWNERS *

Marc S. Adler Rohm & Haas Company	John P. McDonnell AT&T
Robert L. Andersen FMC Corporation	Alexander J. McKillop Mobil Oil Corporation
Norman L. Balmer Union Carbide Corporation	Robert E. Muir Caterpillar Inc.
Erwin F. Berrier, Jr. General Electric Company	Wallace L. Oliver Amoco Corporation
W. Dexter Brooks Coca-Cola Company	Garo A. Partoyan Mars Incorporated
James L. Fergason Optical Shields, Inc.	Harold R. Patton Medtronic, Inc.
Michael W. Glynn Ciba	Jacobus C. Rasser Procter & Gamble
Stephen S. Grace Dow Chemical Company	Peter C. Richardson Pfizer, Inc.
Gary L. Griswold 3M	Allen W. Richmond Phillips Petroleum Company
Robert P. Hayter United Technologies Corp.	Melvin J. Scolnick Pitney Bowes Inc.
Edward P. Heller, III Seagate Technology, Inc.	Victor Siber IBM Corporation
Wayne C. Jaeschke Henkel Corporation	Roger S. Smith Morgan & Finnegan
Geoffrey M. Karny Genetic Therapy, Inc.	Howard C. Stanley Monsanto
John J. Klocko, III E.I. DuPont de Nemours & Co.	Gary D. Street Hoechst Marion Roussel
Edward T. Lentz SmithKline Beecham Corp.	Herbert C. Wamsley Intellectual Property Owners
William F. Marsh Air Products & Chemicals, Inc.	Ogden H. Webster Eastman Kodak Company
Roger L. May Ford Motor Company	John K. Williamson Westinghouse Electric Corp.

* IPO procedures require approval of positions in briefs by a three-fourths majority of directors present and voting.

Report of the United States

OFFICE OF THE SECRETARY

REPORT OF THE SECRETARY

REPORT OF THE SECRETARY

BEST AVAILABLE COPY

TABLE OF CONTENTS

	<i>Pages</i>
TABLE OF AUTHORITIES	ii
INTEREST OF THE <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT	2
ARGUMENT	3
I. <i>Amicus</i> Takes No Position as to the Conflicting Historical Record on the Seventh Amendment Right to Jury Trial of the Meaning of Patent Claims; Regardless of How that Conflict Is Resolved, the Result Below Should Be Affirmed	3
II. The Practical Effects of the Decision Below Depend on the Manner in Which the Federal Circuit Resolves Related Issues	5
III. This Court Should Promote the Congressional Goals Underlying Creation of the Federal Circuit by Affirming and Allowing that Court to Establish a Uniform Body of Procedures for Patent Cases	7
CONCLUSION	9

TABLE OF AUTHORITIES

	<i>Pages</i>
<i>Cases</i>	
<i>Cardinal Chemical Co. v. Morton International, Inc.</i> , 113 S. Ct. 1967 (1993)	8
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	3
<i>Dennison Manufacturing Co. v. Panduit Corp.</i> , 475 U.S. 809 (1986)	8
<i>Elmer v. ICC Fabricating Inc.</i> , 67 F.3d 1571 (Fed. Cir. 1995)	7
<i>Hilton Davis Chemical Co. v. Warner-Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995) (en banc), <i>petition</i> <i>for cert. filed</i> , No. 95-728 (Nov. 6, 1995)	4, 6-7
<i>Howes v. Medical Components, Inc.</i> , 814 F.2d 638 (Fed. Cir. 1987)	5
<i>Johnston v. IVAC Corp.</i> , 885 F.2d 1574 (Fed. Cir. 1989)	5
<i>Senmed, Inc. v. Richard-Allan Medical Industries, Inc.</i> , 888 F.2d 815 (Fed. Cir. 1989)	5
<i>Telephone Cases</i> , 126 U.S. 1 (1888)	8
<i>United States v. Fausto</i> , 484 U.S. 439 (1988)	8
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991)	4

Constitutional Provisions, Statutes, and Rules

35 U.S.C. § 101 (1988)	4
35 U.S.C. § 112, first paragraph (1988)	4, 7
35 U.S.C. § 161 (1988)	4
35 U.S.C. § 171 (1988)	4
Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25	7
37 C.F.R. § 1.153(a) (1995)	4
37 C.F.R. § 1.164 (1995)	4
FED. R. CIV. P. 44.1	9
FED. R. CRIM. P. 26.1	9

Pages

Legislative Materials

H.R. Rep. No. 312, 97th Cong., 1st Sess. (1981)	7, 8
---	------

Treatises and Articles

DONALD S. CHISUM, PATENTS (1995)	4
Rochelle C. Dreyfuss, <i>The Federal Circuit: A Case</i> <i>Study in Specialized Courts</i> , 64 N.Y.U. L. REV. 1 (1989)	9
Karl B. Lutz, <i>Evolution of the Claims of U.S. Patents</i> (pts. 1-3), 20 J. PAT. OFF. SOC'Y 134, 377, 457 (1938)	4
WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS (4th ed. 1890))	3

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF OF THE DALLAS-FORT WORTH
INTELLECTUAL PROPERTY LAW ASSOCIATION
AS AMICUS CURIAE URGING AFFIRMANCE**

INTEREST OF THE AMICUS CURIAE*

Formed in the mid-1950s, the Dallas-Fort Worth Intellectual Property Law Association is a regional association of persons concerned with the patent, trademark, copyright, trade secret, and other laws protecting intellectual property rights. The Association, which was formerly known as the Dallas-Fort Worth Patent Association, is a member of the National Council of Intellectual Property Law Associations.

The Association's approximately 100 members, mostly attorneys, regularly represent clients in patent litigation, advise clients in patent and licensing matters, and represent clients in

* The parties' letters of consent have been filed with the Clerk pursuant to Rule 37.3.

administrative proceedings before the United States Patent and Trademark Office. In patent litigation, the Association's attorney members represent individuals, universities, and small and large businesses in trial and appellate proceedings. The members' clients are split roughly evenly between patent owners and accused infringers.

Neither the Association nor any of its members has any direct interest in any of the parties or in which side prevails in this lawsuit, except to the extent that the outcome affects the administration of the patent laws. A principal object of the Association is to aid in the institution of improvements in the patent laws and court procedures for administering those laws. To promote that objective, this *amicus curiae* brief sets forth the Association's observations regarding the likely practical effects of the ruling below on the conduct of patent litigation and regarding the need to allow the Federal Circuit to develop a consistent body of law concerning the respective roles of judge and jury in that litigation.

SUMMARY OF ARGUMENT

The historical record on the jury's role in interpreting patent claims is conflicting and ambiguous. *Amicus* takes no position on how those historical conflicts should be resolved, but notes that under any historically supportable resolution of the jury-trial issue in this case the ultimate result below should be affirmed.

By itself, the decision below does not significantly curtail the role of juries in patent cases. Instead, both its effect on the role of juries and its attainment of more consistent and predictable decisions in patent cases depend on how the Federal Circuit decides related issues. Since the decision below, that court has already resolved major related issues in a manner that preserves the factfinding role of juries while promoting uniform, certain, and predictable resolutions of issues of patent claim scope.

Congress established the Federal Circuit for the express purpose of promoting development of a uniform body of substantive and procedural law to govern patent issues. In view

of the cloudy historical record and the influence ongoing decisions of related issues will have on the decision's practical effects, this Court should uphold the Federal Circuit's ruling that disputes of patent claim interpretation present only legal issues for judges to decide.

ARGUMENT

I. *Amicus* Takes No Position as to the Conflicting Historical Record on the Seventh Amendment Right to Jury Trial of the Meaning of Patent Claims; Regardless of How that Conflict Is Resolved, the Result Below Should Be Affirmed.

The jurisprudence of the Seventh Amendment, guided by the amendment's language, turns in significant part on the historical inquiry: Would the issue in dispute have been triable by jury under the common law of England in 1791? As the varied opinions below and briefs in this Court demonstrate, that inquiry is clouded by an ambiguous and conflicting record, devoid of any contemporaneous¹ decision clearly assigning the issue to judge or jury.

Amicus takes no position as to the proper resolution of this historical inquiry, other than to note that it should be based on a precise definition of the issue as to which a jury-trial right is asserted. The decision below concerns only disputes as to the meaning of utility patent *claims*, an American innovation to patent

¹ Subsequent decisions assigning an issue to the jury are not directly relevant, since they may reflect a jury right, not preserved by the Seventh Amendment, that arose after 1791. Moreover, subsequent decisions do not consistently treat patent claim interpretation as a jury issue. See, e.g., *Coupe v. Royer*, 155 U.S. 565, 579 (1895) (judge "defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant") (quoting 3 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* 378 (4th ed. 1890)).

law begun in 1822.² Genuine disputes as to the meaning of a patent's *specification*, which may arise if an accused infringer contends the patent is invalid for lack of a disclosure adequately teaching those skilled in the art to practice the invention, will continue to be decided by juries. Moreover, the decision below leaves to the jury disputes as to the scope of non-utility patents;³ that scope is governed by the prior practice of factually assessing similarities between the accused infringement and the invention as disclosed in the specification. In short, the decision below narrowly focusses on disputes over the scope of the legal decrees of exclusivity embodied in utility patent claims.

It should also be noted that, even under the analysis previously followed by the Federal Circuit, this case would not have presented a claim interpretation issue for the jury. The dispute turns on the meaning of "inventory," a common, ordinary word, not a technical term. Under the prior analysis, conclusory

² Earlier patents contained only a "specification," which described and showed the invention in technical terms and enabled its practice by those skilled in the art. The scope of a patent was determined by comparing the invention as described and shown with the accused infringement. Our present patent laws, in contrast, require an applicant to submit claims, which are carefully scrutinized and sometimes revised by the Patent and Trademark Office, thereby legally defining the patent's coverage. 35 U.S.C. § 112, first paragraph (1988). For accounts of the historical development of patent claims, see generally 2 DONALD S. CHISUM, PATENTS § 8.02, at 8-5 to -13 (1995); Karl B. Lutz, *Evolution of the Claims of U.S. Patents* (pts. 1-3), 20 J. PAT. OFF. SOC'Y 134, 377, 457 (1938); *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1530-31 (Fed. Cir. 1995) (Newman, J., concurring), *petition for cert. filed*, No. 95-728 (Nov. 6, 1995); and *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-61 (Fed. Cir. 1991).

³ In addition to utility patents on inventions, 35 U.S.C. § 101 (1988), the patent laws provide for issuance of plant patents and design patents, 35 U.S.C. §§ 161, 171 (1988). Plant and design patents have claims only in formal terms. 37 C.F.R. §§ 1.153(a), 1.164 (1995).

opinions on the meaning of an ordinary word raised no genuine jury issue.⁴ Thus, in all events, the result below should be affirmed.

II. The Practical Effects of the Decision Below Depend on the Manner in Which the Federal Circuit Resolves Related Issues.

The briefs filed in support of petitioner, as well as concurring and dissenting opinions below, suggest the holding that claim interpretation presents only legal issues is tantamount to denying outright the right to a jury in patent infringement cases. As even dissenting Judge Newman has previously noted, however, many patent infringement cases turn on issues other than claim interpretation.⁵ Indeed, the principal factual issue underlying the infringement determination—whether the accused activity or product satisfies the limitations of the properly construed claim language—is unaffected by the decision below. Particularly from a trial lawyer's perspective, patent infringement cases often present many jury issues that are not foreclosed by the decision below, including the factual inquiries underlying patent-law doctrines of conception, reduction to practice, diligence, prior invention, and obviousness. This reality has been confirmed by several experiences of members of *amicus* since the decision below.

In their briefs, petitioners and supporting *amici* question the soundness of the various practical and policy considerations cited by the Federal Circuit in support of its ruling. They attack the Federal Circuit's conclusion that allowing judges to decide the

⁴ E.g., *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 643-44 (Fed. Cir. 1987).

⁵ *Senmed, Inc. v. Richard-Allan Medical Industries, Inc.*, 888 F.2d 815, 823 (Fed. Cir. 1989) (Newman, J., dissenting) ("Many patent infringement determinations do not require a preliminary 'claim interpretation' . . .").

meaning of patent claims will promote uniformity and predictability in patent matters.

In *amicus's* view, these attacks are premature. Both the frequency of jury trials under the decision below and the benefits of that decision will ultimately depend not simply on the decision itself, but on how the Federal Circuit proceeds in fashioning a coherent body of law applying the decision. Inherent in any language, for example, is a limit beyond which definitions cannot meaningfully elaborate. In applying the decision below, the Federal Circuit must determine where interpretation of a claim (by a judge) ends and application of that interpretation (by the jury) begins. Appropriate demarcation of this boundary can preserve the vitality of juries while promoting the benefits sought by the decision below.

The Federal Circuit can similarly promote these twin goals by setting appropriate procedures for the conduct of "*Markman* hearings"—proceedings conducted early in patent cases by which trial judges hear detailed arguments, review the patent and its prosecution history, and resolve disputes of claim interpretation. Based on their experience in the past few months, members of *amicus* believe that with appropriate safeguards these hearings can greatly enhance the fairness and efficiency of patent litigation while preserving the role of juries.

To implement the decision below, the Federal Circuit must also establish rules governing related issues. By establishing these rules appropriately, that court can ensure that the factfinding role of the jury is preserved fully while still promoting uniform and predictable resolution of disputes over patent scope. The Federal Circuit has already begun that effort.

One example is the Federal Circuit's *en banc* decision in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995), *petition for cert. filed*, No. 95-728 (Nov. 6, 1995). Patents are infringed not only by products and activities literally embraced by their claims, but also under the "doctrine of equivalents" by substantially similar products and activities. In

resolving conflicts among Federal Circuit panels on several aspects of that doctrine, *Hilton Davis* reaffirmed that the determination of whether sufficient similarity exists is one for the jury to make as a matter of fact. 62 F.3d at 1522.

Another illustration of the continued vitality of juries in patent matters arises in cases involving the scope of one form of patent claim—the so-called "means plus function" claim—that under the Patent Code⁶ is determined by comparing the accused product or activity with the invention's description in the patent specification. The decision below reserved decision on whether this comparison is for judge or jury. 52 F.3d at 977 n.8. In *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1575 (Fed. Cir. 1995), the Federal Circuit appears to have determined it is an issue of fact for the jury. These subsequent decisions demonstrate that, contrary to petitioners' arguments, the decision below does not end the substantial role of juries in patent trials.

III. This Court Should Promote the Congressional Goals Underlying Creation of the Federal Circuit by Affirming and Allowing that Court to Establish a Uniform Body of Procedures for Patent Cases.

Congress created the Federal Circuit expressly to promote "nationwide uniformity in patent law."⁷ In view of the increasing importance to the nation's economy of uniform and reliable results in patent matters,⁸ Congress concluded that a single court should handle all patent appeals, so that a consistent and uniform body of patent law can be developed and maintained.⁹ Recognizing that this Court's broad jurisdiction and limited resources preclude it from reviewing patent cases with the

⁶ 35 U.S.C. § 112, sixth paragraph (1988).

⁷ H.R. Rep. No. 312, 97th Cong., 1st Sess. 20 (1981); see Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25.

⁸ H.R. Rep. No. 312, 97th Cong., 1st Sess. 22-23 (1981).

⁹ *Id.* at 20, 23.

frequency necessary to perform that role,¹⁰ Congress created the Federal Circuit to "fill this void."¹¹

As the only Court of Appeals having its jurisdiction defined exclusively by subject matter rather than geography, the Federal Circuit employs a special expertise and carries out a special mission. On questions such as that here presented, where concrete historical tests are inconclusive and the analysis instead depends mainly on sound policies for, and the practicalities of, patent litigation, the Federal Circuit's judgment should not lightly be disturbed.¹²

Here, the question is whether disputes over the meaning of utility patent claims present issues of law or fact. The Federal Circuit concluded they were legal issues, reasoning that patent claims, which are governmental decrees of exclusivity, should be treated like statutes.¹³ With that conclusion, the Federal Circuit

¹⁰ In earlier times, a significant part of this Court's resources was devoted to patent cases. For example, the Court conducted twelve days of argument on the *Telephone Cases*, 126 U.S. 1 (1888); an entire volume of *United States Reports* is devoted to the report of that case.

¹¹ H.R. Rep. No. 312, 97th Cong., 1st Sess. 22 (1981).

¹² See *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) (remanding to obtain "the Federal Circuit's informed opinion on the complex issue of the degree to which the obviousness determination is one of fact"); see also *United States v. Fausto*, 484 U.S. 439, 464 n.11 (1988) (Stevens, J., dissenting) ("Because its jurisdiction is confined to a defined range of subjects, the Federal Circuit brings to the cases before it an unusual expertise that should not lightly be disregarded."); cf. *Cardinal Chemical Co. v. Morton International, Inc.*, 113 S. Ct. 1967, 1979-80 (1993) (Scalia, J., concurring in part) (noting experience of Federal Circuit judges in their specialized patent jurisdiction).

¹³ Although resolving those issues sometimes requires weighing conflicting opinions, such weighing is commonplace in deciding legal issues, as demonstrated by the historical inquiry facing the Court in this case. The propriety of weighing conflicting evidence

began the task of establishing a coherent body of procedures designed to promote uniform, certain, and predictable results while preserving the role of the jury.¹⁴ This Court should allow the Federal Circuit to use its special expertise to complete that task.

CONCLUSION

The decision of the Federal Circuit that disputes over the meaning of utility patent claims present only issues of law should be affirmed.

Respectfully submitted,

PAUL V. STORM
*Counsel of Record
 and President*
 Dallas-Fort Worth Intellectual
 Property Law Association
 4500 Renaissance Tower
 1201 Elm Street
 Dallas, Texas 75270
 (214) 939-4525

December 8, 1995

in resolving disputed issues of law is recognized, for example, in FED. R. CRIM. P. 26.1 and FED. R. CIV. P. 44.1, which direct trial courts to determine foreign law issues by considering all relevant materials and sources, and provide that the ruling shall be treated as one of law.

¹⁴ See generally Rochelle C. Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 5-23, 74-75 (1989) (describing Federal Circuit's progress in establishing "accurate, precise, and coherent" body of law for patent cases and advocating that Federal Circuit be given broad authority to continue).